BL0/073/86

PATENTS ACTS 1949 AND 1977

IN THE MATTER OF applications
by Walker Wingsail Systems Limited
for revocation of Patents No 1375191
and 1375192 in the name of Alastair
Hugh Garnet Murray (deceased)

DECISION

The patents both relate to sailing boats having rigid pivoted sail assemblies. No 1375191 relates to a counter-weight for the sale assembly and No 1375192 relates to a governor which limits the wind thrust which can be applied to the sail assembly.

In the late 1960's and early 1970's, boats with rigid sail assemblies were designed and developed by a company known as Planesail which was founded by a Mr John Walker who is managing director of Walker Wingsail Systems, the present applicants for revocation. The patents in suit stand in the name of Alastair Hugh Garnet Murray (referred to hereinafter as Mr Hugh Murray) who joined Planesail in 1968. Mr Walker subsequently left Planesail in circumstances which are in dispute. The present patents originated in provisional specifications filed by Mr Hugh Murray at about the time that Mr Walker left Planesail, but apparently without the latter's knowledge.

Revocation of the counter-weight patent, No 1375191, is sought on the following grounds:

(a) prior publication in articles in the Journals "Yachts and Yachting" and "Engineering" which describe Planesail projects.

(b) prior public use and demonstration of Planesail designs and prototypes, in particular at sea, at boat shows,

and to the author of the "Engineering" article.

(c) obviousness in relation to the prior publication and use.

(d) insufficient and unfair description.

(e) Mr Walker was the inventor of at least part of the invention claimed, and Mr Murray know that and also knew of the prior publication and use of the invention.

Revocation of the governor patent, No 1375192, is sought on the same grounds, except that there is no suggestion of prior publication in the "Yachts and Yachting" article.

Statement and counter-statement were filed in the usual way. After extensions, evidence on behalf of the applicants was filed on 6 August 1984. Two extensions of time for filing their evidence were then requested by the patentee's agents, and the second of these requests was opposed by the applicants. The circumstances which gave rise to the second request for extension are unusual. At some time after the patents were applied for and also after Planesail ceased to have any active existence, Mr Hugh Murray moved to Singapore where he was unfortunately killed in an accident in 1981. Much if not most of the Planesail records remained in an unsorted condition in Singapore. On the patentee's side, it was alleged that Mr Hugh Murray's son, Mr Julian Murray, is in practice the only person able to gain appropriate access to the Planesail papers which are in any case mixed up with Mr Hugh Murray's voluminous personal papers. Mr Julian Murray is engaged on refugee work in Africa and therefore clearly has great difficulty in providing the necessary papers.

At a hearing on 5 February 1985 I gave an extension of time for the filing of the patentee's evidence. That evidence was submitted within the extended period, although the declaration by

Mr Julian Murray was unsworn. It was foreshadowed that leave would in due course be sought to file further documents from the Singapore collection when Mr Julian Murray was able to produce them.

On 30 May 1985 the applicants applied to the Comptroller under Rule 103(3) for discovery of a wide variety of documents which, as I understand it, are largely if not entirely concerned with the question of who was the true inventor of the counter-weight and governor in question, and which were also likely to be among the documents housed in Singapore. On 25 June 1985 the applicants filed evidence in reply, but noted that it related only to matters not dependent on the sight of documents in respect of which discovery had been requested. Since the patentee's agents were not able to obtain instructions from Mr Julian Murray, they felt obliged to resist the request for discovery. A hearing was therefore appointed for 5 November 1985 to resolve the matter. However, on 28 October 1985 the patentee's agents filed offers to surrender both patents, in each case giving as the reason on Form 18/77 that the patentee did not wish to defend the patent against the application for revocation by Walker Wingsail Systems Limited. As required by Rule 43(1), the offers were advertised in the Official Journal dated 27 November 1985. No notice of opposition was received within the 3 month period set by Rule 43(2).

Under the 1977 Act, acceptance of an offer to surrender does not automatically involve revocation of the patent, so that the present applications need to be disposed of by issue of a formal decision. On 14 March 1986 the Office wrote to the parties giving its view that a sufficient case for revocation had been made out, that a decision should be issued revoking the patents, and that the offers to surrender should not therefore be accepted. The parties were given one month in which to oppose this course of action and to put forward arguments relevant to any award of costs. The parties replied by their agents' letters both dated 14 April 1986. On the substantive issues, the

patentees's agents simply state that a decision to revoke the patents will not be opposed. However, the applicants' agent presumes that a hearing will be offered, in accordance with Section 101, if the patents are not to be revoked on each and every ground put forward in their statements of case.

I do not propose to discuss the evidence in detail. I have considered it carefully and find that in respect of items (a) to (d) set out in my earlier summary of the grounds, the patentee's evidence is not a sufficient reply to the applicants' at least on the matters of obviousness and the various forms of prior use and prior disclosure, and that the applicants have made out a sufficient case on these grounds for the patents to be revoked. On the remaining ground relating to false representation and rightful inventorship, ie that set out as item (e) in my earlier summary, the applicants' evidence presents a strong and persuasive case. However, these are serious matters touching on the personal integrity of someone who cannot himself give evidence and I am not prepared to come to a conclusion on them in the absence of such evidence, particularly since I have already found that other grounds for revocation have been established. Furthermore, since the patents are to be revoked, it seems to me that no discretion has been exercised adversely to the applicants, and that the applicants' claim to a hearing under Section 101 is therefore not justified.

On costs, the applicants have asked for full solicitor and client costs, but I can see nothing in the present case to justify departure from the practice of awarding only a contribution towards costs in actions before the comptroller.

In the outcome, I order the revocation of both patents and, having considered the various arguments on costs put forawrd by

the parties in correspondence, I award the applicants £600 as a contribution towards their costs and direct that this sum be paid to them by the patentee.

Dated this 10th day of June 1986

N G TARNOFSKY
Superintending Examiner, acting for the Comptroller.

PATENT OFFICE