

BLO/116/90

PATENTS ACT 1977

IN THE MATTER OF an application under Section 72 by Isobel Martin for the revocation of Patent No 2151269 in the name of Rosemary Vanessa Amelia Moore

PRELIMINARY DECISION

The application for the patent in suit was filed on 17 December 1984 having a priority date of 15 December 1983, and the patent was granted on 26 November 1986. The invention relates to a process for producing a fabric with an irregular puckered effect.

Application for revocation was first made on 2 September 1987 by Isobel Martin who, in a letter to the Patent Office, argued that the invention lacked novelty. On 3 December 1987 a more formal statement was filed setting out as grounds for revocation:

- (a) that the invention was not new having regard to UK Patent No 503663 and to a fabric sample entered into a competition organised by the Textile Institute in 1958;
- (b) that the specification does not disclose the invention clearly enough and completely enough for it to be performed by a person skilled in the art;
- and (c) that the matter disclosed in the patent extends beyond that disclosed in the application for the patent as filed.

This was followed on 7 July 1988 by a supplementary statement setting out further facts regarding the competition sample.

The patentee filed a counterstatement on 17 March 1988 and, in a supplementary counterstatement filed on 5 May

1989, offered unconditional amendments to the description and claims, which amendments were opposed by the applicants on 5 January 1990.

Evidence in chief was filed by the applicant on 30 September 1988 and by the patentee on 5 May 1989, and the applicant filed evidence in reply on 3 August 1989.

The applicant's evidence in reply was accompanied by a request for an order for discovery under rule 103(3) in respect of material exhibited at the patentee's degree show in 1983 at the Royal College of Art and at the Fabrex Exhibition in October 1983, it being stated in the accompanying letter that the applicant had become aware since the filing of her evidence in chief that the patentee had made the invention public on at least two occasions before the priority date. In her patent agents' letter of 3 October 1989 the patentee opposed the request for discovery and the addition of new grounds for revocation (although at that stage no formal request for addition of further grounds had been made). On 9 April 1990 the applicant filed a second supplementary statement seeking to bring into the proceedings the further ground of lack of novelty in that the patentee had made the invention available to the public on the two occasions referred to above. (For convenience I will refer to this further ground as "prior use").

At a preliminary hearing before me on 4 July 1990 the issues were whether to allow the admission of the requested new grounds of revocation, the request for discovery and the subsequent procedure in both the revocation and opposition actions. At the hearing the applicant was represented by counsel, Mr Roger Wyand, and the patentee by counsel, Mr George Hamer.

In arguing in support of the introduction of the further ground of prior use Mr Wyand referred me to the four

considerations set out by the Assistant Comptroller in Owens-Corning Fibreglas Corporation's Patent, [1972]RPC 684, and approved by the Patents Appeal Tribunal in Addressograph-Multigraph Corporation's Patent, [1974] RPC 264, as to be taken into account in the exercise of the comptroller's discretion to allow amendment of the pleadings in revocation proceedings, namely:

- (a) whether the applicant used due diligence in preparing his case;
- (b) the relevance of the new art sought to be introduced;
- (c) the time that had elapsed since the filing of the application;
- (d) whether delay will be caused which might be unjust to the patentee or against the public interest.

Mr Hamer did not contest the pertinence to this case of the Owens-Corning criteria, and I accept that I must take them into my consideration. I would also note that the Patent Appeal Tribunal added in Addressograph-Multigraph that this list was not comprehensive, and that anything relevant must be considered and given appropriate weight.

As regards (a) Mr Wyand argued that there could be no suggestion that the applicant had not used due diligence. The evidence of prior use by the patentee had, he said, come to the attention of the applicant quite by chance and hence, he argued, the question of due diligence did not arise in this case. Mr Hamer responded on this point that since there was no evidence of when the applicant became aware of the alleged prior use it was not possible to determine whether due diligence had been used.

I must agree with Mr Hamer on this point. Although the applicant's evidence in chief includes statutory declarations relating to the alleged prior use, there is

nothing in the evidence to explain why this ground was not raised at the outset. I am therefore unable to decide whether due diligence was used by the applicant in this respect.

The second Owens-Corning criterion is much more straightforward to apply, since it was agreed by both counsel that, since the alleged prior use of the invention was by the patentee herself, it is certainly relevant. I would go further by adding that in my view the prior use, as pleaded, is of the greatest possible relevance. To borrow Mr Wyand's expression, the requested new ground has the potential to be a "knock-out", and I know of no firmer confirmation of relevance.

Little was said at the hearing with regard to criterion (c). In the present proceedings there were some twenty three months between the filing of the application and the submission of the evidence in support of the requested new ground. Even if this time is extended to take account of the fact that a formal request to add the new ground was not made until some eight months after the evidence was filed, this delay is not as long as that of over four years which influenced the decision in Owens-Corning, and is also somewhat less than the delay of about three years which did not prevent the Hearing Officer from considering new grounds in Addressograph-Multigraph (though the patentees did not apparently contest entry of the new grounds in that case).

In relation to Owens-Corning criterion (d), Mr Wyand argued that the patentee had been aware of the evidence of prior use since August 1989, that it was in any case her own prior use, and that she had herself applied to amend the specification, thus incurring inevitable delays. Any further delay associated with the introduction of the new ground would therefore, he argued, not be unjust to the patentee. As to the public interest, Mr Wyand argued that

the overriding public interest was that the patentee should answer the allegation of self prior use.

Mr Hamer's main arguments in relation to the question of prejudice to the patentee concerned costs, and I shall return to these.

In all the circumstances, and taking full account of the Owens-Corning criteria and of any other relevant factors, I conclude that I should permit the new ground of prior use to be admitted. The most important single factor for me in coming to this conclusion has been that, as pleaded, the alleged prior use was by the patentee herself, and was therefore of potentially fatal consequence for the patent. It would, I consider, in these circumstances, be wrong, and contrary to the public interest, for me to allow such a central challenge to the validity of the patent to go uninvestigated. The absence of evidence in relation to due diligence is a serious omission by the applicant but does not, in my view, in the present case, override the public interest need for the new ground to be tested. Any suggestion of undue prejudice to the patentee as a result of the additional delay is countered by the recognition that the patentee has at all times been aware of what she has actually done, even though she may not have been conscious of its consequences. I therefore formally allow amendment of the pleadings by admission of the second supplementary statement of 9 April 1990 into the proceedings.

Such amendment of pleadings requires an opportunity for reply, and I therefore allow the patentee two months from the date of this decision within which to file any supplementary counterstatement dealing with the matter raised in the second supplementary statement of 9 April 1990.

Mr Hamer argued at some length that, if I were to allow the pleadings to be amended, I should protect the patentee

in respect of costs by making an "Earth Closet" order or an order of the kind made in See v Scott-Paine, 50 RPC 56. I do not propose to discuss Mr Hamer's submissions in this regard in any detail since, as Mr Wyand observed, the practice in the Patent Office in relation to costs differs fundamentally from that of the courts. In the Office awards are made only as contributions to costs, and do not reflect the full costs entailed. I therefore do not regard the sort of protection provided by Earth Closet or See v Scott-Paine orders as appropriate for the Office, and I decline to make such an order.

I turn now to the question of discovery. As Mr Wyand observed, this becomes a live issue with my allowance of amendment of the pleadings. Mr Wyand's arguments in support of discovery were brief. He noted that the applicant had attempted to obtain information from the Royal College of Art in respect of the patentee's degree show, but that they had refused to allow access to slides. He argued that if the patentee had any relevant documents in respect of the two allegations of prior use then they should be put before me.

Mr Hamer referred me to the passage in The Supreme Court Practice (104/11/3) which states that discovery is only ordered when the issues are clearly defined, and he pointed out that there had as yet been no opportunity for the patentee to put in counter pleadings on the prior use issue. I accept that the Patent Office should operate to the same broad constraints in relation to discovery as the courts, and I agree with Mr Hamer that it would be premature of me to order discovery at this stage. Mr Hamer himself commented that it was possible that in a supplementary counterstatement the patentee may be able to make certain admissions which would render discovery irrelevant, and I am reluctant to order discovery before this possibility has been fully considered. I therefore decline to make any order at this stage in relation to

discovery, though in doing so I do not rule out the possibility that discovery may become appropriate at a later stage in the proceedings.

Although there was some brief discussion at the hearing of the requested amendments to the specification of the patent, it was, I think, agreed by counsel for both sides that this should be deferred to a substantive hearing. In any event it seems to me possible that resolution of the prior use issue may radically alter the situation in relation to amendment. I therefore say nothing further at this stage regarding amendment of the specification.

My uncertainty as to how these proceedings are likely to evolve beyond the filing of a supplementary counterstatement makes me reluctant to lay down further formal procedural requirements at this stage. I therefore invite both parties to submit views on further procedure in the month following the filing of such supplementary counterstatement, and having considered any such views I will determine the future course of the proceedings.

This being a procedural matter, any appeal should be lodged within fourteen days after the date of this decision.

Dated this 16 day of October 1990



Dr P FERDINANDO
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE