BLO / 011/90

PATENTS ACT 1977

IN THE MATTER OF an application
under Section 72 by Glaverbel for
the revocation of Patent No
2035524 in the name of
Coal Industry (Patents) Limited

PRELIMINARY DECISION

Application has been made by Glaverbel under section 72 for an order by the comptroller revoking Patent No 2035524 granted on 4 August 1982 in the name of Coal Industry (Patents) Limited ("Coal Industry"). In the course of these proceedings, Glaverbel have requested a preliminary hearing on the admissibility of evidence filed on 8 June 1989 by Coal Industry, on their request that the comptroller should direct that this evidence should be treated as confidential under rule 94(1) of the Patent Rules 1982 and on the subsequent procedure to be followed in these proceedings.

The preliminary hearing was held on 16 November 1989, when Glaverbel and Coal Industry were represented by their respective counsel Mr Geoffrey Hobbs and Mr George Hamer.

The patent in suit relates to a method of and apparatus for flame spraying refractory material using a lance which, it is contended, overcomes the problems of flame flashback and lance blockage encountered in prior art processes.

The application for revocation was filed by Glaverbel on 8 December 1986 accompanied by a statement under rule 75(1) setting out the grounds for revocation and the facts on which Glaverbel rely. The grounds pleaded are first 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 second that the invention is not a patentable invention in that it is not new and does not

involve an inventive step having regard to common general knowledge and matter disclosed in certain cited documents.

In response, Coal Industry filed a counterstatement under rule 75(3) denying each of the grounds pleaded. This was followed in due course by Glaverbel's evidence in chief in the form of a (first) affidavit by Leon Phillipe Mottet sworn 7 September 1987 ("Mottet 1") and thereafter by Coal Industry's evidence in answer in the form of a (first) declaration by Leslie Ernest John Tucker sworn 24 February 1988 ("Tucker 1").

In addition to these revocation proceedings and running in parallel therewith were proceedings arising from unconditional amendments offered by Coal Industry in their counterstatement under rule 75(3). These amendments were formally opposed by Glaverbel on Patents Form 15/77 and in an accompanying statement under rule 78 filed 17 December 1987. Coal Industry's response was contained in a counterstatement in support of the amendments filed 24 May 1988. Glaverbel then filed their evidence in chief in support of their opposition, this being in the form of a (second) affidavit by Mr Mottet sworn 15 July 1988 ("Mottet 2"). Subsequent to the filing of this evidence, Coal Industry informed the comptroller in their patent agent's letter of 2 November 1988 that they wished to withdraw their offer to amend, stating:

> "This will dispose of the Opposition to the amendments and leave the Applications [sic] for Revocation to proceed on the basis of the specifications [sic] as originally filed."

The position at this date was therefore that the proceedings on Coal Industry's offer to amend, and consequently on the opposition thereto, were de facto terminated. Mottet 2 was expressly filed in the opposition proceedings, not in the revocation proceedings per se. Since there was some confusion as to its present status I took care to enquire of

Mr Hobbs at the hearing whether it was still in the proceedings, now limited to revocation. He confirmed that in his view it was not. Mr Hamer argued that it should still be in, and I fully accept that, given the interrelationship of the two proceedings, it might have been possible to deem it to be admitted in the revocation proceedings had the party filing it wished it to be so. However, that is not the case, and I do not consider that I should oblige Glaverbel to include as part of their evidence in the revocation action something that they expressly do not wish to include. I therefore find that Mottet 2 is not part of the evidence in the revocation proceedings. It will emerge that this has consequences for the consideration of the admissibility of Tucker 2.

To return to the position in November 1988, Glaverbel's evidence in reply in the revocation proceedings had not been filed, and that is still the case. My above finding makes it clear that Mottet 2 does not perform this role. The three month period allowed for filing the evidence in reply was subsequently extended to 17 June 1989. However, before the expiration of this period, Coal Industry filed on 8 June 1989 supplementary evidence in the form of a second declaration by Mr Tucker sworn 1 June 1989 ("Tucker 2") together with three exhibits labelled 2 LEJ1 to 3 referred to therein.

In their patent agents' letter dated 20 June 1989, Glaverbel submitted that Tucker 2 and the accompanying exhibits should not be admitted. They also submitted that this evidence contained confidential information and should therefore be kept off the public record. In a subsequent letter dated 17 August 1989, Glaverbel contended that if this evidence were to be admitted, it should be restricted to matters on which Coal Industry propose to rely and which are relevant to the points in issue in these proceedings or, alternatively, that Coal Industry should be required to identify the passages in the exhibits relevant to the proceedings in suit.

I will deal first with the admissibility of Tucker 2 and its accompanying Exhibits.

The purpose of this evidence is explained in paragraph 2 of Tucker 2 which reads:

> "I have read Mr Mottet's Second Affidavit [i.e Mottet 2] and, now that the amendments proposed have proved not to satisfy the Applicants and have therefore been withdrawn, I would like very briefly to deal with part of it. I have been asked to confine myself to that part which may be affected by the withdrawal of the amendments, rather than to deal with the whole of his declaration."

It is clear from this paragraph, and was confirmed by Mr Hamer, that this supplementary evidence was filed in response to Mottet 2. I have already found that Mottet 2 has no place in the present proceedings, and it follows that, notwithstanding that Tucker 2 may reply only to aspects of Mottet 2 which might in principle have survived the withdrawal of the amendments, Tucker 2 has no logical place in the proceedings. It replies to "evidence" which is not itself in the case. For this reason I refuse to admit Tucker 2 and its accompanying exhibits.

Having decided this, I must now decide on what directions to give on the subsequent procedure in the revocation proceedings in accordance with the comptroller's powers under rule 75(7).

Mr Hobbs submitted that Glaverbel's evidence in chief, viz Mottet 1, was directed primarily to the patent as amended in accordance with Coal Industry's unconditional offer in their counterstatement rather than to the patent as granted. The goal posts having now moved, in his phrase, he proposed that Glaverbel should be allowed to file supplementary evidence in

chief directed to the patent as granted and that Coal Industry should then be allowed to file supplementary evidence in answer before Glaverbel filed their evidence in reply.

Mr Hamer resisted this proposal on the grounds that the evidence already filed, including Mottet 2 and Tucker 2, was relevant to the patent both as granted and as amended in accordance with Coal Industry's unconditional offer. However, it is now clear that neither Mottet 2 nor Tucker 2 are admitted in the present proceedings. I am conscious of the fact that to accede to Mr Hobbs' proposal will further the delay the settlement of the proceedings, but the alternative would be to proceed on the basis of evidence, viz. Mottet 1 and Tucker 1, which Mr Hobbs says is not complete from Glaverbel's point of view and which Coal Industry have sought to supplement with Tucker 2 and accompanying exhibits. Under the circumstances I have concluded, albeit reluctantly, that it would not be satisfactory to proceed on the basis of Mottet 1 and Tucker 1 alone. I therefore agree to the procedure proposed by Mr Hobbs. However, in order to minimise any further delay in the proceedings, and having regard to the fact that it is only supplementary evidence which is to be filed, I am of the view that the respective periods for filing this evidence should be only two months rather than the normal three months.

In accordance with this decision, Coal Industry will have the opportunity to file supplementary evidence in answer. Clearly, I cannot ignore the possibility that this evidence might well comprise at least part of the substance of Tucker 2 together with its associated exhibits which, in the absence of any directions as to subsequent procedure under rule 75(7), could lead to a further hearing on two matters relating to this evidence which were argued fully at the preliminary hearing.

The first of these matters is Glaverbel's request that the comptroller should direct under rule 94(1) that the declaration Tucker 2 and two of its accompanying exhibits 2LEJT2 and 3 should be treated as confidential.

Exhibit 2LEJT2 is a copy of an affidavit by Mr Tucker sworn 15 September 1988 filed in evidence in High Court proceedings brought by Glaverbel against British Coal Corporation and National Smokeless Fuels Limited in respect of UK Patent Nos 1330894 ("894"), 2110200 and 2154228 in the name of Glaverbel, together with exhibits referred to in this affidavit by Mr Tucker. "894" is one of the prior documents cited in the present proceedings. 2LEJT2 also includes an affidavit and exhibit of Stephen Gerrard Nowell in the same High Court proceedings.

Exhibit 2LEJT3 is a copy of a report by the North Rhine-Westphalian authorities on a detonation which occurred during ceramic welding in the Zollverein coke works on 18 June 1986, together with an unsworn translation of part of this report.

Mr Hobbs submitted that Tucker 2 and its accompanying exhibits should be confidential in view of allegations therein of accidents involving flashback using the Glaverbel process which forms the subject-matter of "894". He contended that these allegations were based on hearsay and lacked particularity and would therefore be unsatisfactorily prejudicial to the interests of Glaverbel if laid open to public inspection, without having any probative effect as far as the comptroller is concerned. In support of this, he referred me to to a copy of an order of Master Gowers dated 28 October 1988 and entered 8 November 1988 that, inter alia, a reference to reports of flashbacks using the Glaverbel process be struck out of the pleadings in the High Court proceedings.

Mr Hamer, in reply, contended that the evidence in question was not being treated as confidential in the High Court proceedings and, since it had not been obtained either on discovery or with any restriction as to the use of which it should be put, there were no grounds for making it confidential in the proceedings in suit.

Having considered the evidence in question, I cannot agree with Mr Hobbs that these documents should be subject to a confidentiality order. The exhibits in question consist of copies of affidavits filed in High Court proceedings in which there is no suggestion that they are to be treated as confidential, copies of published patent applications, a copy of the published patent in suit, copies of published articles from technical journals and copies of reports and correspondence in respect of which there is no suggestion that confidentiality is claimed by their authors. Under these circumstances, I can see no justification why any of these documents should be treated as confidential.

However, I do not think that I can ignore the fact that Master Gowers has ordered the striking out of certain parts of the exhibited evidence in the High Court proceedings brought by Glaverbel. I am therefore of the view that if Coal Industry wish to file as evidence in the present proceedings any evidence filed in the High Court proceedings, such evidence should be in the form allowed by the High Court. Accordingly, it should not include matter ordered by Master Gowers to be struck out.

As regards the content of Tucker 2 itself, I see no reason for directing that this should be treated as confidential when the exhibited evidence on which it is based is not to be so treated.

The second matter raised by Mr Hobbs was his submission that Tucker 2 and its accompanying exhibits should be restricted to matters relevant to the proceedings in suit or,

alternatively, if this evidence is to be admitted, there should be a direction by the comptroller requiring Coal Industry to identify the particular statements and portions in the exhibited material on which they intend to rely.

As regards the first of these alternatives, Mr Hobbs drew my attention to the decision in Hill v Hart-Davis (vol.26, 1884; Chancery Division) that the court had an inherent power to take pleadings or affidavits off the file for prolixity. Mr Hamer accepted that parts of the exhibits were not relevant to the present proceedings but submitted first that it was apparent which parts were relevant and second that it was desirable to submit the whole of the High Court evidence rather than to select parts of it in order to avoid any suggestion that the parts selected had been taken out of context.

Having considered the matter, I accept Mr Hamer's argument that it is desirable to file the whole of the evidence to avoid any suggestion of selection. However, it seems to me that evidence in this form can cause difficulties in the present proceedings in that it is not in fact clear on which parts of the exhibits accompanying Tucker 2 Coal Industry intend to rely. Accordingly, I am of the view that if this exhibited evidence is filed by Coal Industry as part of their supplementary evidence in answer, it should be accompanied by a declaration or affidavit which clearly identifies which parts are relied on.

Mr Hobbs also sought an award of costs for Glaverbel arising from the proceedings resulting from the amendments unconditionally offered by Coal Industry and subsequently withdrawn. Mr Hamer accepted that Coal Industry must be responsible for some costs for this. He submitted, however, that these costs and the costs of the revocation action should be dealt with together at the conclusion of the revocation action with provision being made for the fact that an amendment was put forward by Coal Industry and then

withdrawn. In my view, this is the appropriate procedure in the present circumstances and I therefore make no decision on costs at this stage.

In accordance with my findings above, I therefore direct that Glaverbel shall have a period of two months from the date of this decision in which to file any supplementary evidence in chief in support of their case for revocation of the patent as granted, and that they shall send a copy of any such supplementary evidence to Coal Industry. Coal Industry will then have a period of two months from the receipt of this supplementary evidence in which to file any supplementary evidence in answer, and they shall send a copy of this supplementary evidence to Glaverbel. Glaverbel will then have a period of three months from the receipt of Coal Industry's supplementary evidence in answer, or if Coal Industry do not file any supplementary evidence from the expiration of the time within which such evidence might have been filed, in which to file further evidence confined to matters strictly in reply to Coal Industry's evidence in answer and any supplementary evidence in answer, and shall send a copy of it to Coal Industry.

I further direct that if Coal Industry file as supplementary evidence in answer evidence comprising matter contained in the statutory declaration identified above as Tucker 2 and/or any or all of its accompanying exhibits, then such matter and/or exhibits:

a) shall not be treated as confidential under rule 94(1);
b) shall not contain matter struck out in accordance with Master Gowers' order of 28 October 1988 entered 8 November 1988;

and c) shall be accompanied by further evidence in the form of a statutory declaration or affidavit stating which parts of the exhibits are relied on by Coal Industry in the proceedings in suit.

Dated this 21st day of December 1989

DR P FERDINANDO
Superintending Examiner, acting for the Comptroller