

0/108/94

PATENTS ACT 1977

IN THE MATTER OF proceedings for
revocation under Section 73(2) of patent
No 2175786 in the name of Amoy
Margaret Assing-Collier

DECISION

In accordance with the provisions of Section 73(2) the examiner issued an official letter on 4 August 1993 informing the patentee that the invention claimed in claim 1 at least of patent No 2175786 B (hereinafter the 'UK patent') was the same as that claimed in claim 1 at least of European patent No 0250426 B1 designating the UK (hereinafter the 'EP(UK) patent'). The patentee replied by way of her Agent's letter of 5 October 1993 arguing that the two patents did not in fact relate to the same invention. Two further rounds of correspondence comprising official letters of 29 October 1993 and 10 January 1994 and Agent's letters dated 15 December 1993 and 3 March 1994 of reply failed to resolve the matter and, following a further official letter of 18 March 1994 maintaining the objection, the patentee asked to be heard in the matter before the Comptroller decides whether he is required to revoke the UK patent. As a result, the matter came before me at a hearing on 18 July 1994 at which Mr Anthony Asquith appeared as Agent for the patentee and Mr P M Back appeared as the examiner in the case.

Section 73(2) states:

"If it appears to the comptroller that a patent under this Act and a European patent (UK) have been granted for the same invention having the same priority date, and that the applications for the patents were filed by the same applicant or his successor in title, he shall give the proprietor of the patent under this Act an opportunity of making observations and of amending the specification of the patent, and if the proprietor fails to satisfy the comptroller that there are not two patents in respect of the same invention, or to amend the specification so as to prevent there being two patents in respect of the same invention, the comptroller shall revoke the patent"

Both UK patent No 2175786 and EP(UK) patent No 0250426 were filed in the name of Amoy Margaret Assing-Collier and both claim the priority date of 19 March 1985 by virtue of priority application No GB8507120. A patent was granted on the UK application on 19 October 1988 and is currently in force. The EP(UK) patent was granted on 6 February 1991 but was subsequently allowed to lapse by failure to pay the renewal fee due on 6 May 1991.

Whilst not an issue raised at the hearing, I consider it desirable that I should first dispose of a preliminary point. As I have noted, the EP(UK) patent has been allowed to lapse by failure to pay the renewal fee. However, whilst the EP(UK) patent is no longer in force, there was a period of some three months in 1991 during which both patents were together in force. The Patent Office approach in such a situation is clearly set out in the decision of the hearing officer in Turner & Newall Ltd's Patent [1984] RPC 49, ie that (i) section 73(2) obliges the comptroller to revoke the UK patent unless the proprietor's observations or amendments are sufficient to overcome the objection of double grant, there being no discretion exercisable in the proprietor's favour not to revoke the UK patent if the EP(UK) patent were abandoned instead; and (ii) surrendering the EP(UK) patent or allowing it to lapse by non-payment of fees does not overcome the objection of double grant because there would still have been a period of time, however short, when both patents were in existence, both lapse and surrender operating only *ex nunc* and not, as does revocation, *ex tunc*. Thus, despite the lapse of the EP(UK) patent in this case, section 73(2) is still applicable provided, of course, that the other requirements of that section are met. There being no dispute in this case that the UK and EP(UK) patents have the same applicant and priority date, the point at issue is whether or not the two patents have been granted for the same invention.

"Invention" is defined by section 125(1) which states:

"For the purposes of this Act an invention for a patent for which an application has been made or for which a patent has been granted shall, unless the context otherwise requires, be taken to be that specified in a claim of the specification of the application or patent, as the case may be, as interpreted by the description and any drawings contained in that specification, and the extent of the protection conferred by a patent or application for a patent shall be determined accordingly."

Turning to the subject matter of the patents at issue, claim 1 of the EP(UK) patent reads:

"An improved process for preparing salted-and-dried fish; where the fish on which the improved process is carried out is fish that has been salted and dried by the steps:-

(i) of receiving a fresh catch of fish, and of laying open and eviscerating the fish;
(ii) of immersing the fish in concentrated brine until the fish has absorbed enough salt to preserve the fish;

(iii) of extracting water from the fish, and of de-hydrating the fish to such an extent that the fish has the hard, bone-dry texture or the almost hard, bone-dry texture of traditional salted-and-dried fish;

(iv) of leaving the fish, after de-hydrating, for a substantial period of time;

where the improved process comprises the steps:-

- (a) of *fully* re-hydrating the fish by soaking the fish in fresh water;
(b) of extracting water from the re-hydrated fish until the fish is in the just-damp or almost-dry condition;
(c) of sealing the just-damp or almost-dry fish into cans.

Claim 1 of the UK patent is similarly worded except that those words highlighted by italics in the above recitation of the EP(UK) claim are omitted from the UK patent claim. Thus the EP(UK) claim defines a more restricted method falling entirely within the method of the UK claim by virtue of the two additional requirements that (i) the fish, after de-hydrating, is left for a substantial period of time before applying the improved process of the invention, and (ii) the subsequent re-hydration step is such as to fully re-hydrate the fish. The remaining appendant claims 2-13 of the two patents are identical except for claim 9 where the wording in the UK patent was modified during prosecution of the application, and the description in each case is virtually identical.

Despite omitting the two highlighted requirements from claim 1, the description of the UK patent states that they are in fact essential to the process of the invention, stating (i) at page 3 line 30 - page 4 line 2 "*It is essential, in this invention, that the salted-and-dried fish to which the process of the invention is to be applied is fish that has been left in the salted-and-*

dried condition for a substantial period, for example for some weeks..."; and (ii) firstly at page 2 lines 18 - 22 "If the canning of salted-and-dried fish is to be successful, it has been found that the following steps are essential: first, before it can be put in cans, the salted-and-dried fish must be fully re-hydrated..." and later at page 4 lines 16 - 18 "The length of time that the fish is left in the tank should be long enough that all the fish is completely rehydrated." In view of these passages and additionally claim 11 of the UK patent which (similarly to claim 11 of the EP(UK) patent) reads *"Process of claim 1, where the fish has been in the said salted-and-dried condition for a period of several weeks prior to re-hydrating"*, the examiner considered that, notwithstanding the highlighted differences between the main claims, both patents had been granted for the same invention.

Mr Asquith has maintained from the outset that the two patents do not relate to the same invention. His argument in this respect is straightforward. Quite simply he contends that since the main claims of the two patents are different in scope, such that one can envisage a method which would infringe the UK patent but not the EP(UK) patent, and since section 125(1) defines an invention as what is specified in the claim then the respective main claims cannot be said to define the same invention. Whilst acknowledging that section 125(1) further contains the qualification that the claim is to be interpreted by the description, Mr Asquith contends that, although such 'interpretation' allows clarification or even re-definition of the words used in the claim, it does not extend to allowing the importation into the claim of words from the description defining a feature not present in the claim, such as the 'step (iv)' missing from the claim of the UK patent. The latter, he argued, is amendment rather than interpretation of the claim and there is no precedent in law for this. Although further acknowledging that there is inconsistency between the description and claim in the UK patent, he contends that it is not permissible to resolve this by reading the additional features into the claim.

I cannot agree with Mr Asquith that there is no precedent for interpreting a claim as including a feature omitted therefrom but specified in the body of the specification. For example, in his decision in *Glatt's Application* [1983] RPC 122 at page 129 Whitford J considered that on its true construction a claim could properly only be read as being limited to an article including an air-permeable substrate where the feature of air-permeability was

not present in the claim but was clearly specified as essential by the body of the specification. In the present case, the description stresses, without ambiguity, both that the fish treated must have been left in the salted-and-dried state for a substantial period of time and that it must subsequently be fully re-hydrated. In view of this and the requirement in section 125(1) for the claim to be interpreted in the light of the description, I do not see that claim 1 of the UK patent can be correctly construed as embracing processes omitting these features.

I do not, however, regard this point as alone decisive. Irrespective of whether or not claim 1 of the UK patent should be interpreted as being of the same scope as claim 1 of the EP(UK) patent, I cannot accept the argument that a mere difference of scope between the claims of the two patents is necessarily adequate to avoid the sanction of section 73(2). It is quite clear from prior decisions under section 73(2) that the phrase "for the same invention" is to be regarded as embodying the long-standing principle that the same monopoly should not be granted twice over and, thus, it covers not only the situation where respective patents contain claims of the same scope but also where the claims differ in the scope of the monopoly claimed but not in substance. For example, the hearing officer in *Maag Gear Wheel and Machine Co Ltd's Patent* [1985] RPC 572, whilst observing that claim 1 of the UK patent was not limited to the pad geometry of claim 1 of the corresponding EP(UK) patent but that the said pad geometry was the only construction described and illustrated in the UK patent, construed claim 1 of the UK patent as protecting a journal bearing including that pad geometry and accordingly found claim 1 of the UK patent to be directed to the same invention as claimed in the EP(UK) patent. In doing so he made use of the decision in *Armstrong-Kropp Development Corporation's Applications* [1974] RPC 268 considering that the tests for determining whether or not two patents are in conflict under section 73(2) are the same as deciding whether two UK applications are in conflict under section 18(5). A further similar decision, albeit under section 18(5), is that of *IBM Corporation (Barclay & Bigar's) Application* [1983] RPC 283 where a claim to a solution containing a compound in a concentration "less than 0.03M and sufficiently low to give a perceptibly lighter colour..." and a claim to a solution containing the same compound in a concentration "less than or equal to 0.02 Molar" were held to be for the same invention. I see the present situation as being analogous. Whilst claim 1 of the UK patent at issue omits the additional two features of the EP(UK) claim, a process involving these features is the

only one contemplated in the UK patent and there is no suggestion of any technical difference between the processes defined by the two claims, ie that by "re-hydration" in claim 1 of the EP(UK) patent is meant anything other than full re-hydration or that the fish to be re-hydrated is anything other than fish which has been left in the salted-and-dried state long enough to gain its traditional flavour. Accordingly I do not consider that the claims differ in substance. This point is particularly strongly illustrated by the respective claims 11 of the two patents. These identically worded claims state "*Process of claim 1, where the fish has been in the said salted-and-dried condition for a period of several weeks prior to re-hydrating*", ie they claim the case where the 'substantial period of time' for which the fish are left is specifically "several weeks". In the case of these claims, I consider that a particular embodiment of the 'step (iv)' of the EP(UK) claim (which Mr Asquith has stressed as the more significant of the two differences between the claims) is identically present in both cases. Mr Asquith maintained that there was still a difference in scope by virtue of the appendancy of the claim in the EP(UK) case to the narrower claim 1 and the definition in the description of the 'substantial period' as being long enough that unsalted and undried fish would go bad, ie on the grounds that the UK claim 11 alone included the case where the period of a few weeks would not be long enough for unsalted and undried fish to go bad, but I do not agree that this can be said to show any significant difference in scope.

There is yet another way of looking at the situation, and this is the one utilised in the recent decision under section 73(2) by the Court of Appeal in *Marley Roof Tile Co Ltd's Patent* [1994] RPC 231. In that case, similarly to the present situation, the main claim of an EP(UK) patent (relating in that case to an article prepared by a particular process) fell entirely within a claim of the corresponding UK patent (relating to the said article *per se*). The decision of Balcombe L. J. overturns an earlier Patents Court decision where the two claims were held not to relate to the same invention because of their difference in scope, and states that if the claims of a UK patent and a EP(UK) patent cover the same invention, whatever other linked inventions may be covered by the claims of either patent, then the Comptroller may revoke the UK patent. In that particular case, it was considered that claim 1 of the UK patent covered (a) articles made by the particular process covered by claim 8 of the EP(UK) patent and (b) articles made by any other process, and on that basis claim 1(a) of the UK patent was for the same invention as claim 8 of the EP(UK) patent. Extending

the same principle to the present situation, I can notionally divide claim 1 of the UK patent at issue into (a) a process including the omitted step (iv) and full re-hydration, and (b) a process not including one or both of these features, the former being the same invention as claim 1 of the EP(UK) patent.

Mr Asquith's view of the Marley decision differs from this. He argued that the decision should not be seen as negating the premise that claims of differing scope cannot be said to relate to the same invention except for the case where the claims are so nearly identical that one cannot envisage a structure covered by one and not the other. He further contends that one can always consider any two claims as overlapping in the sense that one can always envisage something falling within the scope of both, and thus to interpret the Marley decision as not allowing any overlap of claim for cases in potential section 73(2) relationship would have the effect of completely prohibiting the co-existence of UK and EP(UK) patents of the same priority date and applicant, no matter how different the inventions claimed. Since he considered that this must be an absurd result, he contended that the Marley decision must have resulted from the special circumstances appertaining to product-by-process claims and was not therefore of general applicability. Once again, I cannot agree with his argument. The situation at issue is not one of some theoretically-derived overlap of claim, but of one claim falling entirely within the scope of the other with both supported by identical disclosures. I see nothing in the Marley decision to void its applicability to the present situation or to limit it to the special field of product-by-process claims.

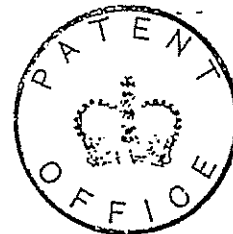
Thus, whichever way I approach the present issue, I find that the two patents at issue GB 2175786 B and EP(UK) 0250426 B1 relate to the same invention and hence fall within the terms of section 73(2).

Mr Asquith further argued that double patenting as prohibited by section 73(2) is an administrative rather than a substantive matter, in a manner analogous to plurality of invention, and that because of this any doubt should be resolved in favour of the patentee, and indeed that the Patent Office should look for a way to avoid revoking the UK patent. Whilst I have sympathy with the patentee who, having allowed her EP(UK) patent to lapse, now stands to lose her UK patent, this is not a situation where I consider that there is any

doubt that the two patents are for the same invention and I have no discretion to do other than to apply section 73(2).

In summary therefore, I find that the objection raised under section 73(2) is well founded. The arguments so far considered have been directed to the validity of the objection and have not investigated the possibility of amending either or both of the UK and EP(UK) patents to overcome the objection. Accordingly, I allow a period of two months from the date of this decision for the patentee to file proposals for amendment, failing which I shall order the UK patent No 2175786 to be revoked. I would also remind the patentee that she has a period of six weeks from the date of this decision in which to enter an appeal against my finding.

Dated the 29 day of July 1994



G M BRIDGES

Principal Examiner acting for the Comptroller

THE PATENT OFFICE