

PATENTS ACTS 1949 AND 1977

BLO/041/85

IN THE MATTER OF an application  
for a declaration of non-infringement  
of Patent No 1179723 by  
South African Inventions Development Corporation

AND

IN THE MATTER OF PATENT NO 1179723  
in the name of British Railways Board

PRELIMINARY DECISION

Application is made under Section 71 of the Patents Act 1977 for a declaration of non-infringement of Patent No 1179723. The patentees have requested a preliminary hearing to seek directions that the applicants be directed properly to plead their case on invalidity, that the patentees should have leave to file evidence to answer that case, that certain experimental evidence be excluded, and that the applicants' contention to widen the scope of the proceedings by the substitution or addition of a new-allegedly non-infringing construction be rejected. At the hearing leave was canvassed on behalf of the applicants to amend the statement or to file a further supplementary statement to amplify the details of the proposed act in respect of which the declaration is sought.

At the preliminary hearing before me on 31 January 1985 to determine the above issues Mr N Pumfrey appeared as Counsel for the patentees and Mr D Young QC appeared as Counsel for the applicants.

At the outset both Counsel agreed that the applicants should file a further statement pleading their case on invalidity, and that the patentees should have leave to file evidence strictly in reply. So the argument at the hearing revolved around the questions of allowability of certain evidence and the amendment of the particulars of the proposed act.

Claims 1 and 2 of Patent No 1179723 are as follows:-

1. A railway vehicle having at least two wheel-sets, each with a live axle mounted at each of its ends in a respective axle bearing, wherein at least one axle bearing of one wheel set is elastically interconnected with at least one axle bearing of the other wheel-set through bracing means which serve no vertical load carrying function at least intermediate their connections to the axle bearings, said bracing means providing bracing between the wheel-sets which produces restoring forces to relative displacements of the wheel-sets from their parallel and aligned position and wherein the vehicle body is supported on the wheel-sets in a manner offering substantially no restraint to horizontal rotation of the vehicle body relative to the wheel-sets.
  
2. A bogie for a railway vehicle, the bogie having at least two wheel-sets, each with a live axle mounted at each of its ends in a respective axle bearing, wherein at least one axle bearing of one wheel-set is elastically interconnected with at least one axle bearing of the other wheel-set through bracing means which serve no vertical load carrying function at least intermediate their connections to the axle bearings, said bracing means providing bracing between the wheel-sets which produces restoring forces, to relative displacements of the wheel-sets from their parallel and aligned position and wherein the bogie is adapted to support a vehicle body in a manner offering substantially no restraint to horizontal rotation of the vehicle body relative to the wheel-sets.

As shown in Figure 1 of the specification axle bearings are interconnected by braces 9, 10, 11, 12, each brace comprising, as shown in Figure 2, a tubular strut 16 connected to end fittings 17 by rubber washers 18 to give the required elasticity to the braces.

The applicants in a letter dated 22nd October 1981 wrote to the patentees requesting an acknowledgement that exploitation of a "Scheffel" bogie as disclosed in a pamphlet and drawing accompanying the letter would not be an infringement of any of the claims of Patent No 1179723. The patentees replied that from the information provided they were not in a position to give the acknowledgement required.

As described in the pamphlet, bracing between the wheel-sets is provided by a pair of diagonal links each comprising a lightweight, flexible cross-anchor which is pin-jointed to the subframes of the wheel sets "by means of high-strength urethane bushes which accommodate the minute movements without wear".

No further details of the construction of the links are given in the pamphlet or drawing. In the statement accompanying this application it is stated that the links are rigid. However the patentees in their counter-statement, paragraph 9, state that the features of the linkage referred to in the pamphlet imply that the "linkage arrangement has some elasticity", and refer in support to a passage in the applicants' specification No 1495072 which describes a bogie apparently identical, according to the patentees, to the Scheffel bogie. This passage at lines 110-119 on page 2 clearly states that the diagonal interconnection between the wheel sets is flexible.

Thus the precise construction of bogie in respect of which a declaration is sought is not clear. Mr Young on behalf of the applicants offered to put into the statement further details of the Scheffel bogie which are contained in an affidavit by Dr Scheffel. Mr Pumfrey in reply stated that amending the statement in this way would render it not a description in relation to which his clients have ever been asked for an acknowledgement.

The applicants are also now seeking a declaration in respect of a modified bogie in which the diagonal links are pin-jointed to the sub-frames directly by steel pins without the use of urethane bushes and in which the pins and links are as shown in a pair of drawings. The patentees have declined to give the applicants an acknowledgement of non-infringement of this modified bogie, and the applicants have filed a Second Supplementary statement in which they propose that a "notional new application" in respect of this modified bogie be consolidated with the present application. They argued that the major part of the evidence which has been filed in this application would be duplicated in a new application and that consolidation would avoid an enormous waste of time and effort of all concerned.

Before an application can be made under Section 71 the intending applicant has to apply in writing to the patentee "for a written acknowledgement to the effect of the declaration or declarator claimed and (to) furnish him with full particulars in writing of the act in question". It is readily apparent that the particulars furnished must be sufficiently detailed for the patentee to determine whether the act in question falls within the scope of his patent. It is clearly essential for any difference between the act and the invention claimed in the patent to be brought out whether the difference relates to the absence, or to the replacement, of a feature claimed. The furnishing of full particulars is clearly a prerequisite to the initiation of a Section 71 application. Scarman L J (as he then was) when referring to the similar need for the court to have full details stated in Mallory Metallurgical Products Limited v Black Sivalls and Bryson Incorporated [1977] RPC at page 345, where he was concerned with the similar provisions of Section 66 of the Patents Act 1949:-

"Nevertheless, this is clear that, if, as in this case, the article has not been produced but the plaintiff chooses to rely solely on the description contained in his particulars, the description must be sufficiently clear and precise to enable the court to declare that an article corresponding with the description would not constitute an infringement.

The burden of proving the absence of infringement rests, in my judgement, upon the plaintiff. If there be lack of clarity or precision, the court is not in a position to grant the declaration sought."

I accordingly consider that it would be grossly unfair on the patentees to allow the applicants to amend their statement to give further particulars of the proposed act three years after they had filed the application and over three and quarter years after they had requested an acknowledgement from the patentees. It is essential for applicants seeking a declaration to supply the patentees with full particulars when they apply for a written acknowledgement from the patentees before proceedings under Section 71 are started.

Similarly I do not consider it proper for a modified construction to be substituted for or added to the originally proposed act. The present cause of action arises from the failure of the patentees to give an acknowledgement in respect of the original construction. Any different construction relates to a separate cause of action.

If the applicants consider the particulars they have given with regard to the present application are insufficient or if they wish to pursue an application in respect of the modified construction the proper course to follow would appear to be to ask the patentees for a written acknowledgement giving them full particulars of the proposed act or acts, and if the acknowledgement is not forthcoming to file a new application under Section 71. Either party could then apply, if it was thought propitious, for the evidence on this application to be used on the new application and for there to be a joint hearing. It may well be of course that if the patentees were given further particulars they might decide to give the desired acknowledgement and thus the present proceedings could then be terminated.

The patentees seek to have experimental evidence relating to the alleged behaviour of the Scheffel bogie and contained in an affidavit by a Dr Hunt excluded from these proceedings. The applicants claim that this evidence is corroborative of the submission that the Scheffel bogie does not have the elastic interconnection required by the apparatus of claims 1 and 2.

Dr Scheffel in the applicants evidence in reply had stated that the diagonal links in the Scheffel bogie had a stiffness of more than 50 MN/m each. In a letter dated 15th December 1983 to the applicants the patentees stated that if this evidence of stiffness could be corroborated by independent tests carried out in the presence of representatives of the patentees then the patentees would give the desired acknowledgement under Section 71. In a letter dated 8th May 1984 on behalf of the applicants it was stated not to be a practical proposal in view of the high expense to transport a bogie to the UK and to set up and arrange for the appropriate tests to be carried out. In reply the patentees offered the use of their own existing test rig at Derby. This offer was also declined in view of the unacceptable expense and the anticipated time and difficulty in settling an agreed test procedure.

Mr Pumfrey argued that as the applicants were proposing to rely on Dr Hunt's evidence his clients should have an opportunity to see a repetition of the experiments. He stated that it was standard practice in patent proceedings that if one side wished to rely upon any experiment that party should afford the other party an opportunity, if so requested, of inspecting a performance of the experiment. In support of this contention he referred me to paragraph 104/10/3 of the Supreme Court Practice which sets out a specimen order for directions in infringement or revocation proceedings. He also submitted that American Cyanamid Company v Ethicon Limited [1978] RPC 667 provides support for his contention that there is clearly a discretion to exclude experimental evidence if an adequate opportunity for inspection is not afforded.

In reply to this argument Mr Young asked on behalf of the applicants what was the unfairness in allowing the experimental evidence, what was the

prejudice to the patentees. He contended that a declaration if granted would not cover a non-rigid diagonal linkage and would therefore not prevent the patentees from suing the applicants should they import a bogie which had an elastic linkage. He submitted that this case differed from "American Cyanamid" because Mr Hunt's evidence was not about facts upon which the whole basis of non-infringement hinges but was just corroborative of the description of the bogie.

I consider that there is substantial force in Mr Pumfrey's contention that Dr Hunt's evidence be disallowed because no opportunity has been given for the patentees to see a repetition of the experiments. In these proceedings the Comptroller has been asked to give a declaration based on what the pamphlet and the drawing show. The applicants case is apparently that the linkage in their bogie is rigid and that there is no elastic interconnection. However this feature is not apparently explicit from consideration of the pamphlet and drawing alone. The applicants seem to be arguing however that the linkage in the bogie as shown in the pamphlet and drawing is necessarily rigid, and in support they are relying on Mr Hunt's evidence at least in part. While it is clear from the case of Plasticisers Limited v Pixdane Limited [1978] F.S.R. page 595, to which I was referred by Mr Young, that it is not necessary for proceedings under the Section that an actual article should be provided - it being necessary only that there should have been furnished full particulars in writing of the process or article in question - nevertheless if applicants under Section 71 are not able to specify in the particulars they have supplied of the act in question the alleged distinction between the act and the patent in suit but rely instead on experiments, it seems to me to be entirely reasonable and in agreement with practice in patent matters before the court for the patentees to be entitled to see a repetition of the experiments. This is especially so in this case where the patentees have not had an opportunity to inspect the bogie. I accordingly decide that Dr Hunt's evidence be excluded from the proceedings.

I accordingly direct as follows:-

- (a) that Dr Hunt's evidence be excluded from these proceedings;
- (b) that there be no amendment of the statement on this application either to give further particulars of the bogie or to add the modified construction of bogie in which the connections between the cross-links and sub-frames are bush free. The second supplementary statement filed on 13th September 1984 is accordingly disallowed;
- (c) that the applicants should file a supplementary statement pleading their case on invalidity within one month of the date of this decision and shall send a copy to the patentees. The patentees shall have leave to file a supplementary counter-statement and evidence confined strictly to matters in reply to the new pleading within two months of the receipt by the patentee of the statement.

These being procedural matters, in accordance with RSC Order 104, Rule 14(2)(a), any appeal must be lodged within 14 days of the date of this decision.

Dated this 21<sup>st</sup> day of March 1985

J SHARROCK  
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

