

BLO /152/90

PATENTS ACT 1977

IN THE MATTER OF an application
under Section 72 by
Craig Medical Products Limited
for the revocation of Patent
No 2083782 in the name of
Timbale Corporation NV, formerly
Enak Limited

PRELIMINARY DECISION

The application for the revocation of Patent No 2083782, which was granted in the name of Enak Limited but which was transferred to Timbale Corporation by virtue of an assignment dated 27 June 1988, was filed together with a statement on 31 July 1986. The grounds for revocation are that the invention is not new, that it does not involve an inventive step and that the matter disclosed in the specification of the patent extends beyond that disclosed in the application as filed.

The application proceeded through the counterstatement and evidence stages, albeit with some delays, in accordance with Rule 75 and the filing of the applicants' evidence in reply was eventually completed on 18 June 1990.

In their patent agent's letter of 20 July 1990 the patentees raised certain objections to the evidence in reply and, since the parties were unable to agree, these fell to be resolved at a hearing before me on 2 November 1990 at which the applicants were represented by their patent agent, Mr A J Cook, and Mr G Burkill appeared as counsel for the patentees.

The invention of the patent in suit is concerned with a WC-disposable ostomy bag for collecting bodily excretions from patients who have undergone colostomy, ileostomy or

urostomy operations. For the purposes of this decision, however, I do not think that I need to go into the details of the invention or refer in great detail to the evidence.

The matters in dispute arise out of the evidence given in reply on behalf of the applicants by Mr T R Hayward and were summarised in the official letter of 20 August 1990 to the parties as follows:

- (i) whether any of the applicants' evidence in reply goes beyond what is strictly in reply to the patentees' evidence;
- (ii) if so, whether it should be admitted; and
- (iii) if so, on what terms in particular as to the presentation of the applicant's experimental evidence, the repetition of such experiments and the filing of further evidence in reply by the patentee;

and these were the matters which were argued at the hearing.

Mr Burkill began by saying that the patentee has only one opportunity to put in evidence which is the reason for the words "strictly in reply" in Rule 75(5) in connection with the applicant's second round of evidence. If the applicant is allowed to include new evidence at the reply stage, then the applicant has the last word and the patentee is taken by surprise and has no chance to reply without further argument as to whether there should be an additional round of evidence. In support of his arguments Mr Burkill referred me to Ford Motor Company Limited (Nasta's) Application [1968]RPC 220 and Scragg (Ernest) & Sons Ltd's Application 1972 RPC 679 and he went on to outline the chronology of events in the present case and invited me to apply certain tests in order to decide whether the evidence in dispute can be regarded as being strictly in reply. Other than to urge me to apply caution in the application of the tests proposed

by Mr Burkill, Mr Cook took no point on the generality of Mr Burkill's submission and accepted that the onus is on the applicant to set out his case at the outset and confine the second round to matters which are strictly in reply to those raised in the patentees' evidence. I do not therefore propose to deal with the generality of Mr Burkill's submission in any further detail.

The first area of dispute concerns the admissibility of paragraphs 9, 16 and 19-23 of Mr Hayward's evidence.

Beginning with paragraph 9 of Mr Hayward's declaration, Mr Burkill stated that there is no attempt in this paragraph to identify any aspect of the patentees' evidence to which it claims to be in answer, that it is a general attack on obviousness and seeks to reformulate the attack on the ground of obviousness in a different way and begins to formulate a case for obviousness relying on the trends in the art and matters of that kind. In his view this paragraph could have been put in the evidence-in-chief because it does not answer anything arising out of the patentees' evidence but, belatedly, attempts to strengthen the applicants' case. For the applicants Mr Cook pointed out that the prior art referred to in this paragraph was discussed in the patentees' evidence and that Mr Hayward is merely replying to the patentees' attempts to distinguish claim 1 from the prior art. For my part I am inclined to share the patentees' view that this paragraph is concerned largely with opinion as opposed to evidence and does not amount to more than repetition and re-argument of the applicant's case and is not evidence strictly in reply. I therefore direct that this paragraph should be struck out.

Moving on to paragraph 16 of Mr Hayward's declaration Mr Burkill drew my attention to the first line of the first paragraph where Mr Hayward says that he would like to make some general comments on the prior art. In Mr Burkill's submission, the statement that they are general comments

excludes them from being evidence in reply and he went on to say that the teachings of this prior art could have been dealt with in evidence in chief rather than for the first time in the evidence in reply. Mr Cook pointed out that this prior art is considered in paragraphs 10 and 11 of Mr Cross's first declaration on behalf of the patentees to which Mr Hayward's evidence in paragraph 16 quite reasonably can be considered to be evidence in reply. I agree with Mr Burkill that the first two paragraphs of paragraph 16 finishing at line 3 on page 13 are concerned with a consideration of the prior art which could have been dealt with by the applicants in their evidence in chief and should therefore be struck out but the third paragraph of paragraph 16 makes specific reference to Mr Cross's evidence in chief and to this extent I agree with Mr Cook that it can be considered to be evidence in reply and should be allowed to remain.

With regard to paragraphs 19-22 of Mr Hayward's declaration which refer to individual sub-claims of the patent, Mr Burkill submitted that none of the sub-claims in question were attacked in the applicants evidence in chief and they had therefore elected to deal with the sub-claims by way of argument at the substantive hearing rather than by way of evidence. Although Mr Burkill conceded that Mr Cross had supported the sub-claims in his evidence for the patentees, the applicants should not be allowed to change their minds and seek to include evidence at this stage on which the patentees would not be able to comment by way of evidence. Mr Cook's response to this was that the matter of the sub-claims was considered by Mr Cross in his evidence and the applicants have merely replied to it. I consider that paragraphs 19-22 of Mr Hayward's declaration can reasonably be considered to be in reply to Mr Cross's evidence and I shall allow them to remain.

According to Mr Burkill paragraph 23 of Mr Hayward's evidence is not just a summary of Mr Hayward's views, which

was the explanation offered by Mr Cook, but is a new approach to obviousness and it is the skilled man expressing yet another route by which the invention could have been made from the prior art. Mr Burkill argued that this paragraph should have gone in the evidence in chief and, on balance, I agree with him and order that it should be struck out.

I will now turn to the second area of dispute on which there was considerable discussion at the hearing and this concerns paragraph 5 of Mr Hayward's declaration and certain experimental evidence to which it refers.

In his submission Mr Burkill objected not only to the introduction of experimental evidence at the reply stage because the patentees would not have an opportunity to provide evidence in answer, he also criticised the particulars of the experiments in question as being so vague and unhelpful that it is impossible for the patentees to repeat and evaluate them. In support of his argument Mr Burkill referred me to a number of authorities and invited me to follow the High Court procedure concerning experimental evidence which is set out in Order 104 Rule 12 of the Rules of the Supreme Court.

If I understood him correctly Mr Burkill's main concern was whether the applicants would seek to rely on this experimental evidence for some sort of unpleaded insufficiency attack. Mr Cook conceded that the applicants do not seek to rely on the experimental evidence for this purpose and went on to say that the evidence is purely to put the commercial success of the invention in a true and fair light. I put it to Mr Cook and he agreed that what the applicants are seeking to prove by this evidence is not that the invention of the patent does not work but that it does not work quite as well as the patentees would have it. Nevertheless Mr Cook conceded that manifestly there has been commercial success and quickly achieved commercial success

at that.

In these circumstances Mr Burkill recognised that, since the commercial success had not been achieved by the time when the applicants evidence in chief had been filed, it would be proper for me to allow the experimental evidence in reply, although he still sought full and better particulars and the opportunity for the patentees to see a repeat of the experiments and to file evidence in answer.

Although I found Mr Burkill's argument persuasive, I find it difficult at this stage to envisage what assistance the applicants will derive from the experimental evidence in view of Mr Cook's acknowledgement of the commercial success of the invention. In the circumstances I do not see the need to put both sides to the expense and inconvenience of repeating the experiments, filing further evidence and in further delaying these proceedings when, as Mr Cook indicated, nothing very much will turn on it.

I derive support for this approach from the judgement of Buckley L J in American Cyanamid v Ethicon Ltd (Discovery and Experiments) 1978 RPC 667 to which a passing reference was made at the hearing in a slightly different context. At line 14 on page 674, quoting the judgement of the lower Court, Buckley L J said:

"Giving the matter the best consideration I can I think that it is highly desirable in the circumstances that this case should if possible come on as soon as possible. Where you have an injunction and cross-undertaking running and a large amount of damages at stake it is clearly in the public interest that such a dispute should be resolved as soon as possible. I am not satisfied in the circumstances that the defendants here will be unduly prejudiced if they do not see a repetition of these two experiments in view of what I have been told and in view of the nature of the

experiments which are described in the documents and in the research report. If it should turn out at the trial that in fact the defendants have for some reason been prejudiced by not having seen a repetition of both or of one of these experiments, it will be possible for the court at the time to make any necessary order even then for a repetition or new experiment, though, of course, this might well involve an adjournment, and would no doubt require serious consideration of the proper order as to costs. However I think myself that it would not be right to hold this trial up, as would be inevitable if a repetition of these two experiments is now definitely allowed."

and at line 29 on page 675 he went on to say:

"I think the matter should be left to the discretion of the learned trial judge when the action comes to be tried, when there will be various courses open to him in his discretion; he could then refuse to admit evidence of experiments D and E without repetition; he could adjourn the trial to allow the repetition of the experiments to take place; or he could admit evidence of those experiments without repetition, and he could give that evidence such probative weight as seemed to him to be appropriate in the circumstances."

In my view, this is the proper course for me to adopt in these proceedings. I shall allow paragraph 5 of Mr Hayward's declaration and the experimental evidence to stand and if it transpires at the substantive hearing that I was wrong at this stage in my assessment of the value of the experimental evidence, the courses of action which were approved by Buckley L J will still be open to me.

In summary, therefore, I order that paragraph 9, the first two paragraphs of paragraph 16 and paragraph 23 of Mr Hayward's evidence in reply should be struck out, but I

allow the remaining paragraphs and the experimental evidence to stand.

It only remains for me now to consider the future timetable for these proceedings. As I see it there is no reason why there should be any further delay and I will therefore give the parties 1 month from the date of this decision in which to agree a date for the substantive hearing which should be within the following two months and, if they fail to do so, the Comptroller will set a date at 14 days notice.

Finally Mr Burkill raised the matter of costs but I will deal with these at the end of the proceedings.

Dated this 20 day of December 1990



P J HERBERT

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE