

PATENTS ACT 1977

0191/93

IN THE MATTER OF a request on Form 23/77 by Potts, Kerr & Co for a copy of evidence filed in an appeal to the Patents Court in respect of Patent No 2101984 in the name of the Marley (UK) Limited

DECISION

Patent Application No 2101984 entitled "Polymer-modified cement mortars and concretes and processes for the production thereof" in the name of the Marley Roof Tile Company (the "proprietors") was published under section 16 on 26 January 1983 naming Michael Eric Lynn as inventor. The granted patent was published on 24 July 1985, and now stands in the name of Marley (UK) Limited.

In a final Decision dated 28 November 1991, the Principal Examiner acting for the Comptroller revoked the patent in suit under section 73(2) on the ground that no further amendments had been submitted to meet his earlier finding in an interim Decision dated 17 September 1991 that that patent and the equivalent European Patent (UK) No 0069586B had been granted for the same invention.

Notice of appeal to the Patents Court against this decision was lodged by the proprietors on 9 January 1992. On 31 March 1992 the proprietors filed evidence in support of their case in the form of an affidavit by the inventor, Mr Lynn sworn 10 February 1992. Upon the appeal before the Patents Court on 6 May 1992 Mr Justice Aldous ordered that the Appeal be allowed and the Decisions dated 17 September 1991 and 28 November 1991 be discharged. Notice of appeal dated 29 May 1992 against this Decision of the Patents Court was then lodged to the Court of Appeal by the Treasury Solicitor on behalf of the Comptroller. This appeal is still to be heard.

Following the Decision of the Patents Court, correspondence was received from Potts, Kerr and Co, European Patent Attorneys and Chartered Patent Agents ("Potts, Kerr"), containing submissions regarding both the allowability of amendments to the claims made during the revocation proceedings and the interpretation of the claims in the granted patent, and requesting a copy of the evidence which was filed on the Appeal to the Patents Court, ie the affidavit of Mr Lynn.

This was followed by a formal request by Potts, Kerr on Patents Form 23/77 filed 24 March 1993 for

"A copy of the evidence which was filed by Marley on the Appeal to the Patents Court asserting that the concrete articles could be made in other ways",

it being made clear in the letter dated 23 March 1993 accompanying this Form that the request was in respect of the patent in suit.

Potts, Kerr before applying on Form 23/77 had requested the Civil Appeal Office of the High Court for a copy of the evidence. That Office declined to provide a copy. Accordingly, when this Office received the request on Form 23/77, it enquired of the Appeal Office whether it was aware of any legal provision overriding the obligation section 118(1) (see below) imposes on the Comptroller. The reply from the Appeal Office did not refer to any legal provision that would override the operation of section 118(1).

At Potts, Kerr's request, the Office asked the proprietors in an official letter dated 3 June 1993 if they agreed to the Office providing them with a copy of evidence in question. In their reply dated 16 June 1993, the proprietors' agents confirmed that they did not agree.

No agreement having been reached, and each party having stated in writing that they were content for the matter to be decided on the papers without being heard it now falls to me to determine the matter.

Section 118 of the Patents Act 1977 is the general provision providing inter alia for the inspection of documents relating to any granted patent. Section 118(1) reads:

"118.-(1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) give the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions."

The prescribed restrictions are those of rules 93(4) and (5) which are as follows:-

- "(4) The restrictions referred to in paragraph (1) above are:
- (a) that no document shall be open to inspection until fourteen days after it has been filed at the Patent Office;
 - (b) that documents prepared in the Patent Office solely for use therein shall not be open to inspection;
 - (c) that any document sent to the Patent Office, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;
 - (d) that no document filed at the Patent Office in connection with an application under section 40(1) or (2) or section 41(8) shall be open to inspection unless the comptroller otherwise directs;
 - (e) that no request made under rule 48, 49(2), 52(2) or 92 or this rule shall be open to inspection; and

- (f) that documents in respect of which the comptroller issues directions under rule 94 that they are to be treated as confidential shall not be open to inspection, save as permitted in accordance with that rule.
- (5) Nothing in this rule shall be construed as imposing on the comptroller any duty of making available for public inspection:
- (a) any document or any part of a document:
 - (i) which in his opinion disparages any person in a way likely to damage him; or
 - (ii) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or anti-social behaviour; or
 - (b) the file (but not the report) of the international preliminary examination of an international application under the Patent Co-operation Treaty; or
 - (c) any document filed with or sent to the Patent Office before 1 June 1978."

However, it has not been argued that the evidence in question is a document referred to in rule 93(4) or (5) and I am satisfied that it is not such a document. Therefore, rules 93(4) and (5) are not relevant to the request in suit.

The request is made on Patents Form 23/77 in accordance with the provisions of rule 52(2). This rule reads:

"(2) Upon request made on Patents Form 23/77 and payment of the appropriate fee, but subject to paragraph (3) below, the comptroller shall supply an uncertified copy

of an entry in or an uncertified extract from the register or an uncertified copy of or an uncertified extract from anything referred to in section 32(11)(b)."

The first matter to be determined is therefore whether the copy requested is a copy of anything referred to in section 32(11)(b). This section reads:

"(b) a copy of any document kept in the Patent Office or an extract from any such document, any specification of a patent or any application for a patent which has been published"

In fact, although lodged at the Supreme Court of Judicature, Chancery Chambers on 31 March 1992, the affidavit of Mr Lynn is now kept at the Patent Office on the file relating to the proceedings for revocation of the patent in suit under section 73(2).

Accordingly, I therefore find that as a matter of fact, this evidence is a document kept at the Patent Office and that the copy requested is therefore a copy of a document referred to in section 32(11)(b).

Rule 52(3) provides that the supply of copies under rule 52(2) is subject to the same prescribed restrictions (ie those of rules 93(4) and (5)) as the general provision of section 118(1), but as noted above these restrictions are not relevant to the request.

As the evidence was filed in support of the appeal against the Comptroller's decision to revoke the patent in the ex-parte proceedings under section 73(2), I would observe that it would seem right and proper for the evidence to be on the Office file relating to those proceedings. The purport of section 118(1), as I understand it, is that the public should have access to all documents (apart from the limited restrictions listed above) relating to the prosecution of a patent application before the Office. A patent gives a proprietor monopoly rights and under the provisions of section 118(1) the public can have access to any document held by the Office which might have a bearing on the validity of those rights. Thus in these ex-parte proceedings I consider that the evidence on appeal from the Comptroller is correctly on file, and that therefore section 118(1) and rule 52(2) apply to this evidence.

I am therefore satisfied that the request falls within the terms of both section 118(1) and rule 52(2). I also find that where the provisions of this section and rule are satisfied, the Comptroller is under an obligation to accede to the request, ie it is not a matter of discretion, and I am unaware of any statutory provision that overrides this obligation as regards the evidence in question.

I therefore order that the copy of the affidavit of Michael Eric Lynn sworn 10 February 1992 should be supplied to Potts, Kerr in accordance with their request on Patents Form 23/77.

However, to avoid negating the result of any possible appeal by the proprietors, I hereby stay the above order until after the period allowed for lodging an appeal to this Decision, including any extension thereto, has expired. In the event that an appeal is lodged, I extend the stay by a further month from the date of lodging of the appeal. It will then be a matter for the Court to decide on any further stay and under what conditions, if any, concerning the prosecution of the appeal the Court may wish to impose.

Under Order 104, rule 19(3) of the Rules of the Supreme Court, I determine that this is a matter of procedure. Accordingly, under rule 19(2) the period for appeal to the Patents Court is 14 days from the date of this decision.

Signed this 29 day of July 1993



B G HARDEN
Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE