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PATENTS ACT 1977

IN THE MATTER OF an application under Section 72(1) by Fosroc International Ltd for revocation of Patent No 2279664 in the name of Concrete Repairs Ltd.

Pat / Linda
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PRELIMINARY DECISION

Patent application GB9413047.3 was filed on 1 July 1994, and was granted as Patent No. GB2279664 to Concrete Repairs Limited ("CRL") on 4 September 1996. The application for revocation was filed on 12 September 1996 by Fosroc International Limited ("Fosroc") accompanied by a supporting statement under Rule 75(1). CRL responded with a counterstatement on 9 December 1996. In a letter received on 15 January 1997, representatives for Fosroc claimed that the counterstatement was totally inadequate, and asked that the Office require that the counterstatement be remedied or to be heard should the Office decline. In the event, a hearing was offered to determine the matter. In response, CRL objected to the appointment of a hearing and requested a hearing to determine whether there ought to be a preliminary hearing to decide the adequacy of the counterstatement. CRL's request was granted and following that hearing I decided that it was appropriate to hold a preliminary hearing to determine the adequacy of the counterstatement. The matter was accordingly heard before me on 26 March 1997. Mr L Shaw (Patent Agent) represented the applicants and Mr B Reid (instructed by P Gladwin & Co) represented the patentees.

The applicants' statement lists the grounds for revocation as:

(i) that the specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art (Section 72(1)(c))

(ii) the matter disclosed in the specification extends beyond that disclosed in the application for the patent (Section 72(1)(d)); and

(iii) that the invention is not a patentable invention in that the claims define matter devoid of inventive step (Section 72(1)(a)).

The statement then continues with a list of relevant passages from the patent which, it is alleged, lack clarity or sufficiency, or represent added matter. Finally, it is suggested that claims 1-4 lack an inventive step in the light of CA2040610 and an article entitled "Neutralisation of chloride in concrete" by C Lankard *et al.*

In the counterstatement, CRL firstly deny that the patent contravenes Section 72 as alleged or at all. There then follow specific rebuttals of, or assertions against, each of the allegations made by Fosroc.

In their communication objecting to the counterstatement, Fosroc identify a number of specific passages which they claim are unclear, or do not address the points raised in the statement, or are irrelevant.

It was Mr Shaw's case that the counterstatement did not comply with the requirements of Rule 75(3) of the Patents Rules in that it did not set out fully the grounds upon which the application was contested. He drew my attention to various passages in the counterstatement, which, he alleged, were not clear, or appeared to be irrelevant. This, he suggested, left the applicants in some difficulty in constructing their case.

Mr Shaw referred me to *Wollard's Patent* [1989] RPC 141 in which the Hearing Officer ordered that the proprietor file an amended counterstatement and said, at line 24 on page 145: "in order to clarify the issues or reduce the amount and scope of the evidence and argument which might be necessary otherwise, some explanation should be demanded of the proprietor short of requiring him to produce argument as to how his claims should be construed". Mr Shaw also drew my attention to the decision in *Polaroid Corporation's Patent* [1977] FSR 243. In that case the Appeal Court upheld the decision of Graham J to direct the proprietors to provide further and better particulars in response to matters

particularised in an insufficiency plea by the petitioners for revocation.

Mr Reid, in referring to *Marshall's Application* [1968] RPC 83 in which the Patents Appeal Tribunal affirmed the Hearing Officer's decision to dismiss an objection to the counterstatement, drew my attention to four passages in that decision. Firstly, on page 84 line 40, the Hearing Officer states that "the onus for establishing a ground of opposition is always on the opponent ...". Then on page 84 at line 44, he says "each ground of opposition so supported in the statement should be answered by the [patent] applicant in the counterstatement by way of admission or denial or by an offer to amend the specification with the object of avoiding the opposition". On page 85 at line 22, he adds "it is not necessary for the counterstatement to contain argument", and finally, at line 40 of page 85, he says "he [the patent applicant] is not required to argue or deal seriatim with every point of detail, particularly of construction and argument, advanced by the opponents, but he must reply to each of the grounds relied upon".

Mr Reid went on to argue that the counterstatement began with a general denial of all the grounds, and that alone, without the further details of the counterstatement met the requirements set out in the decision in *Marshall's Application.*

Rule 75(3) of the Patents Rules states that:

> Within the period of two months beginning on the date when such copies are sent to him, the proprietor of the patent shall, if he wishes to contest the application, file a counter-statement in duplicate setting out fully the grounds upon which the application is contested; and the comptroller shall send a copy of the counter-statement to the applicant.

In the present case, the applicants, Fosroc, seek revocation on three grounds; firstly that the specification is insufficient, secondly that the specification contains added matter, and thirdly that certain of the claims lack an inventive step. In relation to the first two grounds, their statement particularises various passages in the description and claims where they allege insufficiency or added matter, and in relation to the third ground, they set out the prior art

on which they rely, and brief reasons why the believe that this art shows that claims 1-4 lack an inventive step. In their counterstatement, the proprietors, CRL, begin by generally denying that the patent contravenes the Patents Act as alleged, or at all. They then set out what would appear to be particularised responses to the matters alleged in the statement.

In determining the suitability or otherwise of the counterstatement, I am grateful for the guidance given in the precedent cases brought to my attention. In *Marshall*, I take note that the Hearing Officer indicated that each ground of opposition supported in the statement should be answered in the counterstatement by way of admission or denial or by an offer to amend. Looking at the counterstatement in the present action, it can be seen that it commences with a denial of all the grounds in the statement. Had it stopped there, it is certainly open to question whether the counterstatement would have fulfilled the requirements of Rule 75. However, it does not stop there, but goes on to respond to the majority if not all the specific allegations set out in the statement.

The Hearing Officer in *Marshall* also said, at line 12 of page 85, in a passage not specifically brought to my attention, that "the matter contained in a counterstatement must, to some extent, depend on the manner in which the opponent's case is set out in the statement and, in general, it is to be expected that a full and detailed statement will be answered by a counterstatement in greater detail than will be the case where the statement is vague and general in its terms. All grounds in the statement should be dealt with." This, it seems to me, is what the counterstatement has done, ignoring for a moment the substance of the points made.

The question, then, that remains is whether the counterstatement in substance meets the requirements in answering the case raised by the applicants in their statement. Mr Reid admitted, that with the benefit of hindsight, some of the responses in the counterstatement might have been better put. He also conceded that the counterstatement probably contained a typographical error in that it appeared that a patent number had been misquoted. Mr Shaw was concerned about the relevance of several passages, which did not appear to be direct responses to points made in the statement, and suggested that his clients were at a disadvantage in that they were not sure what to put in their evidence.

I am not persuaded by Mr Shaw's argument. As the Hearing Officer said in *Marshall*, the onus in establishing a ground of opposition lies with the opponent, and thus it is not for the proprietor to give arguments in his counterstatement. In *Wollard*, the proprietors were countering a request for a declaration of non-infringement by asserting infringement. It was held that their assertion of infringement was not clearly made out , and in those circumstances, they were ordered to amend their counterstatement to clarify their allegations of infringement. The present case is, in my view, distinguished from *Wollard* in that there is no burden on the proprietor in this case to prove a positive averment.

In *Polaroid*, the petitioners for revocation had alleged insufficiency with regard to the description of a particular example, and had enumerated a large number of specific respects in which they regarded that portion of the description insufficient. In reply, the proprietors had merely asserted that the description was sufficient. In that case, the Court of Appeal took what they acknowledged as a perhaps unusual step of ordering further and better particulars in response to the specific points made by the petitioners. In doing so, they emphasised that such requests for further particulars should be treated on the merits of the case. Again, I think that the circumstances of the present case differ from those in *Polaroid.* The proprietors have not merely responded with a bare denial of the allegations set out in the statement; they have made a specific response to each of the individual allegations.

I therefore come to the conclusion that the applicants have not made out their case and thus I decline to order the proprietors to amend their counterstatement. As this is a procedural matter, any appeal should be lodged within 14 days.

On the question of costs, I make no order, the normal practice being to consider these at the conclusion of the substantive hearing. With regard to the future conduct of this action, I now direct that the applicants have 2 months from the expiry of the appeal period in which to file their evidence, and that the proprietors have 2 months from the receipt of the applicants' evidence in which to file their evidence. The applicants will then be allowed 2 months from the receipt of that evidence to file any further evidence in reply.

Dated this 17th day of April 1997.

D L WOOD

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE