

0/92/97

**PATENTS ACT 1977**

Mr P Hayward  
3Y46

IN THE MATTER OF an application  
by Delta Print and Packaging Ltd under  
Section 71 for a declaration of non-  
infringement of Patent No 2046060 in  
the name of Waddington Cartons Ltd.

Hayward 22/5/97

Adequacy of pleadings re. (s.71)

**PRELIMINARY DECISION**

1. Patent No 2046060 is concerned with a receptacle for use in microwave cooking in which, to permit browning of the food, a thin metal layer is provided on stock material. In July last year Delta Print and Packaging Ltd ("Delta") filed an application under section 71 of the Patents Act 1977 requesting a declaration of non-infringement of the patent. The proprietors, Waddington Cartons Ltd ("Waddington"), have filed a counterstatement, but the action has got no further because Waddington maintain that :

- The application should be rejected completely because the applicants' attempts to seek a written acknowledgement from the proprietors were not adequate to comply with the requirements of section 71(1)(a), and
- The act which the applicants wish to do is not adequately particularised.

2. The parties have agreed that I should decide these matters upon the papers without a hearing.

3. Section 71(1) states that:

"... a declaration or a declarator that an act does not, or a proposed act would not, constitute an infringement of a patent may be made by the court or the comptroller in proceedings between the person doing or proposing to do the act and the proprietor of the patent, notwithstanding that no assertion to the contrary has been made by the

proprietor, if it is shown -

- (a) that that person had applied in writing to the proprietor for a written acknowledgement to the effect of the declaration or declarator claimed, and has furnished him with full particulars in writing of the act in question; and
- (b) that the proprietor has refused or failed to give any such acknowledgement.

It is primarily (a) with which I am concerned in this preliminary decision.

4. The relevant events started with a letter to Waddington, written on 29 May 1997 by F R Kelly & Co, European Patent Attorneys representing Delta. This stated that Delta intended to "commercialise the subject-matter of enclosed International Publication No WO95/19926 within the United Kingdom", that they believed that "this would not infringe your Patent rights" and asking for an acknowledgement of non-infringement under section 71. In reply Bailey Walsh & Co, Chartered Patent Agents representing Waddington complained that:

"1. [The letter] fails to indicate any patent in relation to which you reach the "belief" that there is no infringement of our client's patent rights. Section 71 of the Patents Act 1977 requires you to identify a "patent" to obtain a declaration.

2. The specification which you sent to us describes a number of embodiments and methods of manufacture of certain products. Which one or ones does your client intend to "commercialise"? and what is meant by commercialisation?

3. You have not indicated any feature in relation to any patent whereby you can advance any argument to say that there is no infringement."

However, they also stated that "we take the view that all of the embodiments and methods of manufacture mentioned in the Specification which you sent to our clients, if sold and carried out in the United Kingdom, would be infringement of our client UK patent No 2046060B".

5. At this point Delta filed their application to the comptroller under section 71, enclosing the above two letters as evidence that the steps required by section 71(1)(a) and (b) had taken place. The Office responded with a preliminary view that the requirements of section 71(1)(a) had not been met, in that full particulars of the act in question had not been set out by Delta in their letter of 29 May 1996. They were asked to provide more details. In response, in a letter dated 20 September 1996 they stated that they proposed to:

"use, make, import, dispose of or offer to dispose of :-

1. A patterned conductive structure comprising :-

1.1 a substrate layer; and

1.2 a conductive layer disposed on a surface of the substrate layer, the conductive layer having at least one fuse link and at least two base areas, the base areas being linked to each other by the fuse links, and the fuse links being more susceptible to breaking upon exposure to microwave energy than the base areas; and

2. A food preparation receptacle incorporating same".

Save for the omission of a restriction to a structure "for use in microwave food packaging", the structure defined in 1 above corresponds to claim 1 of WO95/19926.

They then went on to say that they required a declaration in respect of such a structure or receptacle "each of which have a discontinuous metal layer". They also enclosed detailed drawings of a specific structure whose metal layer had a particular pattern and precisely-specified dimensions.

6. In due course, Waddington's filed a counterstatement, but when doing so and subsequently they maintained that the application has not been properly made since the initial request for an acknowledgement of non-infringement did not identify the patent in question, and that the initial request does not particularise the proposed act.

7. I have to say that I am not impressed by either side's handling of this case so far. The applicants' approach seems to me to have been sloppy and the patentees' unreasonable. On

the applicants' side, I have to agree that their original written request was defective in that the patent in respect of which an acknowledgement was required was not indicated and the particulars of the proposed act were inadequate. Their subsequent letter of 20 September removes some of these defects but unfortunately introduces others because it is self-inconsistent. It identifies the patent in question. It also identifies the kind of act they wished to do, ie "use, make, import, dispose of or offer to dispose of", though I doubt whether much is likely to turn on this. However, from that letter I still cannot work out in respect of which of the following they require a declaration:

- Any structure which falls within the scope of claim 1 of the PCT application WO 95/19926 A1 as published, and any food preparation receptacle incorporating that structure.
- Any structure which falls within the scope of lines 5 to 12 of their letter of 20 September, ie anything that falls within the scope of claim 1 of the PCT application save that it need not be for use in microwave food packaging.
- Any structure with a discontinuous metal layer on a substrate (bearing in mind, as the patentees have correctly pointed out, that the layer as illustrated in the PCT application is not discontinuous).
- Just the specific embodiments described in the PCT application.
- Just the specific structure shown, with dimensions, in the plan attached to their letter of 20 September.

8. The differences between these are significant. At one extreme, if they are interested in the first or second of the above, *prima facie* I will only be able to grant a declaration of non-infringement if I am satisfied that no structure falling within these definitions can infringe. This follows from, for example, from the comments of Goff L J (in proceedings under the corresponding section of the Patents Act 1949) in *Mallory Metallurgical Products v Black Sivalls and Bryson* [1977] RPC 321 at lines 30-34 on page 339. At the

other extreme, if they are only interested in the last of the above I only have to be satisfied that that particular structure does not infringe. Thus in my view the applicants have still not given clear enough particulars of the act in respect of which they require a declaration.

9. However, notwithstanding these problems, I have only limited sympathy with the patentees' protestations. The applicants' failure to specify the patent number in their original letter of 29 May did not actually cause the patentees any difficulties because it is clear from their response that they knew perfectly well which patent it was. Further, the applicants' failure to identify properly the structure they are interested in has not so far caused the patentees any problems because the patentees have made fairly clear that they feel every option infringes the claims of their patent. In these circumstances, to suggest that these failures justify throwing the whole action out is unreasonable and can only serve to delay the settlement of this issue.

10. It is well established that whilst the requirements of section 71(1)(a) must be met before a declaration of non-infringement may be made by the comptroller, the fact that the requirements were not met at the outset does not necessarily mean that the application may not proceed. It is not unusual to give an opportunity for an applicant to subsequently clarify the act on which a declaration was sought. This appears to have been done in *Mallory Metallurgical Products* mentioned above, and was certainly done in *Chr Hansen's Laboratorium A/S v Unilever NV* (SRIS 0/144/94) and in *Johnson Matthey PLC v Sumitomo Special Metals Co Ltd* (SRIS 0/145/94). I propose to do so here. Accordingly, having regard to my comments in paragraph 7 above:

**I hereby order the applicants to file within 14 days a clear statement of the act or acts in respect of which they seek a declaration under section 71. The statement should be copied to the proprietors.**

11. If the applicants fail to do this, I will strike the action out. Assuming they do supply a clear statement, however, I think it is pretty clear from what the proprietors have said already that they will refuse to give an acknowledgement of non-infringement no matter how broad or narrow the scope of what the applicants seek. Accordingly I do not feel

there is any point in giving them a further opportunity to give such an acknowledgement following the filing of a clearer statement by the applicants. We can therefore move on to the next stage.

12. This action was launched on 12 July 1996. After 10 months we have not even started the evidence rounds. In the interests of justice I have a duty to see that the proceedings continue at a rather faster pace from now on. From a quick glance at the papers, this does not strike me as a case in which masses of evidence is likely to be required, so there is no reason for the evidence stages to be protracted. Further, I do not feel that the actions I have ordered above need delay the evidence rounds. Accordingly, I am laying down the following timetable:

The applicants must file any evidence that they wish to submit under rule 74(3) of the Patents Rules 1995 within two months of today.

The proprietors will then have the two months specified in rule 74(4) in which to file their evidence.

The applicants will then, as laid down in rule 74(4), have a further two months to file evidence in reply. Concurrently with this, I will ask our Hearings Clerk to settle the date for the substantive hearing to avoid any undue delay between the filing of the evidence in reply and the hearing itself.

Because of the paucity of argument in the statement and counterstatement, I require the applicant to submit skeleton arguments two weeks in advance of the substantive hearing and the proprietor to submit skeleton arguments one week in advance. I am staggering these dates because in the present case I feel it is right for the applicant to put forward their arguments first.

13. The question of costs will be deferred until the substantive hearing.

14. As this decision relates to procedural matters, under the Rules of the Supreme Court any appeal must be lodged within two weeks.

Dated this 22<sup>nd</sup> day of May 1997



P HAYWARD

Superintending Examiner, acting for the Comptroller



THE PATENT OFFICE