01/90/92

PATENTS ACT 1977

IN THE MATTER OF an application under Section 72 by A P (Consultants) Limited for the revocation of Patent No 2187958 in the name of Albright & Wilson Limited

DECISION

Patent No 2187958 was granted on 15 August 1990 pursuant to application No 8706646 which was filed on 20 March 1987 claiming priority from earlier UK application No 8607035 dated 21 March 1986. The patent is concerned with a process for the treatment of growing plants in order to control the growth of adventitious organisms. An equivalent EP application was filed for the same invention and was published as EP 242990, but that application has not been granted and was 'deemed withdrawn' as of 14 February 1992.

The application for revocation of the patent was filed by A P (Consultants) Ltd on 21 June 1991 together with a letter which is being treated for the purposes of these proceedings as the applicant's statement under Rule 75. Whilst the grounds for revocation are not pleaded explicitly in the letter, it is accepted by the patentees that the grounds implied are that the invention is not new and/or does not involve an inventive step having regard to:-

(a) US Patent No 2512640 (Buffalo Electro-Chemical Co) which was issued on 27 June 1950; and

(b) field experiments carried out by the applicants since December 1987.

The patentee points out in his counterstatement that the field experiments are admitted to have commenced no earlier than December 1987, which is later than the date of the application for the patent; the applicant for revocation did not pursue the matter of the field experiments and I am satisfied that no question of prior user arises.

The applicant for revocation has declined to file any evidence in these proceedings and the only evidence I have before me is a statutory declaration by Dr R A K Szmidt on behalf of the patentees. The matter came before me at a hearing on 2 October 1992 at which Mr A P Pilsworth appeared on behalf of the applicant and the patentee was represented by its patent agent, Mr R G M Savidge.

At an early stage of the hearing Mr Savidge drew my attention to the judgement of Bridge L J in Dunlop Holdings Limited's Application [1979] RPC 523 which sets out at page 546 the principle to be applied in opposition proceedings under Section 14 of the Patents Act 1949 that the onus is on the opponent to prove his case and he submitted that the same considerations apply in revocation actions under Section 72 of the Patents Act 1977, that is that the onus is on the applicant for revocation to prove his case. He pointed out that whilst the patentee has filed a full counterstatement followed by evidence by Dr R A K Szmidt, the applicant's only submission of any substance has been his letter of 21 June 1991 together with one or two comments in a later letter of 16 January 1992, and he has declined to file evidence in chief and has failed to file evidence in reply to Dr Szmidt's evidence which thus stands uncontroverted. On Mr Savidge's submission the applicant has failed to discharge the onus upon him and the application for revocation cannot succeed.

Whilst I accept Mr Savidge's argument that the onus is on the applicant to prove his case and that he has undoubtedly disadvantaged himself by his failure to file a detailed case and evidence in support, nevertheless the allegations of lack of novelty and/or inventive step have been raised and cannot be dismissed without due consideration.

Turning then to the grounds on which revocation is sought, claim 1 of the patent as granted reads as follows:-

> "A process for the treatment of growing plants in order to combat the growth of adventitious organisms which comprises treating the plant with an effective quantity of peracetic acid or perpropionic acid."

According to the patent specification, the use of peracids has the advantages that, whilst providing an effective broad spectrum disinfectant, they decompose to non-toxic products and can hence be used on edible crops without the need for subsequent washing or delay in harvesting after treatment, and unlike some alternative treatments, their use does not result in the evolution of a resistant strain of the organism. As originally filed, there were claims also to compositions comprising peracetic or perpropionic acid for use in such treatment, but these were deleted during examination following the citation of prior publications showing the use of such materials as disinfectants.

The allegation of lack of novelty is based on US patent No 2512640 which relates to the preservation of raw plant tissue to reduce spoilage resulting from the growth of micro-organisms and browning by treatment of the exposed surfaces thereof with a peracid of the fatty acid series, the use of peracetic acid being exemplified. The argument before me centred on whether or not the prior patent can be said to disclose the treatment of 'growing plants' as required by claim 1 of the patent in suit. In Mr Savidge's view it does not, the disclosure of the US patent being directed solely to the treatment of harvested produce, such as tomatoes or grapes, and he pointed to several passages in the cited document in support of his argument. Whilst there is a reference in the US patent at column 2, line 15 to the process being applicable "in the field or at the plant", he submitted that in the context this should be read as treatment after harvesting either before removal of the harvested crop from the field or subsequently at a food processing plant. Dr Szmidt's evidence supports this interpretation and I accept it.

Mr Pilsworth was unable to point to a passage in the US patent which discloses the treatment of the actual plants from which the produce is harvested as opposed to the treatment of the harvested produce itself but argued instead that the harvested produce falls within the scope of the term 'growing plants'. According to Mr Pilsworth the US patent relates to the treatment of harvested produce, such as tomatoes, to keep it alive and fresh and, just because the produce has been harvested, it does not cease to be a plant nor to stop growing immediately since it will continue to respire and transpire and therefore must still be regarded as a 'growing plant'.

I cannot accept this argument. Whilst Mr Pilsworth may well be right on a strictly scientific approach in saying that harvested produce might be regarded as being still alive (and even perhaps a growing plant) since certain biological or biochemical processes do not cease instantaneously with harvesting but continue for a limited period, I must agree with Mr Savidge that such harvested produce is not a growing plant as understood by the ordinary man nor, in the absence of any indication in the patent in suit of a special meaning being given to the term 'growing plants', would claim 1 of the patent be construed as embracing the treatment of harvested produce.

In connection with this question of anticipation by prior publication Mr Savidge drew my attention to the well known passage in the decision of the Court of Appeal in General Tire & Rubber Company v Firestone Tire and Rubber Company Limited [1972] RPC 457 at pages 485-486 which clearly states the principles that the earlier publication and the patentee's claim must each be construed as they would be at the respective relevant dates by a reader skilled in the art to which they relate and that, in order to anticipate the patentee's claim, the prior publication must contain clear and unmistakeable directions to do what the patentee claims to have invented, concluding at lines 13-15 on page 486 with the words:

> "..... A signpost, however clear, upon the road to the patentee's invention will not suffice. The prior inventor must be clearly shown to have planted his flag at the precise destination before the patentee."

In the present case, there is no doubt in my mind that the US patent teaches only the treatment of harvested produce prior to subsequent processing and contains no directions to treat the actual plants in situ in the ground to facilitate their healthy development which is the claimed invention of the patent in suit. The allegation of lack of novelty therefore fails.

The remaining issue which I have to consider is the allegation of lack of inventive step having regard to US patent No 2512640 and to the field trials which the applicants claim to have carried out since December 1987. Mr Savidge gave four arguments for rejecting the allegation which I can summarise as the lack of evidence in support of the applicant's

case, the age of the cited US patent, the teaching of that patent, and the lack of relevance of the applicant's field experiments.

In drawing my attention once again to the lack of evidence in support of the applicants' case Mr Savidge submitted that this in itself is sufficient reason to reject the allegation. As I have already indicated, however, whilst the lack of evidence on the applicant's part is undoubtedly an important point to be taken into consideration, in the public interest I would not wish to reject the allegation without fully considering the issues.

The cited US patent was published in 1950 and although Mr Savidge did not address me at great length on the age of the document he did refer to the decision in American Cyanamid Company v Ethicon Limited [1975] RPC 513 and particularly to lines 2-4 on page 518 where Graham J said:

> "One may well ask why, if the invention was obvious, did it take nine and a half years before any one suggested using or trying the fibre of example 4 of Lowe as a suture. I need say no more on the question of obviousness".

As Mr Savidge pointed out, in this case the gap between the invention in suit and the date of the prior art which, it is argued by Mr Pilsworth, renders it obvious, is four times as long as the one which Graham J apparently considered to be so significant in American Cyanamid; in Mr Savidge's submission it would require very substantial evidence to explain that gap away and there is no evidence whatsoever in this case.

Turning to the teaching of the US patent, whilst it does disclose the applicability of peracetic acid as a germicidal and fungicidal wash for harvested produce which is to be used as food, it is the patentee's contention that the treatment of harvested produce is a totally different problem from the treatment of growing plants and this view once again is supported by the uncontroverted evidence of Dr Szmidt. In his counterstatement the patentee argues that there would be a technical prejudice against using a broad spectrum biocide to treat growing plants and cites a passage from Kirk-Othmer "Encyclopedia of Chemical Technology" in support. Further, at the hearing Mr Savidge argued that the US patent is concerned with the question

of preserving harvested produce and, just as a grower would not think of applying other known preservation methods, such as blanching, freezing or washing with brine, to growing crops, nor would he look to the disclosure in that patent as suggesting a treatment for growing crops. In further support of this argument he pointed out that the US patent states that the peracid treatment inactivates enzymes present in the produce which, he submitted, suggests that it is at least potentially highly phytotoxic and this would be a strong negative teaching which would deter the reader from following the path to the invention in suit. On this latter point, Mr Pilsworth in his turn submitted that the purpose of the treatment process of the US patent is to keep the harvested produce fresh and that only a single enzyme, which is a browning enzyme, is influenced by the treatment and the produce (which he argues is still a living plant) remains alive and well after the treatment. This he said suggests that it is perfectly feasible to apply the treatment to growing plants in the field.

Finally, as regards the field experiments, Mr Savidge pointed out that whilst Mr Pilsworth claims in his letter of 21 June 1991 in support of his argument on obviousness that "any expert agronomist such as myself may successfully apply the information contained in that patent to growing crops, as I have been doing in field experiments since December 1987 without any knowledge of the content of the Albright & Wilson patent application until 1988", these experiments were not conducted until after the patentee's patent had been published and this was some 36 years after the US patent itself had been published. He submitted that perhaps Mr Pilsworth inadvertently had become aware of the information in the patentees' patent without realising its source, a point denied by Mr Pilsworth, but that in any case these experiments are not relevant because of their date and Mr Pilsworth had not made any allegations as to what was or was not obvious at the relevant priority date of the patent in suit which was some two years earlier. He also referred to a point raised by Dr Szmidt in his evidence which draws attention to Mr Pilsworth being an expert agronomist and thus, he submitted, does not represent the ordinary man skilled in the art when it comes to saying what was or was not obvious at the relevant date. Having regard to the discussion of the views expressed by the Court of Appeal on the person skilled in the art in Genentech Inc's Patent [1989] RPC 147, I am not convinced that this line of argument is valid, but in the event I do not see that the patentees need to rely upon it and I shall not consider it further.

The applicants' case as presented by Mr Pilsworth basically stands on the teaching of the US patent alone and the submission that since the purpose of the treatment described in that patent is to keep harvested plants alive and fresh, it would be obvious for any expert agronomist to realise its applicability to growing plants. However, the applicant has failed to file evidence in support of his case or to contravert the expert evidence of Dr Szmidt, and has further failed to provide any argument or evidence to explain the long period between publication of the US patent and the application of peracetic acid treatment to growing plants. Moreover, whilst Mr Pilsworth himself claims to have realised the relevance of the treatment described in the US patent such as to apply it to the treatment of growing crops, he apparently did not think to do so until after publication of the patent in suit and has failed to provide evidence showing it would have been obvious to do so two years earlier at the priority date of the patent.

Since I have found that the applicant has failed on all of the grounds pleaded, I refuse to order the revocation of Patent No 2187958 and I award the patentee (Albright and Wilson Limited) the sum of £350 (three hundred and fifty pounds) as a contribution towards his costs and direct that this sum be paid by the applicant A P (Consultants) Limited.

The patentee also asks for a certificate of contested validity under Section 65(1). Accordingly I certify that the validity of UK Patent No 2187958 was contested on the grounds of lack of novelty and lack of inventive step having regard to the disclosure in US Patent No 2512640 and that the UK Patent was held to be valid.

Dated this 19 day of November 1992

P J HERBERT
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE