

30 October 2008

PATENTS ACT 1977

APPLICANT Inventech UK Limited

ISSUES Whether translations of citations against patent application number GB 0807916.2 should be supplied; whether the invention complies with sections 1(1)(a) and (b)

HEARING OFFICER R C Kennell

DECISION

1 This application entitled “Holographic hand-held fan” was filed on 1 May 2008 with no claim to any earlier priority. It has been searched and substantively examined, but is not yet due to be published. The claims defining the invention comprise a single independent claim, claim 1, which reads:

“A holographic effect hand fan that has one or more fixed fan blades that when oscillated back and forth produces a flow of cool air.”

and further claims 2-15 dependent on claim 1 which I do not need to recite for the purposes of this decision.

2 During the prosecution of the application before the Office, Inventech UK Limited was represented by the inventor Mr David Edgar who is a director of the company. Following the first substantive report examination on 14 August 2008, Mr Edgar argued that, in order to deal with the objections to lack of novelty and inventive step that it raised, the examiner should be obliged to provide translations of two Japanese published patent applications that she had cited (together with a US patent specification) in support of the objections. Further correspondence with the Office on this point failed to resolve the matter and it came before me at a hearing on 13 October 2008.

3 At the hearing Mr Edgar appeared in person; he provided a witness statement summarising his arguments and also gave a most helpful demonstration of the principles underlying his invention. We were assisted from the Office by Miss Natalie Coombs (the case examiner) and Mr Colin Thompson.

- 4 Mr Edgar's arguments covered both whether the Office was obliged to supply translations of the Japanese documents and whether the invention was in fact new and involved an inventive step as required by sections 1(1)(a) and (b) of the 1977 Act, and I will deal with these two issues separately.

Whether the Office should supply translations of cited documents

- 5 The practice of the Office on this is stated at paragraph 17.104.1 of its Manual of Patent Practice, to which I drew Mr Edgar's attention. As this explains:

“ ... In citing a disclosure found online for example the search examiner may initially rely on an abstract. However a copy of the source document should be obtained and sent to the applicant as soon as possible. Where a source document is not in English, machine translations of the source document should not accompany the document for contractual and copyright reasons, but if a free translation can be obtained (e.g. through another patent office website), reference can be made to this source. ...

The situation regarding abstracts is as follows:

(a) if the search examiner does not have a copy of the source document, (whether because it is not needed or it is unavailable), then the abstract alone issues to the applicant; ...”

- 6 For whatever reason, Mr Edgar was unable to access the Japanese patent websites supplying computer-generated translations to which the Office had referred him. However, he thought that such translations would be inherently inaccurate in any case because they lacked the skills of a linguist who would be aware of the difference between ordinary and technical languages. He further believed that the English language abstracts which the Office supplied to him were wholly unreliable for the same reason and therefore inadmissible at law as material evidence. Mr Edgar argued that by refusing to supply certified translations of the Japanese citations the Office was denying him the right to challenge the specifications and claims in these documents; in his view this conduct was a breach of human rights, was contrary to the principles of natural justice, and a procedural impropriety.
- 7 Mr Edgar reinforced his argument by reference to the following texts, precedents and legislative provisions:
- i. Sections 89A(3) and (5) of the Patents Act 1977 and rules 69-70 of the Patents Rules 2007. Ss.89A(3) and (5) empower the comptroller to require “any necessary translation” of the application and any amendments to it; rr.69(1) and (4) prescribe that translations are necessary, amongst other things, when the published international application and any published amendments thereto are not in English; and r.70 sets out the requirements of necessary translations as regards the parts of the application or amendment which are to be translated. (*See the Annex below for the relevant parts of these and other rules governing translations which are referred to in this decision.*)

- ii. The Office's publication "Patents: Deciding Disputes" which states at paragraph 3.13 that although evidence may be filed in a foreign language, "you may also need to file with it a translation into English".
- iii. The Patents Court Guide, which states that, where a document referred to in a statement of case requires translation, that should be served with the document and the statement of case.
- iv. Paragraph 4.45 of the Office's Patent Hearings Manual¹ which states, in the case where a witness does not speak English, "The parties should themselves endeavour to ensure that any documents on which they wish to (cross) examine the witness in question are translated beforehand into the language in question".
- v. The right to a fair trial under Article 6.1(a) of the European Convention on Human Rights, incorporated into UK law by s.6 of the Human Rights Act 1998, and the commentary thereon in paragraphs 1.17-1.29 of the Patent Hearings Manual. From this Mr Edgar infers that he is entitled "to be informed, in a language which I understand and in detail, the nature and cause of the accusations against me". (I observe that, as stated in paragraphs 1.18-1.19, this point refers to criminal proceedings but could in civil proceedings perhaps be regarded as part of the more generally applicable right to a fair trial under Article 6.1 and as echoing the principles of natural justice.)
- vi. The definition of "procedural impropriety" by Mustill LJ in the *Greater London Council* case² (quoted below).

8 In interpreting these provisions, I am governed both by primary legislation such as the Patents Act 1977 and the Human Rights Act 1998, and by secondary (or "delegated") legislation including Statutory Instruments such as the Patents Rules 2007. However secondary legislation cannot override the express provisions in primary legislation from which it derives its authority and must be read with it. I am also bound by judgments of the House of Lords or the higher courts including the High Court and the Court of Appeal, unless I can distinguish such a judgment on the facts of the case or because it did not decide the point in issue. As regards statements in the practice manuals and guidance literature which the Office issues, these indicate the current practice of the Office but have no legal authority in themselves.

9 The provisions in item (i) above (ss.89A(3) and 5 of the 1977 Act and rr.69-70 of the 2007 Rules) prescribe the translation requirements for international applications for patents, but for the following reasons I do not think they support Mr Edgar's proposition:

- i. As I explained at the hearing, these provisions apply only to international applications made under the Patent Cooperation Treaty (PCT) – they do

¹ This would appear to be the publication "Basic Legal Principles" to which Mr Edgar refers.

² R v Secretary of State for the Environment ex p The Greater London Council and another, Queens Bench Divisional Court, 3 April 1985

not govern “domestic” applications made under the 1977 Act such as the present application. (An international application is a single application designating a number of countries. After search and possibly a measure of examination in the “international phase” the applicant has the option of entering the “national phase” in each of the countries in which he wants a patent to be granted. In the UK national phase, the application will then be examined in similar manner to a domestic examination taking account of any international search or examination carried out under the PCT.)

- ii. They apply only to applications and amendments, not documents cited by an examiner. R.113(5) gives the comptroller the power to direct the filing of a translation into English of any document referred to in an International Search Report which is not in English or Welsh, but it is not mandatory.
- iii. Translations filed in accordance with these provisions are governed by r.115. This does not require the translation to be certified, but if the comptroller has reasonable doubts about the accuracy of the translation he can require evidence that the translation is accurate.

- 10 Therefore as I read them the Act and Rules go no further than giving the comptroller the option, if he wishes, of asking for a translation, which does not have to be certified, of a document cited in the international phase of an international application. I see no reason to infer from this any obligation on the comptroller to supply to the applicant a certified translation of a document cited by an examiner during the search and examination of a domestic application.
- 11 Items (ii)-(iv) above all relate to situations in which two parties bring a dispute before the court or the comptroller. In such cases, I fully accept that the rules of natural justice and the right to a fair trial under the Human Rights Act (see item (v) above) will require procedures such as stated in these documents to enable each party to know what case it has to answer and to be able to examine witnesses fairly and effectively. In such situations it may well be necessary for a party to supply a translation of a document on which its case is founded.
- 12 However, I do not think that the prosecution of an application between the examiner and the applicant as part of the application procedure can be equated with the trial of a dispute. When he or she examines an application, the examiner is not acting as an independent party to a dispute before the comptroller, but is acting on behalf of the comptroller to ensure that the requirements of the Patents Act and Rules are met. The examination is not therefore adversarial in nature; rather it is part of an administrative procedure which may involve negotiation between the examiner and the applicant as to the scope of the monopoly which is to be granted.
- 13 This does not of course absolve the examiner from generally dealing fairly and justly with an applicant or anyone representing him, and I accept that it is appropriate for me to consider whether the examiner’s conduct constitutes a procedural impropriety on the part of an administrative body as explained in the *Greater London Council* case (item (vi) above). In this case the court rejected applications for judicial review of “rate-capping” orders made by the Secretary of

State in purported exercise of powers conferred by primary legislation. In giving the judgment of the court, Mustill LJ sought to flesh out the concept of “procedural impropriety” put forward in earlier case-law³ with a view to isolating particular ways in which a decision-making process by an administrative body might go wrong short of illegality or irrationality and justify intervention by the court. As he put it⁴:

“The following may be identified: (i) Unfair behaviour towards persons affected by the decision. Here are grouped many familiar situations which may, in the right context, justify intervention. For example, failure to inform the person affected by the decision of the case which he has to meet and failure to give him an opportunity to make representations; (ii) Failure to follow a procedure laid down by the legislation, whether primary or delegated, which confers the decision-making power; (iii) Failure properly to marshal the evidence on which the decision should be based. For example, taking into account an immaterial factor or failing to take into account a material factor or failing to take reasonable steps to obtain the relevant information ...; (iv) Failure to approach the decision in the right spirit, for example, where the decision maker is actuated by bias or where he is content to let the decision be made by chance.”

- 14 As I have explained above, the essence of Mr Edgar’s argument is that by refusing to supply anything other than an unreliable (in the sense that it has not been certified by someone with linguistic skills) abstract of a Japanese citation, the Office is effectively relying on material which is inadmissible at law and is denying him the right to mount an effective challenge to the documents. In applying Mustill J’s analysis to this situation I should heed the warning that he gave later in the judgment:

“We, therefore, conclude that there is nothing in the 1984 Act which takes away the jurisdiction of the court to strike down the Order on the ground of procedural unfairness. We must, however, emphasise that this conclusion is no warrant for a process which involves searching all the reported cases on procedural unfairness, compiling a list of all the types of conduct which have been held to be unfair, matching the conduct complained of in the instant case against the list and then, if it is found to correspond with one of the items, asserting that the court should intervene. Fairness is not an abstract concept. Everything depends on the subject matter, terms and policy of the statute; the type of decision which is being made; the nature of the procedure by which it is intended to be reached; and the circumstances of the individual case”

- 15 In my view, I do not think that Mr Edgar’s argument can be supported when one looks at the nature of the examination procedure as I have explained it above. It is not an adversarial dispute in which the examiner is in some way seeking to wrong-foot the applicant by trying to rely on inadequate evidence. If an examiner cites a document to show lack of novelty or inventive step, the question is not whether there is evidence which would be admissible before a court or tribunal. Nor is it a case of the applicant mounting a “challenge” to the cited documents: irrespective of whether a valid patent has been granted on a patent application,

³ By Lord Diplock, in *Council of Civil Service Unions v Minister for the Civil Service* [1984] 3 WLR 1174

⁴ I have taken this quotation directly from the judgment. A slightly abbreviated version is given in Mr Edgar’s witness statement.

its contents form part of the state of the art and can be cited by the examiner in appropriate cases. What has to be resolved is what the document teaches someone who is skilled in the art in question – who in this case would probably be a mechanical or electrical/electronic engineer with experience of producing lighting effects.

- 16 I do not think that this necessarily requires a full certified translation of the document to be supplied in every case – if at all. I accept that the quality of an English language abstract or a machine-generated translation may leave something to be desired from the viewpoint of a qualified linguist, but they may still be, and in most cases are, sufficient to establish what the source document actually teaches the skilled man. It all depends on the particular case. It is of course possible that recourse may be necessary to a certified translation if real doubt remains as to what a significant part of the document teaches, but even then it would be most unlikely that the whole document would need to be translated.
- 17 Therefore in my view, provided the examiner has adequately explained to the applicant the relevance of a cited non-English language document (allowing for the fact that the contractual terms on which the Office obtains access to translations will likely preclude it from sending a copy on to the applicant), there will have been no unfairness or injustice that would constitute a procedural impropriety. In particular, having regard to criteria (i), (ii) and (iv) in *Greater London Council*, I do not think that the examiner could reasonably be said to have failed to inform the applicant of the “case” that he had to meet, to give him an opportunity to make representations, to follow the procedure laid down by legislation (which I have dealt with above), or to approach the matter in the right spirit.
- 18 Also, in regard to criterion (iii), I do not think there would have been any failure to “properly to marshal the evidence” by not taking reasonable steps to obtain relevant information. Mr Edgar’s contention would require the Office to prepare or procure a full certified translation and supply it to the applicant each and every time that a non-English language document is cited by an examiner. Such a procedure would be enormously burdensome and costly given the frequency with which such documents are cited, and I doubt very much whether it would be feasible without a substantial increase in the fees charged by the Office. I do not see how this could possibly be justified as reasonable given that, as I have explained above, a full certified translation will be unnecessary in all but the rarest of cases.
- 19 In my view therefore that the comptroller is not generally obliged to supply certified translations of non-English language documents which are cited by the examiner during the search and substantive examination of an application under the 1977 Act.

Novelty and inventive step

- 20 In the event, it was not necessary for me to consider whether the examiner should have gone any further than she did in regard to translating the Japanese

documents in this particular case. Thus, in its letter of 19 September 2008 the Office had explained that for the hearing the examiner intended to rely only on the English language abstracts and drawings the Japanese citations. Further, notwithstanding his arguments above, Mr Edgar was prepared to highlight specific features of his invention which in his view distinguished it from the cited prior art - even when relying, for the Japanese documents, only on abstracts and drawings.

21 In a further letter dated 23 September 2008 the Office stated that five issues were outstanding:

- Whether claims 1-4, 7-12 and 14 were new (*s.1(1)(a) of the 1977 Act*).
- Whether claims 5, 6 and 13 involved an inventive step (*s.1(1)(b)*).
- Whether the invention was excluded from patentability as an aesthetic creation (*ss.1(1)(d) and 1(2)(b)*).
- Whether claims 3, 4 and 8-12 were supported by the description (*s.14(5)(c)*).
- Whether claims 8-12 were clear (*s.14(5)(b)*).

22 At first sight this seemed difficult to square with the examiner's report of 14 August 2008 in which she referred to specific paragraphs in the description of one of the Japanese citations in respect of claims 2-14. However, I accepted at the hearing that subsequent correspondence had been directed to securing an acceptable formulation to define the widest scope of the invention in claim 1, for which reference to the full text of the description might not be necessary.

23 Taking up this point, Mr Edgar thought that the invention differed from the prior art in the following respects:

- The "holographic effect" on which it relied was different from the holograms shown in the prior art documents.
- In its mechanical construction it differed from the "full moon" fans shown in the citations.

and accepted that it might be necessary for him to restrict the claims accordingly. It seemed to me that even if there was not (at least yet) a meeting of minds between Mr Edgar and the examiner on what amendments would be necessary, there was still a realistic prospect of them resolving the matter by correspondence and discussion without recourse to any further translation of the citations.

24 In the absence of full argument on these points, particularly as to what is the meaning of "holographic effect", I therefore believe that it would be premature for me to try to decide the issues of novelty and inventive step for any of the claims at the present time. Subject to any appeal against my decision (see below), I will

therefore remit the application to the examiner at the end of the appeal period for further consideration of Mr Edgar's arguments and of whether they serve as a basis for distinguishing the prior art constructions for novelty and inventive step. This does not preclude a further hearing if Mr Edgar and the examiner still cannot reach agreement.

Other matters

- 25 I do not think that for now I need to consider the issues of aesthetic effect and lack of support. It was confirmed at the hearing that the question of whether the invention was unpatentable because it related only to an aesthetic effect was intended only as a warning to the applicant not to rely on purely aesthetic features to avoid the prior art. As to the lack of support for some of the claims, the examiner explained at the hearing, and I agree, that this will be probably be a relatively simple matter to resolve if the invention in its widest form can be satisfactorily defined.
- 26 The question of clarity may be more difficult to overcome. The examiner considers the claims in question to lack clarity because they do not adequately define the technical features which are necessary to achieve the result stated in the claim. I think the objection is well-founded, but again it seems to me that its resolution ought to await clarification of the widest scope of the invention, when some at least of these claims may not need to be retained.
- 27 This leads me on to some points which Mr Edgar will need to bear in mind when considering amendment to the specification. It is open to him to discuss these in more detail with the examiner if he wishes:
- The examiner may carry out a supplementary search, for which a fee may be payable in some cases, if she considers that the original search needs to be supplemented (*ss. 17(7) and (8) of the 1977 Act*).
 - It is not possible to add new matter to an application after it has been filed, even if this is what is needed to clarify any obscurities or define any of the terms used in the claims (*s.76(2)*).
 - If in order to overcome difficulties of this nature the applicant wishes to file a new application with a fuller description of the invention, he should do so before the present application is published and before 1 May 2009 – i.e. 12 months from the filing date of the present application - if he wishes to claim a priority date from it (*s.5*).

Costs

- 28 Mr Edgar has asked for his reasonable costs. Under section 107(1) of the 1977 Act the comptroller has power to award such costs, in proceedings before him, as he considers reasonable. However these will generally be only a contribution to the expenses of a successful party, and in any case it is not the Office's practice to award costs following an "ex parte" hearing such as the present which is

essentially a continuation of the Office's administrative procedure.⁵ I see no reason to depart from that practice in the present case, especially since Mr Edgar has not succeeded in his general argument on translations, and I therefore make no award of costs.

Conclusion

29 In summary, I have decided:

- that the comptroller is not generally obliged to supply certified translations of non-English language documents which are cited by the examiner during the search and substantive examination of an application under the 1977 Act;
- (subject to any appeal against my decision) to remit the application to the examiner at the end of the appeal period for further consideration of novelty and inventive step; and
- to make no award of costs.

Appeal

30 The applicant has a right of appeal from my decision to the Patents Court. Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days of the date of the decision stated above.

R C KENNEL

Deputy Director acting for the Comptroller

⁵ For a full explanation, see the section on "Costs" at Chapter 5 of the Patent Hearings Manual, and also paragraphs 6.01 and 6.49

ANNEX TO DECISION O/298/08

(See paragraph 7)

Patents Act 1977 (as amended); emphasis added

National and international phases of application

89A(3) - The national phase of the application begins -

(a) when the prescribed period expires, *provided any necessary translation of the application into English* has been filed at the Patent Office and the prescribed fee has been paid by the applicant; or

(b) on the applicant expressly requesting the comptroller to proceed earlier with the national phase of the application, filing at the Patent Office -

(i) a copy of the application ...

and

(ii) *any necessary translation of the application into English*,

and paying the prescribed fee.

89A(5) - Where during the international phase the application is amended in accordance with the Treaty, the amendment shall be treated as made under this

Act if -

(a) when the prescribed period expires, *any necessary translation of the amendment into English* has been filed at the Patent Office, or

(b) where the applicant expressly requests the comptroller to proceed earlier with the national phase of the application, there is then filed at the Patent Office -

(i) a copy of the amendment, ... and

(ii) *any necessary translation of the amendment into English*;

otherwise the amendment shall be disregarded.

Patents Rules 2007

Necessary translations under section 89A(3) and (5)

69 – (1) A translation is necessary for the purposes of section 89A(3) where any of the following are not in English—

(a) the international application for a patent (UK) as published in accordance with the Patent Co-operation Treaty;

(b) where the information mentioned in paragraph 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, that information.

(2) Where the applicant expressly requests the comptroller to proceed with the national phase before the end of the period prescribed by rule 66(1), the translation must include the request and abstract.

(3) But paragraph (2) does not apply where a copy of the application, as published in accordance with the Patent Co-operation Treaty, is available to the comptroller.

(4) A translation of an amendment is necessary for the purposes of section 89A(5) where any amendment made to the application is not in English and has either been—

(a) published under the Patent Co-operation Treaty; or

(b) annexed to the International Preliminary Examination Report.

(5) At the end of the period prescribed by rule 66(1), the comptroller must notify the applicant that a necessary translation is missing if—

(a) a translation of the application has been filed, but a translation of the amendment has not been filed; or

(b) the information mentioned in paragraph 3(2)(a) and (b) of Schedule 1 (biological material) has been provided, but a translation of that information has not been filed,

and the prescribed fee has been paid.

Requirements of necessary translations

70 - (1) This rule applies to translations which are necessary for the purposes of section 89A(3)

and (5).

(2) Such a translation is necessary for only that part of the application which is in a language other than English.

(3) Where the application includes a drawing which is annotated, the translation shall include either—

(a) a copy of the original drawing where the original annotations have been replaced by annotations in English; or

(b) a new drawing with the annotations in English.

(4) Where a title has been established for the application by the International Searching Authority, the translation must include that title (and not any title which was included in the application as it was originally filed).

(5) Where—

(a) the description of the invention includes a sequence listing; and

(b) the listing complies with the relevant requirements of the Patent Co-operation Treaty, the translation of the application may exclude a translation of the sequence listing.

(6) This rule applies to translations of amendments as it applies to translations of applications and accordingly references to “application” shall be construed as references to “amendment”.

Translations

113 - ...

(5) In relation to an international application for a patent (UK), where any document which is in a language other than English or Welsh is—

(a) referred to in an International Search Report or International Preliminary Report on Patentability; or

(b) cited in an International Preliminary Examination Report,

and the relevant report is filed at the Patent Office, the comptroller may direct that a translation into English of that document be filed.

...

Establishing the accuracy of translations

115 - If the comptroller has reasonable doubts about the accuracy of any translation of a document that has been filed at the Patent Office by any person in accordance with the Act or these Rules—

(a) he shall notify that person of the reasons for his doubts; and

(b) he may require that person to furnish evidence to establish that the translation is accurate,

and where that person fails to furnish evidence the comptroller may, if he thinks fit, take no further action in relation to that document.

R C KENNEL

30 October 2008