

PATENTS ACT 1977

01166/92

IN THE MATTER OF AN application to
amend Patent Specification No
2144311 in the name of
Bridgestone Tire KK and an opposition
thereto by Maclellan Rubber Ltd

DECISION

This is an application under section 27 filed by the proprietors, Bridgestone Tire KK, ("Bridgestone") on 22 February 1989, advertised in the Official Journal (Patents) on 5 July 1989, and opposed by Maclellan Rubber Ltd, ("Maclellan") on 4 October 1989.

The patent relates to buoyant elongate cylindrical members which are intended to be linked together end-to-end to form a closed frame for supporting nets defining a fish breeding enclosure. Such articles are known, but the buoyant member of the present invention is distinguished from the prior art buoyant members by its dimensions coupled with certain physical characteristics.

The claims of the patent as granted read as follows:

1. A floatable frame member for use in a fish breeding apparatus, which is a hollow rod-shaped elastic body constituting a main part of a gas chamber therein, the said elastic body being composed of rubber or a rubbery elastic material and reinforced with fiber cords to have an outer diameter of about 279.4-about 609.6 mm (11-24 inches), a thickness of about 12.7-50.8 mm (½-2 inches) and a product between a Young's modulus and a sectional secondary moment of 100-3,000 kg.m², and having a ratio of circumferential stress to axial stress of 1.5-2.5 when an internal pressure of 0.1-20 kg/cm² is applied to the elastic body.

2. A floatable frame member for use in a fish breeding apparatus, according to claim 1, substantially as herein described with reference to, and as shown in, the accompanying drawings.

The requested amendment, which is expressed to be "to better define the invention", consists merely in the insertion of an additional claim, claim 3, which is directed to:

"A fish breeding apparatus which includes a plurality of floatable frame members as claimed in claim 1 or 2."

In their original statement of opposition, Maclellan opposed the proposed amendment on the grounds *inter alia* that the patent, both as it stood and as proposed to be amended, was invalid in view of a specified prior publication, specified prior use, and insufficiency. They were informed by the Office in a letter dated 10 December 1990 that section 74(2) did not allow validity to be put in issue in these proceedings and they were asked to confine their case to the allowability of the proposed amendment.

In an amended statement of opposition, filed on 20 March 1991, Maclellan oppose the amendment on the grounds (which I summarise) that:

- i. it does not meet the requirements of Section 76(2)(a) of the Act [now Section 76(3)(a)] in that it results in the specification disclosing additional matter;
- ii. it does not meet the requirements of Section 76(2)(b) [now Section 76(3)(b)] in that it extends the protection conferred by the patent;
- iii. it introduces lack of clarity and the new claim fails to properly define the matter for which protection is sought;
- iv. Bridgestone have not "come clean" in that they have not fully disclosed the reasons for seeking the amendment;

- v. a further reason for making the amendment is to render the patent valid, but this is not achieved; and
- vi. by retaining claims 1 and 2 Bridgestone are acting covetously.

Evidence in statutory declaration form has been filed by both parties, and the case was set down for hearing before me on 17 September 1992.

By the time I saw the papers in preparation for the hearing, Maclellan had decided not to appear at the hearing, but Bridgestone were proposing to appear by counsel. On a preliminary perusal of the file, it seemed to me that the application to amend was allowable, and the hearing probably a waste of money. The Office consulted Bridgestone's agents by telephone to ask whether they still wished to be heard. They said that they did not, and I then studied the papers in more detail and satisfied myself that the application was allowable, for the reasons which I now set out.

Maclellan's first three grounds of opposition are that the proposed amendment adds subject matter, extends the protection conferred by the patent and lacks clarity.

The two existing claims are for a floatable frame member for use in a fish breeding apparatus, and the proposed claim 3 is for a "fish breeding apparatus which includes a plurality of floatable frame members as claimed in claims 1 or 2". There can be no doubt that the specification describes fish breeding apparatus which includes a floating polygonal frame, each side of the polygon consisting of a frame member. In consequence the proposed claim 3 is supported by the description and would not add matter to the specification.

As regards the alleged extension of the monopoly, Maclellan submit that

"... a third party selling netting and connectors (presumably as required by the proposed claim 3) with instructions to purchase the tubular members of claim 1 or 2 outside the UK and to construct a fish breeding apparatus within the UK

would not infringe claim 1 or 2, but would be a joint tortfeasor in infringing proposed claim 3".

Thus they claim that the proposed amendment extends the monopoly granted by the patent.

Section 60(1) of the Act states that:

"... a person infringes a patent for an invention if, ... where the invention is a product, he makes, disposes of, offers to dispose of, uses or imports the product or keeps it whether for disposal or otherwise".

A person who supplies only nets or connectors does not infringe any of the claims of the patent under Section 60(1). However, such a supplier might be a party to infringement by virtue of section 60(2) which provides that:

"... a person ... also infringes a patent for an invention if... he supplies or offers to supply in the UK a person other than a licensee or other person entitled to work the invention with any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the UK".

The situation envisaged by Maclellan is in my view a realistic one, that a supplier of netting knows that the netting is going to be used with a frame member that is within the scope of claim 1 or claim 2 to make a fish breeding apparatus that is within the scope of claim 3. Such a supply will be an infringement if the netting is, in the words of the sub-section "an essential element of the invention, for putting the invention into effect".

My opinion is that netting is not such an essential element. Although netting is described as a constituent of the fish breeding apparatus, the invention is not limited to the use of any particular type of netting or indeed to any netting, though some enclosing structure is obviously essential. I therefore do not consider that the supply

of netting (and the same applies to connectors) in the circumstances envisaged would infringe the proposed claim 3, and I can envisage no other act that would be an infringement of the new claim 3 but not the existing claims 1 and 2. I therefore reject the objection that the amendment would extend the scope of the monopoly.

I am also satisfied that there is no substance in the opponents' objection that the proposed amendment lacks clarity and fails to properly define the matter for which protection is sought. The argument is that it is not apparent what features of a fish breeding apparatus are embraced by the proposed claim, but I do not think that the claim would confuse a person skilled in the art.

Maclellan's fourth ground of objection is that Bridgestone have not fully disclosed the reason for seeking the amendments. They add that the application to amend was made shortly after they had notified Bridgestone of certain prior art, and they add in their fifth ground that the real reason for the amendment is to make the patent valid.

Plainly the amendment would not avoid any relevant prior art, because no part of the monopoly is being disclaimed. The reason for the amendment given by Bridgestone in their application is to better define the invention, and indeed to my mind the amendment will make it clearer to the public at large that the patentee's monopoly covers the complete fish breeding apparatus as well as a major component of the apparatus. I therefore reject this objection.

The rest of Maclellan's opposition is dependent on the patent, whether amended or not, being invalid in the light of the specified prior art. It is well settled that an application to amend should not be turned into an enquiry into validity, and I therefore reject this part of the case. The appropriate sanction against a patentee who ignores prior art that renders his present invalid is an application for revocation. In summary therefore, I allow the application to amend.

Maclellan's opposition to the amendment has to a great extent been based on their contention that the patent is invalid, and almost all the evidence is directed to this issue. Since I have found this issue irrelevant to these proceedings, it is right that I

should make a modest award of costs to Bridgestone as a contribution to their costs.
I therefore award them the sum of £250 and direct that this sum be paid by Maclellan.

Dated this | day of October 1992

W J LYON

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE