

BLO/031/87

PATENTS ACT 1977

IN THE MATTER OF an application
by National Coal Board under Section 72(1)
for the revocation of Patent No. 2004317
in the name of Gebr. Eickhoff Maschinenfabrik
u Eisengiesserei mbH

PRELIMINARY DECISION

The patentees Gebr. Eickhoff Maschinenfabrik u Eisengiesserei mbH requested a hearing to decide three points following the decision of the applicants of revocation, the National Coal Board, not to file evidence on their application for revocation of patent no. 2004317.

The applicants filed the application for revocation on 15 February 1985. The ground for revocation is that the invention of the patent is not a patentable invention because of the lack of both novelty and inventive step and various prior documents were cited in the accompanying statement. A further document was cited in a supplementary statement filed on 14 May 1985.

The counterstatement filed on 24 October 1985 on behalf of the patentees denied that the patent did not relate to a patentable invention. However the counterstatement proposed, in order to distinguish the invention of the patent more clearly from the cited prior art, the unconditional amendment of the specification by deleting one embodiment and restricting the scope of the claims. A retyped specification embodying the proposed amendments was filed with the counterstatement. The proposed amendments were advertised under Rule 78 of the Patents Rules 1982 on 19 February 1986, and no notice of opposition was filed.

The time for the applicants for revocation to file evidence was extended to 30 August 1986. In a letter dated 2 September 1986

it was stated that they had decided against burdening the matter with further material by way of evidence but they wished to be heard in connection with the present application particularly with respect to the allowability of the proposed amendments.

The patentees made three points in a letter dated 24 September 1986. First, the absence of any evidence precludes the applicants from contending that the invention is obvious since this is a question of fact which can only be decided on the basis of evidence and not on the basis of contentions made in the pleadings. Secondly, the absence of evidence from the applicants must result in all matters in dispute on the pleadings being decided in the favour of the proprietors. Thirdly, the applicants have no right to comment on the allowability of the amendments since no notice of opposition to the amendments was filed within the period of three months permitted by Rule 78. This period is not extendable under Rule 110.

These matters were considered at a hearing before me on 6 February 1987, when Mr S Thorley appeared as counsel for the patentees and Mr R Lunzer as counsel for the applicants for revocation.

I will deal first with the point about the proposed amendments. Mr Thorley's argument was that I must apply Rule 78 as it stands, and that the natural meaning of the words in it was that any opposition to the proposed amendment must be filed within the specified time limit. He said that the applicants had disentitled themselves from questioning the amendments, because they had failed to enter opposition under Rule 78. He contrasted this with the rules for implementing the parallel jurisdiction of the Patents Court, where Order 104, Rule 3 makes it clear that the applicant for revocation is treated as being a party to the amendment proceedings.

Applications for amendment under Section 75 are confined to the situation where the validity of the patent has been put in issue.

Such an application is therefore an interlocutory matter in the particular proceedings in which the patent is already under attack. I turn to Rule 78 therefore expecting that if there are any special requirements for the attacker to comply with they will be clearly set out. Rule 78 is printed under the title:-

"Amendment of patents in infringement or revocation proceedings.

Procedure on advertisement of proposed amendment under Section 75"

and reads:-

"78. (1) Where in proceedings before the comptroller a proposed amendment under Section 75 is advertised, notice of opposition to such an amendment shall, within the period of three months from the date of advertisement in the Journal, be filed on Patents Form No. 15/77.

(2) Such notice shall be accompanied by a copy thereof and be supported by a statement in duplicate setting out fully the facts upon which the opponent relies and the relief which he seeks. The comptroller shall send a copy of the notice and statement to the proprietor of the patent and any other party to the proceedings before the comptroller.

(3) The comptroller may give such directions as he may think fit with regard to the subsequent procedure."

Although the titles are not part of the Rules for the purposes of interpretation, they are consistent with the view expressed by Mr Lunzer that Rule 78 is concerned with advertising to attract new parties into the proceedings. I agree with Mr Lunzer's interpretation. The point of advertising is of course to inform persons who are not already parties to the validity proceedings of the proposed amendment, the parties to the proceedings being automatically made aware of the amendments. Since the advertisement is not therefore primarily directed to existing parties it seems reasonable to conclude that an existing party

wishing to oppose the amendments is not bound by the requirement to file notice of opposition, and that had Rule 78 be intended to bind existing parties there would have been an explicit reference to that effect especially in view of the contrary court practice, mentioned above, and in view of the practice under the 1949 Act of an existing party been able freely to oppose amendments.

In support of this conclusion I should mention that, as Mr Lunzer pointed out, advertising a proposed amendment is at the discretion of the Comptroller. If the Comptroller decides in a particular case not to advertise the amendments filed in response to a revocation action then I consider it beyond dispute that the applicant for revocation might still oppose the amendments.

In my view, Rules 78(1) and (2) set out a procedure, with a certain time limit, by which new parties can enter the proceedings. When the time limit expires, Rule 78(3) comes into operation, and that gives the Comptroller discretion to admit objections from the existing parties. It is however a matter of discretion. If the applicant for revocation were to file objections to the amendment within the time limit under Rule 78(2) applicable to new parties, namely by 19 May 1986 in this case, it would be difficult to imagine circumstances in which the Comptroller would refuse to entertain the objections (provided they were germane to the proceedings). Where, as here, however, the objections were filed some months later, it is necessary to consider whether the objections should be refused by reason of the delay. In fact no procedural step appears to have been taken between 19 May when the opposition period expired and 2 September 1986 when the applicants for revocation wrote to the Office to say that they wished to be heard in connection with the allowability of the amendments, and there seems to be no reason to suppose that the patentees have been prejudiced by the delay. I am satisfied therefore, that under the authority of Rule 78(3) I should admit the applicants' objections to the allowability of the proposed amendments. The objection I shall entertain is contained in a statement filed on 26 November 1986, namely that:-

"the proposed amendments, particularly as applied to claim 1, should be refused in the Comptroller's discretion because the term

'an advancing motor for the driving wheel which is disposed in the casing of said end structural unit' is not clear and cannot be understood in the context of the specification as proposed to be amended."

The first issue raised in the patentees' letter of 24 September concerns the Comptroller's jurisdiction to find an invention obvious. The applicants are not proposing to file any expert evidence, and so the only relevant evidence available at the substantive hearing is likely to be a collection of patent specifications and possibly other technical documents.

Mr Thorley's submission on this issue, as I understand it, was that expert evidence is needed to find an invention obvious; the applicants are not putting expert evidence in, and so the attack based on obviousness fails. In my view that submission fails. Quite clearly the Comptroller has jurisdiction under Section 72 to find that an invention lacks inventive step, and faced with evidence in the form of documents found to be publicly available before the priority date of the patent he cannot refuse to consider whether they constitute sufficient evidence.

The issue is one of some practical importance to Mr Thorley, because he presumably needs to advise the patentees what presumption there might be that the skilled person would apply a solution appearing in one document to a problem identified in another document, and therefore what evidence would be needed to refute that presumptions.

The illustration given by counsel in argument was in my view a good one. A hearing officer might well be inclined to say that it was obvious to replace a nail by a screw, unless evidence were introduced to show the importance of their different frictional properties in the particular application. However, I cannot give

detailed guidance on this case without reviewing the evidence, and I cannot give any general guidance beyond saying that it must be assumed that the Comptroller's hearing officers have a general knowledge, in this case of mechanical engineering, but not a detailed knowledge, in this case of coal cutting machinery.

I shall deal now with the second issue raised in the patentees' letter of 24 September, which in effect asks me to decide, following the applicants' decision not to file evidence, what facts are to be taken to be admitted, and what matters are still in issue.

In fact there was no difference of opinion between learned counsel at the hearing. The applicants' case can be derived from their pleadings following the normal rules, and consists of the matters pleaded in the three statements filed on 15 February 1985, 14 May 1985 and 26 November 1986, minus any facts denied by the patentees in their counterstatement filed on 24 October 1985, and minus any facts expressed to be dependent on evidence to be filed to support them.

That deals with the preliminary issues that I was asked to decide, but I think it would be appropriate for me now to give directions under Rule 78(3) or Rule 100 as appropriate, with regard to the subsequent procedure in this case. Either party is at liberty to apply to vary these directions, particularly so as I was not addressed on them at the hearing.

First, it was agreed at the hearing that it would be sensible for a new statement of case to be prepared setting out the applicants' case in relation to the specification as proposed to be amended. I direct the applicants to file such a statement within six weeks of the date of this decision. The statement should be derived by the process set out above, but excising pleas that are not relevant to the specification as proposed to be amended.

I direct the patentees to file, within one month of receipt of the

applicants' new statement, a new counterstatement consisting of the counterstatement filed on 24 October 1985, plus any response to the matter pleaded in the applicants' second supplementary statement filed on 26 November 1986, minus any matters that are not relevant to the applicants' new case.

I allow the patentees three months from the date of receipt of the applicants' new statement to file any evidence in support of their case, and I allow the applicants three months from the receipt of any such evidence to file evidence strictly in reply to it.

I direct also that copies of any documents filed under the above directions should be sent to the other party.

Dated this 5th day of *March* 1987.

W J LYON

Superintending Examiner, acting for the Comptroller.

