

0/1/91

PATENTS ACT 1977

IN THE MATTER OF a reference
under Section 8(1) by
Glidevale Building and Products Ltd
in respect of Patent Application No 8709245
in the name of Manthorpe Limited

STATEMENT OF REASONS FOR PRELIMINARY DECISION

Patent Application 8709245, which relates to apparatus for ventilating pitched roof spaces and is particularly concerned with apparatus for location at the soffit of the eaves of a pitched roof, was filed by Manthorpe Limited on 16 April 1987 claiming the priority of an earlier application No 8609214 filed on 16 April 1986. The application was published under serial number 2190740 on 25 November 1987. The inventors are identified as Paul Gordon Pochciol and Douglas William Roberts.

A patent was granted on the application on 31 October 1990. Section 9 prescribes that section 8 proceedings continuing at the time of grant shall be treated as proceedings under section 37, which relates to determination of right to a patent after grant. However, for convenience, in this decision I refer to Manthorpe Limited as the applicants.

On 28 October 1988, Glidevale Building and Products Limited ("the referrers") filed a reference under Section 8(1)(a), accompanied by a statement of case. The counterstatement and evidence in chief from both sides was filed as prescribed by rule 7, the applicants being granted an extension of time of one month in which to file their evidence. In an official letter dated 25 October 1989, the referrers were advised, again as prescribed by rule 7, that they had three months in which to file further evidence confined to matters strictly in

reply. Shortly before the end of this period the referrers requested that it be extended by three months under rule 110. The reasons given were (i) leading counsel had been consulted and had identified certain matters which required further investigation, and (ii) additional evidence had just come to light which appeared to be in direct conflict with evidence already presented by the applicants and which required extensive further investigation which was unlikely to be possible to conclude within two months.

On 22 March 1990 the referrers submitted their second round of evidence in the form of statutory declarations (and exhibits thereto) by Glen Robert Hayes, David Bottomore, Paul Bottomore, John Edward Lewis, and Julian Jeffs QC, and requested that leave be given to file this evidence. In an accompanying letter it was explained that in investigating records in order to deal with the points raised by the applicants in their evidence, the referrers discovered further information relating to the inventorship of the invention claimed in the application. Accordingly the referrers also sought leave to amend paragraph 4 of the statement of case. Paragraph 4 incorporating the amendment, which is described in the letter as being of fundamental nature, reads (the amendment being underlined):

"4. The invention described and claimed in the Application was invented in 1982 by Paul Bottomore of Langton Hall, Pinxton, Nottingham, and/or David Bottomore (who was and is a director of Glidevale) of the Foundry House, Millmoor Lane, Meltham, West Yorkshire, not, as stated in Form 7/77, by Messrs Pochciol and Roberts".

In a further letter dated 25 May 1990, the referrers explained that the preliminary drafts of the evidence were to some extent prepared prior to the letter of 19 January 1990.

However, at a conference shortly before that date, leading counsel had identified other aspects of the matter on which evidence was required relating to the origins of the invention. This essentially involved inspection of the originals of certain exhibits to the applicants' evidence before the referrers' evidence could be finalised, and despite repeated requests access to the documents was not finally granted until 3 weeks after the original request on 18 January.

The applicants strongly resisted the granting of leave to the referrers to amend the statement and any extension of time for filing the evidence in reply, and on 31 October 1990, a preliminary hearing took place before me to decide:

- (a) the question of allowability of extension of time for filing the referrers' evidence in reply;
- (b) the referrers' request for leave to amend the statement of case;

and (c) subsequent procedure on the reference.

At the hearing, Mr Nicholas Bragge appeared as counsel for the referrers, and Mr John Fitzgerald appeared as counsel for the applicants.

After hearing both parties I gave an oral decision in which I allowed the late filing of the referrers' evidence but declined to allow them leave to amend the statement of case. In giving my decision I emphasised that I was expressing no view as to whether any part of the evidence filed is inadmissible as being not strictly in reply. I undertook to give the reasons for my decision in writing, and this I now do.

At the hearing, Mr Fitzgerald sought to persuade me not to accede to the request for extension of time for filing the applicants' evidence in view of the nature of the evidence filed, the fact that parts of the evidence could have been filed within the prescribed period, and the fact that extending the period would prolong the time during which ownership remains in question, with consequent diminution of the value of the patent.

As I understood him, Mr Fitzgerald argued that since the evidence includes matter which in his opinion was not strictly in reply and which was known or available prior to the date on which the three month period prescribed by rule 7 would have elapsed, as well as matter already present in the evidence in chief, the nature and quality of the evidence is not sufficient to justify an extension of time.

As indicated earlier, I am not prepared to express a view as to the admissibility or otherwise of the further evidence. I would however note that, while Mr Bragge did not positively admit that certain of the evidence is not evidence in reply, he did accept that David Bottomore's declaration very substantially goes to the amendment of the statement, and he acknowledged, "if one wants to be totally legalistic, that is not in reply, probably, or might not be". However, as asserted by Mr Fitzgerald, correctly in my view, it is one question whether an extension of time in which to file evidence should be granted, and quite another whether evidence which is filed within that time is indeed admissible at the substantive hearing. Accordingly, I consider the question of whether or not the evidence is admissible to be irrelevant to the question of extension of time. Likewise, I do not consider any duplication of documentation to be relevant to the extension question.

I see no reason why the referrers, having requested an extension of time prior to the end of the prescribed period, should proceed to file individual affidavits as and when they became available rather than waiting until the evidence was complete. Accordingly, I do not consider that the fact that the affidavit of Mr Julian Jeffs QC was available for filing before the end of the prescribed period should influence the allowance of an extension of that period.

While I accept that prolonging the period during which ownership remains in question may be prejudicial to the applicants, it can equally be argued that the same applies to the referrers should the question be determined in their favour. I do not regard such a consideration to be an impediment to the allowance of an extension of time.

As I see it, although compliance with the time periods prescribed by rule 7 is to be encouraged, it is not unusual for the comptroller on request to use his discretion under rule 110 to extend a time period for the filing of evidence by the sort of amount entailed in this case, to ensure that the matter at issue may be fully investigated and to assist him in determining the matter. Mr Fitzgerald's reasons for not allowing an extension of time were not sufficient to outweigh the possible advantages that may be derived from any admissible evidence and I accordingly allowed the requested extension.

Although at the hearing Mr Bragge was not prepared to agree with his clients' description of the fundamental nature of the requested amendment to the statement of case, I consider that the introduction of Mr David Bottomore as inventor or co-inventor constitutes a material alteration of the case. Indeed, it appears to me effectively to constitute a new case which, if I were to allow it, would require a complete new round of counterstatement and evidence. Mr Bragge and

Mr Fitzgerald both drew my attention to parts of the reply evidence which indicate that the declarants, and hence the referrers, knew before the reference to the comptroller was made of the involvement of David Bottomore and of the existence of a key drawing dated December 1982, described by David Bottomore as "my drawing", and exhibited as DB3 to his declaration. David Bottomore himself states that on at least two occasions since April 1986 he recalled having told the referrers' solicitors in general terms that he thought such a drawing existed. It is asserted that although searches were made in 1986 and when these proceedings were instituted, the drawing came to light only when a total search of all 16 cabinet drawers full of design files was put in hand in October 1989, some 12 months after the filing of the reference.

There are, in my view, several significant factors that I must take into account. First, at least at the time the reference was made there was amongst the referrers' directors and representatives, according to the referrers' reply evidence, a general knowledge of David Bottomore's early involvement, and even of the drawing DB3. David Bottomore's own evidence is that in 1986 he "recalled having done my design DB3 and searched for my drawing without result". He states that he did so again when the present proceedings were instituted. Second, the searches that were initially made to substantiate and particularise David Bottomore's contribution were shown, by the success of the later search for the drawing, to have been inadequate. Since, at a very late stage in the course of events, it was deemed necessary to search through all 16 drawers of design files, I cannot avoid the conclusion that it is an indication of lack of diligence that the decision to perform this level of search was not taken on either of the two earlier occasions when efforts were made to find the drawing, and especially at the commencement of the present proceedings. Third, and perhaps most significantly of all,

there is a complete absence in the referrers' unamended statement and their first round of evidence of any reference even to the existence of David Bottomore, let alone to his alleged involvement in the creation of the invention, which I am now told was general knowledge within the company. Equally there is no suggestion at that stage in the documents submitted in the reference to the comptroller of the existence of drawing DB3.

I am thus confronted with incompatible positions on the part of the referrers in their two rounds of evidence which lead me to conclude that due diligence was not observed in the preparation of the original reference, and that there was undue delay in bringing to the comptroller's attention the knowledge of David Bottomore's alleged involvement. In my judgement, on the facts of the case, these considerations are sufficient to override the possible relevance of the proposed amendment of the statement to the question of entitlement.

Mr Bragge argued that not to allow the amendment could result in a fresh reference. This may well be so but, on the facts of the case, I do not regard this expediency argument as sufficient to outweigh the reasons given above for my conclusion.

For these reasons I declined to allow the amendment to the statement.

After hearing my decision, both counsel made submissions as to subsequent procedure. Mr Fitzgerald argued that the applicants should have an opportunity to file such evidence as they feel appropriate to deal with the referrers' evidence for which the extension of time had been allowed. Mr Bragge did not object to this. I appreciate that the applicants may be in some difficulty in the absence of any guidance as to the admissibility of the evidence, and after discussion of the

period to be allowed, I granted a period of two months from the date of my decision for the filing of any such evidence.

Mr Bragge indicated that he would wish to cross-examine a number of deponents at the substantive hearing, but after hearing submissions on this matter I indicated my reluctance to make any order at this point.

Mr Bragge raised the possibility of further evidence which may be filed by the referrers. I indicated that there was no order that I could make on the basis of what had been produced at the hearing; the filing of any such evidence is subject to the discretion given to the comptroller under rule 7(6).

Finally, after hearing both counsel on the question of costs I decided, in view of the balance of my decision, that no order for costs in these preliminary proceedings should be made.

This being a procedural matter, the period for appeal except by leave of the Court terminated fourteen days after the date of the oral decision, that is, 31 October 1990.

Dated this 3 day of January 1991



DR P FERDINANDO
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE

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