

PATENTS ACT 1949

B 20 / 167 / 86

IN THE MATTER OF an application  
by Bucher-Guyer AG Maschinenfabrik  
to amend specification No 1302844

and

IN THE MATTER OF an opposition  
thereto by P J Zweegers en Zonen BV

PRELIMINARY DECISION

The patentees sought leave under Section 29 of the Patents Act 1949 to amend their patent no. 1302844 because of prior disclosure in UK specification 662303. The amendments were advertised in the Official Journal dated 28 November 1984. Oppositions were entered by four parties although only the present one survives.

On 14 April 1986, the opponents proposed amendments to the Notice of opposition and the statement of case 'in the light of the evidence filed by the opponents in these proceedings'. The applicants declined to give their consent and a preliminary hearing was requested to determine the point.

At a hearing before me on 16 October 1986 Mr Simon Thorley appeared as counsel for the applicants to amend the statement of case (opponents) and Mr Richard Hacon appeared as counsel for the applicants for amendment (patentees).

The original Notice of opposition contained the following grounds:-

- (i) The proposed amendments do not comply with Sections 29 and 31.

(ii) There has been undue delay in making the application for amendment.

(iii) The amendments are not clear and/or introduce ambiguity.

(iv) The amendments should be refused in the exercise of the Comptroller's discretion.

The amended Notice amplified (ii) by addition of the phrase 'and a lack of candour in making the same' and added a further ground:

(v) The amendment proposed does not achieve the effect desired by the patentees of dealing with the prior art.

The parts of the opponents' statement relevant to the first application are paragraphs 10 to 12. I can summarise them simply by saying that paragraph 10 asserts that the patentees had been aware of the new prior art for several years before they applied to amend; paragraph 11 asserts that the patentees wrote to the opponents alleging infringement of the patent after the patentees had become aware of the prior art but before they applied to amend; and paragraph 12 pleads the legal consequences that should follow from the facts set out in paragraphs 10 and 11, namely:-

"Thus, it is maintained that the patentees have delayed unduly in making the application to amend. For this reason, or for other reasons, amendment should be refused in the exercise of the Comptrollers discretion".

The opponents now apply to amend the first sentence of paragraph 12 to read:-

"Thus, it is maintained that the patentees have delayed unduly and/or have shown a lack of candour in making the application to amend".

It was agreed by Counsel at the hearing that this amendment merely gave notice of the argument that could be presented at the substantive hearing, and I decided to allow it. The opponents may also amend paragraph (ii) of the Notice of Opposition as requested.

The second application by the opponents is to amend their statement of case by adding a new paragraph 13a which reads as follows:-

"The amendment proposed by the patentees to distinguish from the prior publication GB 662303 (Goodall) is merely to add into the claim a feature of a disc-type mower which has been shown by the opponents to have been common general knowledge at the priority date. The addition of a mower to equipment for conditioning cut grass constitutes a mere collocation. Also claim 1 as proposed to be amended is anticipated by the publication of 'The Engineer' of 12 July 1968".

This application highlights an apparent conflict between two principles on which these cases have been decided in the past, one that the Comptroller will not allow an amendment that leaves a patent clearly invalid, and one that the Comptroller will not permit amendment proceedings under Section 29 to be expanded into a roving inquiry into the validity of the patent (for which the authority cited at the hearing was Great Lakes Carbon Corporation's Patent [1971] RPC 117 at 126). Mr Thorley's main argument was that to point to one clear anticipation of the patent could not be regarded as embarking on a roving inquiry into validity. In addition, he submitted that, as was usual in patent litigation, it was necessary to lead evidence to give the hearing officer the background information that the skilled man

would have - in this case as I understand it the information that was common knowledge among agricultural engineers in 1969. Therefore, if the patent was clearly invalid in the light of that common knowledge, it would be wrong of the hearing officer to ignore the situation.

In my view Mr Thorley's submission does not properly take account of the policy associated with these proceedings. It is in the public interest that a patent granted in ignorance of some defect in it should be corrected as soon as possible. The patentee is under a positive obligation to have it corrected without undue delay, and if he neglects this obligation he risks being left with an incurably bad patent. The counterpart of this obligation is that the patentee should be encouraged to amend by making the procedure as straightforward as possible. As a general rule, if the patentee notifies the Comptroller of a specific defect and puts forward a proposal for correcting it, the Comptroller will not go out of his way to search for other flaws.

An opponent may legitimately argue that proposed amendments do not in fact remove the defect they are intended to remove (see for example James Gibbons Ltd's Patent [1957] RPC 158 at p. 163) but such an argument must in my view be based on the evidence that is already before the Comptroller. In the present case the proposed additional paragraph 13a to the opponent's statement alleges that the amended claim is invalid in the light of common general knowledge and an article in "The Engineer", as well as the prior publication introduced by the patentees.

The idea that a brief inspection of one new document might shorten these proceedings is superficially an attractive one, but Mr Hacon told me that the patentees would argue strongly that the article in "The Engineer" was not an anticipation. It therefore seems unlikely that time and effort will be saved by admitting this document. I also do not believe that the opponents will be prejudiced by my ignoring the article, because they can either apply under section 32 or 33 for the patent to be revoked, or, if

the invalidity is as clear as they say, simply proceed as though the patent did not exist.

Turning now to the issue of common general knowledge, Mr Hacon argued against the admission of any further evidence since any breach of a general embargo would inevitably lead to the roving inquiry into validity which was disapproved in Great Lakes, though he did not object to such common general knowledge as was within the purview of the hearing officer.

As stated above, Mr Thorley argued that it was perfectly proper and, indeed, necessary for the hearing officer to be instructed as to the knowledge expected of a man skilled in the art at the relevant date; he further pointed out that it was a matter of chance whether any particular hearing officer already possessed the necessary technical knowledge.

In my view however, this jurisdiction has been given to the Comptroller precisely because of the technical expertise of his hearing officers, which avoids the expense of supplying the technical background to each case. In contrast, the Court's comparable jurisdiction under section 30 is to be exercised within infringement or revocation proceedings, when a more extensive appraisal of the prior art is appropriate. It is true no doubt that one hearing officer's background knowledge will be different from another's, but that is relatively unimportant. The primary purpose of section 29 proceedings is to deal with voluntary proposals by patentees to amend; whether extraneous deficiencies in the patent are spotted at the same time is a secondary consideration.

It follows that I must refuse leave to add paragraph 13a. However I would be prepared to accept an addition to the statement asserting that "The amendment proposed by the patentees fails to distinguish the claims from UK patent specification No 662303 (Goodall)". The proposed introduction of ground (v) into the notice of opposition is allowable since the reference to the

'prior art' must be taken to mean 'Goodall'.

The patentees have also asked me for a ruling that statutory declarations by Mr Arthur and Mr Lewis, filed by the opponents, are inadmissible. These declarations are mainly or wholly concerned with the matter raised in the proposed paragraph 13a; they do not appear to be in support of the opponents' case as set out in their statement as I have permitted it to be amended. I therefore rule that these two declarations are inadmissible as evidence in these proceedings. The opponents are of course at liberty to seek leave to file other evidence in support of their case.

Finally, the patentees ask for a direction that time for filing evidence in support of their case under Rule 43 should run from the date of this decision. Mr Thorley did not oppose this application, and I am satisfied that the request is reasonable. I direct that such evidence should be filed within three months of the date of this decision.

Dated this 18<sup>th</sup> day of November 1986

W J LYON

Superintending Examiner, acting for the Comptroller

PATENT OFFICE

