

**PATENTS ACT 1977**

IN THE MATTER OF an application by  
Canon Kabushiki Kaisha for the revocation of  
Patent No 2155815 in the name of  
Ricoh Company Limited

**DECISION**

Patent No 2155815 was granted pursuant to Application No 8507707 which was filed on 25 March 1985 claiming priority from Japanese Patent Application No 59/054314 dated 23 March 1984. The patent is concerned with a method of ink jet printing.

The application for revocation of the patent, together with a statement, was filed by Canon on 31 July 1989 inter alia on the grounds that the invention is not new and/or involves no inventive step having regard to:

- a) US Patent No 4371582 (Sugiyama et al) which was issued on 1 February 1983 and made available to the public on that day; and
- b) K E Edds et al, IBM Technical Disclosure Bulletin, Volume 22, No 8A, pages 3301-2 (January 1980) which was made available in the British Library Science Reference and Information Service on 6 February 1980.

In their counterstatement filed on 6 December 1989 the patentees offered unconditional amendments in order to distinguish the claims from the prior art referred to in the statement but, in their letter of 30 March 1990 to the Comptroller, the applicants submitted that discretion to permit amendment of the patent should be refused because the patentees had been aware of the Sugiyama and Edds publications during the prosecution of the corresponding United States application before the grant of the British patent and, consequently, had maintained claims which they knew were unsustainable in the light of these

publications. The applicants asked for the question of discretion to be considered as a preliminary issue on the ground that, if discretion were to be refused and the patent revoked as a result, the necessity for both sides to go to the inconvenience and expense of filing technical evidence would be avoided. The patentees resisted this approach and the matter came before me at a hearing following which I issued a preliminary decision dated 21 May 1991 to the effect that I was satisfied that this was an appropriate case for the question of whether the Comptroller should exercise discretion to permit amendment of the granted patent to be decided as a preliminary issue and allowing 3 months for both sides to file evidence in the matter.

In the event both parties subsequently declined to file evidence in connection with this question and the patentees further conceded in their Agents' letter of 20 August 1991 that one or other of the Sugiyama or Edds references constitutes an anticipation of claim 1 of the British patent as granted.

Because of this and since the patentees further indicated that they did not wish to be heard in the matter, the view was expressed in an Official letter of 21 October 1991 that the Comptroller was minded to issue a decision without a further hearing refusing to exercise discretion to allow the patentees to amend and, as a consequence order the revocation of the patent which stands invalid. No objection having been raised by either party to this course of action, it remains for me formally to consider the issues.

Claim 1 of the patent as granted reads as follows:-

"A method of ink jet printing which comprises ink jet printing an ink onto a recording sheet comprising a base material having a surface recording layer, containing a surface active agent, which surface active agent, on contact with the ink does not form a material, insoluble in the ink composition printed upon the recording material, in combination with dye contained in the ink."

The claim as filed was directed towards the recording sheet per se but was amended, at least in part, as a result of a number of citations made by the examiner.

In the corresponding application in the United States of America, the original claims as filed were identical in scope with those in the British Application. During the prosecution of the US application the Sugiyama and Edds documents were cited by the US examiner and the claims of the application were amended to take account of these disclosures. The claims accepted by the examiner in the United States are to recording sheets per se but the surface recording layer is defined more narrowly than that employed in the process claimed in the granted British Patent. In effect the US application was amended to exclude the use of non-ionic surface active agents from the surface recording layer which, in essence, is the amendment which the patentees offered unconditionally in their counterstatement in these revocation proceedings. I do not think that it is necessary for me to consider any further the grounds on which the revocation is based in view of the concession by the patentees that claim 1 of the granted patent is anticipated and I am satisfied, having studied the Sugiyama and Edds documents, that the patent is invalid as it stands.

Turning to the question of whether the Comptroller should exercise discretion to allow the patent to be amended, the kernel of the applicants' argument is that the patentees filed amendments in their final response to the Sugiyama and Edds documents during the prosecution of the US application in December 1986 but, in their response in April 1987 in respect of the British Application, the patentees did not draw attention to the Sugiyama or Edds references, nor did they add any of the limitations to the claims of the British application as they had done in the USA. On this basis it is the applicants' contention that the patentees should not now be permitted in the revocation proceedings to make an amendment which they could and should have made as early as April 1987.

Whilst it was not accepted on behalf of the patentees at the preliminary hearing that the Sugiyama and Edds references are clearly anticipatory of the unamended claims of the patent in suit and it was further suggested that there may be differences between US and British law and practice as to what constitutes an anticipation, the patentees have since conceded that one or other of these references is anticipatory of claim 1 of the patent. Furthermore they have failed to offer any explanation by means of formal evidence or otherwise as to why the

claims of the British application were not amended prior to grant, as had the claims of the corresponding US application, or why amendment of the patent had not been sought after grant in the period of nearly two years prior to the launching of this revocation action.

The allowance of amendments after grant is a matter of discretion and it is well established that the conduct of the patentee is a factor to be taken into account in deciding whether to allow amendment. Thus, in Armco Steel Corporation's Application [1969] FSR 33 it was held that consent to amend may be refused if it is apparent that the proprietor has been aware for some considerable time of prior art which renders his unamended patent prima facie invalid, but has not hitherto taken any steps to rectify this, even though he may not have appreciated the legal significance of the prior art.

The judgement of the Patent Appeal Tribunal in Imperial Chemical Industries (Whyte's) Patent [1978] RPC 11 further emphasises the necessity of a patentee seeking to amend once his attention has been drawn to a defect in his patent by stating at page 23 line 12:

"On the other hand, once a patentee has had his attention drawn to the fact that his claim is unjustifiably wide, and this may well take place on the course of any, including amendment, proceedings, he will be liable for the consequences if he does not take proper steps within a reasonable time to cure by amendment the defect which has been drawn to his attention."

More recently, in Smith Kline & French Laboratories Ltd v Evans Medical Ltd [1989] FSR 561, Aldous J identified the following principles concerning the exercise of discretion as to whether or not to allow amendment:

- (i) the onus to establish that amendment should be allowed is upon the patentee and full disclosure must be made of all relevant matters;
- (ii) amendment will be allowed provided the amendments are permitted under the Act and no circumstances arise which would lead the court to refuse the amendment;

- (iii) it is in the public interest that amendment is sought promptly, so a patentee who delays for an unreasonable period before seeking amendment must show reasonable grounds for his delay;
- (iv) a patentee who seeks to obtain an unfair advantage from a patent, which he knows or should have known should be amended, will not be allowed to amend;
- (v) the court is concerned with the conduct of the patentee and not with the merit of the invention.

Finally, mention may be made of Bentley Engineering Co Ltd's Patent [1981] RPC 361 where, similar to the present case, the patentees had allowed their UK application to be accepted and had requested the sealing of a patent in what should have been the full knowledge that their complete specification had claims equivalent in scope to certain claims of their corresponding US application which they had already proposed should be necessarily restricted in scope to avoid anticipation by a document cited during the prosecution of the US application. The Comptroller's refusal to allow amendment on the grounds that patentees had knowingly and deliberately obtained and maintained a claim of unjustified width was upheld by the Patents Court.

To return to the present case, on the face of it the claims of the US application were amended prior to grant in the light of the Sugiyama and Edds documents. In this respect, the papers show that the patentees were made aware in a US Official letter of December 1985 of this prior art which, it is now conceded, renders the main claim of their British patent invalid, and further that by December 1986 they had appreciated the significance of these citations and filed amendments to their US application to meet them by exclusion of the use of non-ionic surface active agents from the surface recording layer. Despite this, they made no consequential limiting amendments when responding in April 1987 to the British examination report and allowed a prima facie unjustifiably broad claim to proceed to grant and have maintained it subsequently. As I have said earlier, I have been given no explanation of the patentees' conduct in respect of their prosecution of the British application

and, accordingly, I do not consider that the Comptroller's discretion should be exercised in their favour.

In the light of my refusal to allow amendment, the patent in suit stands invalid. The Patentees have conceded in their Agents' letter of 20 August 1991 that one or other of the Sugiyama or Edds references constitutes an anticipation of claim 1, and I am satisfied that this is the case. Accordingly I order the revocation of UK Patent No 2155815.

Finally I turn to the question of costs which both sides have sought. Although this action did not proceed to the evidence stage, the applicants were put to the trouble of arguing their case at a preliminary hearing before anticipation was conceded by the patentees and the patentees have made no attempt whatever to explain their actions. I therefore award the applicants for revocation (Canon Kabushiki Kaisha) the sum of £400 (four hundred pounds) by way of contribution towards their costs and direct that this sum be paid by the patentees (Ricoh Company Limited).

Dated this 19 day of March 1992



P J HERBERT  
Superintending Examiner, acting for the Comptroller

**THE PATENT OFFICE**