

PATENTS ACT 1977

0/074/96

IN THE MATTER OF an application under
Section 27 of the Patents Act 1977 by
Henry Reed to amend Patent number
EP(UK) 0142963

and

IN THE MATTER OF an opposition thereto
by Sir James Laing & Sons Limited

DECISION

EP(UK) 0142693 was granted by the EPO on 20 January 1988, but lapsed by non-payment of the renewal fee due on 9 November 1991. In a letter from the Patent Office dated 2 April 1993, an objection was taken under Section 73(2) that the invention in the EP(UK) patent and that in patent number 2151290 were the same.

After exchanges of correspondence, the application to amend the EP(UK) patent was made by filing Form 14/77 on 26 August 1993, with the stated intention of removing conflict by amending the case in suit in a way complementary to amendment proposed under Section 73(2) on 2151290. The amendments were referred to an examiner, and after some revision, were advertised. Opposition to the proposed amendments was filed by Sir James Laing & Son Limited, together with a statement of case, on 25 July 1994. The Section 73(2) action on 2151290 has been suspended until the outcome of the current action.

The grounds set out in the opponent's statement of case are as follows:-

- (a) There is no basis in law for amending a EP(UK) as a remedy for Section 73(2) relationship.
- (b) Even if there is basis in law, the amendment proposed does not dispose of the conflict.

- (c) There has been delay by the patentee in applying to amend.
- (d) The application to amend does not disclose all relevant facts, particularly some alleged prior disclosures, known to the patentee for some time, which allegedly render the patent invalid.
- (e) The amendment proposed renders the patent insufficient.
- (f) Retention of reference numerals in the claims renders the patent unclear.

The proprietor's counterstatement denies all this, but does, in paragraphs 2 and 9, suggest possible further amendments which he would be agreeable to making if necessary.

The normal evidence rounds were completed, and the matter came before me at a hearing on 21 November 1995, where Mr Colin Birss appeared as counsel for the opponents, Sir James Laing & Son Limited. The proprietor's agents, in a letter dated 15 November 1995, indicated that the proprietor would not be present nor would he be represented, stating that the proprietor was content for the opposition to be decided upon the basis of the facts already upon the written record in these proceedings. His agents believe that those facts wholly support the application to amend the patent. In reaching my decision I have taken account of the evidence and other documents filed on behalf of Mr Reed. At the start of the hearing I asked Mr Birss to answer any points which he felt might have been put had Mr Reed been present or represented. In addition I closely questioned him on some matters.

Since the stated reason for requesting amendment is to remove a conflict between the EP(UK) and the GB patent, I will summarise the amendments currently proposed to both patents.

Claim 1 of EP 0142963, in the form advertised, reads as follows (additions in italics; deletions in brackets):-

1. Scaffolding comprising a number of platforms (12) and *three* flexible [suspension means] *chains* (14) for suspending the platforms in vertical arrays one spaced from another while allowing them to be collapsed on one another in a stack characterised in that said scaffolding includes at least one cable (25) secured to the lowest platform (13) and capable of sliding in relation to the other platform so that the lowest platform (13) can be lifted and stacked against a platform above it by winding in the cable (25).

Original claim 2 is deleted, and consequential amendment made in the remaining dependent claims, and in the opening parts of the description. All of the description referring to the embodiments depicted, and the drawings are deleted.

The further amendments referred to in the patentee's counterstatement (referred to above) are (i) to insert "only" before "three" in claim 1; and (ii) to delete all reference numerals in the claims.

The current form of the amendments proposed under S 73(2) for 2151290 are as follows:-

1. Scaffolding comprising a number of platforms and *four* flexible suspension means for suspending the platforms in vertical array one spaced from the other while allowing them to be collapsed on one another in a stack and including at least one cable secured to the lowest platform and capable of sliding in relation to the other platforms so that the lowest platform can be lifted and stacked against a platform above it by winding in the cable, and a winch for winding in the, or each, cable.

Minor consequential amendment is proposed in the description.

The matters put to me to decide fall into two general areas, albeit interlinked. These are whether as a matter of law an amendment under Section 27 can ever be effective to rectify a "double grant" situation under Section 73(2) (ground (a)); and whether the request under Section 27 made in the circumstances of this specific case is such as to justify the exercise of the Comptroller's discretion (grounds (b) to (f)).

The relevant parts of the Patents Act 1977 are as follows.

Section 73(2) states that:-

"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."

Section 27(1) states that:-

"Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit."; and

Section 27(3) states that

"An amendment of a specification of a patent under this section shall have effect and be deemed to always to have had effect from the grant of the patent."

Since all of the evidence furnished goes to grounds (c) and (d) above, namely delay in seeking amendment and less than full disclosure of all relevant facts by the patentee, I will deal with the second matter first.

Mr Birss, at the hearing urged me that the patentee had not approached the Comptroller with the necessary openness and candour for discretion to be exercised to allow the amendments. He particularly referred me to two exhibits (identified as MJB1 and MJB2) associated with the first

statutory declaration by Michael John Butler, as showing, in his view, that the potential conflict between the EP(UK) and the GB patent was appreciated by, or at least brought to the attention of, the patentee's then professional advisors at the dates of those documents, namely in December 1989 (letter by D C L Perkins to Clifford Chance) and in December 1990 (report by Michael J Butler). Both of these dates were in advance of the lapse of the EP(UK) patent in November 1991 through non payment of the renewal fee, the final date for payment being in May 1992.

Mr Reed's response to this evidence, in a statutory declaration, was a denial that he was aware of the matter until the launch of the Section 73(2) action. The opponents had sought the provision from Mr Reed of copies of any documents in his possession relating to the report from Mr Butler. Mr Reed declined voluntarily to provide copies to the opponents, relying instead on the denial in his affidavit. The opponents did not press for discovery, explaining that the onus for disclosure is on the applicant for amendment. On this point Mr Birss submitted that a patentee seeking the indulgence of the Comptroller to amend should have produced evidence to elucidate and explain the circumstances surrounding the decision to allow the patent to lapse in the context of the exhibits referred to above. He also suggested that the change of Address for Service on the Register (on 21 February 1992, ie after the renewal fee was due), and a letter dated 30 November 1993 from Hay & Kilner (Solicitors acting at that time for Mr Reed) indicate that Mr Reed was attempting to use the patent even though rights were extinct.

Although some of the evidence refers to an alleged prior publication which, it is alleged, might have bearing on the actions of the patentee, Mr Birss did not pursue this line at the hearing, and I am not satisfied that there is sufficient in the evidence for me to find one way or another.

However, it is established law that a patentee seeking exercise of the Comptroller's discretion to amend under Section 27 must come to him promptly and with full and frank disclosure of all the circumstances relevant to the issue. This is a very heavy burden to discharge, and I am not satisfied that Mr Reed has discharged it. The burden is not lessened by the reason given for the amendments, viz that of avoiding revocation under Section 73(2) of the national patent, bearing in mind that on first sight at least of that sub-section, it is the national patent and not the EP(UK) which should be amended to avoid double grant. I will return to this point - ground (a) - below.

Whilst I do not attach any weight to the inference made consequent upon the change of address for service, and, as I read it, the letter from Hay & Kilner does not amount to groundless threats, it is my judgment that the MJB1 and MJB2 exhibits do raise an issue which should have been expanded upon in the proceedings to enable me properly to come to a decision as to exercise of discretion. In the absence of explanation from Mr Reed, I am also not in a position to decide whether the apparent delay (in the face of this evidence) in seeking to rectify the double grant position is excusable. For those reasons I decline to allow amendment under Section 27.

With regard to ground (b), the first submission by Mr Birss was that the wording "three flexible chains" in the proposed amendment to claim 1 of the EP(UK), even if qualified by the insertion of "only" before it in the manner mentioned in the patentee's counterstatement, would still fall within "four flexible suspension means" of the proposed form of claim 1 of the GB patent. For example, the GB patent would cover an arrangement where three chains and one rope were the four suspension means.

As a further, or alternative, submission, he argued that the inventive concept in both cases did not crucially depend upon the number or form of the suspension means. In support of this, it was noted that this feature appears in the "pre-characterising" part of the claim granted by the European Patent Office. On this latter point, Mr Birss referred me to the "purposive" approach set forth in the *Catnic* case.

It is apparent from the decision of the Court of Appeal in *Marley Roof Tile Co Ltd's Patent* [1994] RPC 231, and the hearing officer in *Maag Gear Wheel and Machine Co Ltd's Patent* [1985] RPC 572, that if EP(UK) and UK patents are directed to the same invention, irrespective of what other linked invention may be claimed, then the UK patent may be revoked. Are therefore the inventions in the two patents distinct? The choice of the number of chains or ropes would appear to be a matter of design depending on the size and shape of the platform, rather than a matter of invention. The granted specifications of both patents are totally silent as to any inventive merit in the number of chains. There is thus sufficient doubt as to the distinctiveness of the invention for me on this ground also to decline to exercise the Comptroller's discretion to amend under Section 27, since the amendment proposed does not seem to me to meet clearly the reason advanced for making it.

Before considering ground (e) - sufficiency -, I should mention, for completeness, that Mr Birss at the hearing submitted that the specification as sought to be amended under Section 27 extended the matter disclosed. He contended that the restriction to three or only three chains, with the consequential deletion of the main embodiment showing four chains, would lead to the specification teaching something different to the skilled man. Mr Birss did not indicate what extra would be taught. I am not satisfied that the amended specification by limiting the matter for which protection is sought would disclose matter which extends beyond that of the unamended specification (cf *A. C Edwards Ltd v Acme Signs & Displays Ltd* [1990] RPC 621). However, after some discussion, Mr Birss indicated that the problem with the deletion actually is the starting point on sufficiency.

Turning now to ground (e), it was put to me that, by deletion of all that description which relates to the drawings, the specification is rendered insufficient. I have to say that I am not persuaded by this. It seems to me that an ordinary skilled man would have no trouble in constructing the scaffolding, and therefore find for Mr Reed on this ground.

On the final ground (f) - the presence of reference numerals - , the patentee has offered, in his counterstatement, to remove them. Mr Birss did not press this ground at the hearing. Clearly, if the amendments were to be allowed, then the removal of the reference numerals from the claims would be appropriate as there is now no basis for them as a consequence of their removal from the description.

To sum up, therefore, considering the specific facts of this application to amend, I refuse to exercise the Comptroller's discretion to amend EP(UK) 0142963, for the reasons set out above. Given the reasons, in particular the lack of candour, I do not consider it appropriate to give Mr Reed an opportunity to propose alternative amendments to his patent.

Turning now to the basic question of whether it is possible to amend a EP(UK) under Section 27 to avoid conflict under Section 73(2). Mr Birss submitted that the words of Section 73(2) only envisage the amendment of the GB patent in this circumstance. He argued that, if Section 27 could be used as a remedy, then there would be no reason for the specific provision of Section 73(2) enabling amendment of the UK patent, and that, if Section 27 were a remedy with

the consequential reliance on Section 27(3) then there would be no need to have the provisions in Section 73(3) preventing Section 73(2) action if amendment in opposition proceedings under the EPC avoided there being two patents in respect of the same invention. There is strength in Mr Birss's submission on this matter. Section 73(2) is structured on the basis that before the Comptroller the UK patent granted under the Act rather than the EP(UK) is the one to be amended to avoid conflict. Section 73(2) mirrors the provision of Community Patent Convention in reducing the effect of a patent under the Act in the case of double grant, though the mechanism for achieving the effect differs in detail. However, I have not had the benefit of argument from the other side on the matter. In an earlier, oral, decision on patent no 2,113,554 (The Victoria University of Manchester) the hearing officer allowed amendment of the EP(UK) under Section 27 to avoid Section 73(2) conflict. This is not explicitly excluded by the Act and as I have declined to allow amendment under Section 27, I do not need to reach a definite conclusion and in the circumstances I leave the matter open. I would be reluctant to reverse this earlier decision in the absence of full argument from both sides.

Mr Birss, in a further limb to his argument on Section 73(2), also asserted that, in any event, by using the wording "have been granted", even if the Section 27 amendment has retrospective effect, there will have been, as historical fact, double grant. However on this point the criterion in Section 73(2) for the Comptroller to revoke a patent is that there are (my emphasis) two patents in respect of the two inventions, not that two were granted which is only the trigger to initiate action. Thus if amendment of an EP(UK) under Section 27 is an appropriate way of removing the conflict then the criterion could be met by amendment under Section 27, in view of the provision of Section 27(3) that an amendment has effect and is deemed always to have effect from the grant of the patent, in the same way as the criterion can be met by amendment of the (domestic) patent under Section 73. I therefore do not agree to this limb of his argument.

Both sides, in the respective statement and counterstatement, ask for costs, but neither side addressed me on this. Since, in the event, I have found against the patentee, I consider it would be appropriate to make an award in favour of the opponents. I accordingly direct that the sum of £600 as a contribution towards their costs be paid by the patentee, Henry Reed to Sir James Laing & Sons Limited.

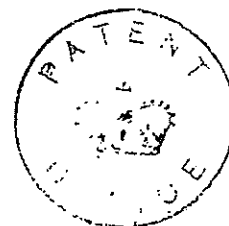
There is one final point to be dealt with. At an early stage of the proceedings, a copy of both a licence agreement and a consultancy agreement between the parties was filed, with a request that they be treated as confidential. Since the content of those agreements, rather than their mere existence, is not relevant to the decision above, I direct that these agreements be treated as confidential under Rule 94(1).

This decision being on a substantive matter, any appeal must be lodged within six weeks of the date of this decision.

Dated this 8 day of December 1995

B G HARDEN

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE