

PATENTS ACT 1977

IN THE MATTER OF an application under section 71(1) by Sean Robert Cayless and Sci-Sport Limited for declaration of non-infringement of Patent Nos. 2214052 and 2253128 in the names of Nicholas John Barton and Beryl Dorothy Cullis

DECISION

1. An application under section 71(1) for a declaration of non-infringement of UK Patent No. 2253128 relating to a hockey goalkeeper's 'kicker' (hereafter "patent A") and UK Patent No. 2214052 relating to a retaining strap arrangement for such a 'kicker' (hereafter "patent B") was made on 29 April 1997 by Sean Robert Cayless and his company Sci-Sport Limited (hereafter "the applicants").

2. The application as filed was deficient under rule 74(1) in that (i) it was not accompanied by a full written statement, and (ii) it identified the proprietors of both patents as S.P. Industries Limited (the "previous proprietors") rather the actual existing proprietors, who by virtue of an assignment made on 30 November 1992 were Nicholas John Barton and Beryl Dorothy Cullis (the "current proprietors"). The applicants subsequently filed an amended Form 2/77 on 9 June 1997 identifying the proprietors as "formerly S.P. Industries Limited and now Nicholas John Barton and Beryl Dorothy Cullis", together with an accompanying statement. The statement referred to a meeting between Mr Cayless and what was identified as "officers of Monarch/SPI" held sometime before February 1997 at which it is alleged that it was orally conceded that a sample of a hockey kicker provided by the applicants would not infringe patents A and B. However, in a subsequent letter from the proprietors' agents Wolff & Lunt dated 10 February 1997 the latter alleged that the sample of the hockey kicker did infringe the patents belonging to 'their client' SP International. The applicants subsequently sought a declaration of non-infringement from the previous

proprietors on 28 February 1997 and there was subsequently some correspondence between the respective agents regarding what were the essential features of the kicker in question.

3. The amended application and statement were served by the Patent Office on the current proprietors via agents Wolff & Lunt (also the address for service for the previous proprietors, S.P. Industries Ltd) on 20 June 1997. On 18 August 1997 the agents Urquhart-Dykes & Lord (now incorporating Wolff & Lunt) filed a counter-statement under rule 74(2) on behalf of the current proprietors stating that S.P. Industries Ltd had been dissolved some years previously and hence could not take any part in the proceedings. The counterstatement on behalf of the current proprietors submitted that the application should be refused for failure to comply with section 71(1) and rule 74(1) since no written application had been made to the *current* proprietors before filing the application at the Patent Office. Also, it was claimed that adequately full particulars of the potentially infringing act had not been supplied in writing, and the sample held on behalf of the current proprietors was inconsistent with such written description as had been given.

4. The preliminary view of the Patent Office issued on 19 December 1997 was, firstly, that it appeared to be strictly correct that no application in writing for non-infringement had been made to the current proprietors. However, it was noted that as late as February 1997 Wolff & Lunt responded to the applicant as agents in respect of "our client S.P. International's British patents..." suggesting that the current proprietors were indeed aware of the application whether or not it had been formally made. Secondly, it also appeared that full particulars of the potentially infringing act had not been supplied *in writing* to the proprietors, the provision of a sample kicker not strictly satisfying this statutory requirement. It further appeared that there were inconsistencies between the sample and the written description that was provided with the application. However, rather than refusal at this early stage in the proceedings (and mindful that the applicants could if they wished merely then make a fresh application on a more correct basis), it was proposed that the filing of evidence should be postponed until the defects of the application had been made good and the applicants given 6 weeks to make a proper application under section 71 and the current proprietors given one month to subsequently provide written acknowledgement of receipt of the amended application.

5. In a letter dated 30 January (*ie* on the last day of the permitted 6 week period) the agents for the applicants requested an extension of 7 days to deal with the matter. However, the agent for the current proprietors objected to the grant of any extra time and sought the striking out of the application on several grounds, one of which was that the applicants were in fact the defendants in a High Court infringement action brought by the current proprietors of patents A and B (trading as SP International) and that any application under section 71 would require the leave of the Court because of the effect of section 74(7).

6. The relevant parts of section 74 read as follows:

Section 74(1)

Subject to the following provisions of this section, the validity of a patent may be put in issue -

- (a) *by way of defence, in proceedings for infringement of the patent under section 61 above or proceedings under section 69 above for infringement of rights conferred by the publication of an application;*

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Section 74(7)

Where proceedings with respect to a patent are pending in the court under any provision of this Act mentioned in sub-section (1) above, no proceedings may be instituted without the leave of the court before the comptroller with respect to that patent under section 61(3), 69, 71 or 72 above.

7. The Patent Office issued a further preliminary view on 3 February 1998, viz. that it was not inclined to grant an extension of time in the face of opposition, particularly in view of the pending High Court infringement action, and that a factor in deciding to grant the original six week period to put the application in order (as opposed to formerly striking the action out) had been the absence of any known parallel High Court action. The agent for the applicants requested that a hearing be appointed to deal with the allowability of the request for an extension of time and accordingly a preliminary hearing was held before me on 23 April 1998. At the hearing the applicants were represented by Mr Laurence Shaw of Laurence Shaw & Associates and the

current proprietors were represented by Mr Paul Wolff of Urquhart-Dykes & Lord.

8. Mr Shaw outlined the background to the making of the original section 71 application . He acknowledged that there had been an error as regards the owner of the patents and that amendment had subsequently been made. As regards the failure to meet the deadline given in the Official letter of 19 December 1997, Mr Cayless was abroad most of the time designing products and there had been no opportunity within the six week period to meet with him and receive instructions and so get the application in proper order. Whilst in September 1997 a High Court infringement action had indeed been launched against the applicants, there had been no progress in respect of that action since January 1998. In the meantime, the applicants had been hampered by people being inhibited from buying their products, and would continue to be so if this Patent Office action was struck out. The applicants would have no option other than to push forward the High Court action with attendant costs which could be ill-afforded. He alleged that, in any case, the hockey kicker at issue in the Patent Office section 71 action was not the same as that in issue in the High Court infringement action.

9. Replying Mr Wolff contended that, on the contrary, there was identity between the kickers which were the subject of the two actions, although the High Court action was of somewhat broader ambit in that it related to infringement by four distinct products. In any case, he argued that this was irrelevant since section 74(7) refers generally to the situation where "proceedings with respect to a patent are pending". There had been discussions between the parties as recently as that month, but the current proprietors wanted the Patent Office proceedings out of the way to avoid duplication of effort. Whatever happened in the Office, the High Court infringement proceedings would continue, unless a settlement was reached. If the disputed extension of time was not allowed, then the Patent Office action would stand to fall on the pleadings in view of the defects under section 71(1)(a) and rule 74(1) already identified. He also noted that the application was deficient in that there had been no evidence filed by the applicant within the two month statutory period allowed by rule 74(3), and in that there was no relief asked for in the statement. As to why the requested extension should not be allowed on its own merits, he submitted that it would have been a simple matter for the applicants to resubmit the written application within the time allowed. Once they had not done so, given the terms of section 74(7), it would need the

leave of the court for the extension to be granted because it would have the effect of antedating the section 71 action proper to a date before the High Court action was filed. He had no quarrel with the principle of amendment of a section 71 application, rather than requiring a new one, because it came to the same thing and it was a reasonable and pragmatic approach as long as the timing was not critical. If however, as here, there were intervening parallel High Court proceedings, then such action went contrary to the statute and thus cannot be allowed.

10. Mr Shaw's response to the lattermost point was that the applicants did not consider the application to be so flawed as to be necessary to start virgin fresh, *ie* they were not asking for an extension of time to make a fresh application which antedated the High Court action, but for an extension to correct defects in a section 71 application that had already been launched. Mr Shaw referred me to *Chr Hansen's Laboratorium A/S v Unilever NV* (SRIS 0/144/94) as a prior example of a case in which the hearing officer had allowed amendment of the details of the act on which a declaration for non-infringement under section 71 was sought. In response to my question as to whether it would have been as easy to write to the current proprietors on 30 January 1998 in the terms suggested by the Official letter of 19 December 1997 as to write to the Patent Office asking for an extension, he acknowledged that perhaps it would have been - but in the former case he would have had to do so in the absence of instructions from his client because it had been impossible in the period (which extended over Christmas) to get together with Mr Cayless.

11. In reaching a decision, the significant questions to be considered in my opinion are: (i) were the section 71 proceedings ever properly launched? (ii) if they were not, why had the applicant not responded within the six week period to rectify faults in the application? (iii) how should section 74(7) be interpreted in the circumstances of this case?

12. First, it is not disputed on behalf of the applicants that there were severe defects in their application under section 71. However, had it not been for the parallel High Court proceedings, it would appear that the current proprietors would not have objected to amendment of the deficient application in order to furnish them with full particulars of the act in writing. Second, I am also satisfied that the agent for the applicants was unable to respond within the six week

period because he was unable to receive instructions from his client. Under such circumstances and particularly having in mind the intervention of the Christmas holiday, I would have been minded to allow the modest extension of time requested for the application to be amended. This is in line with the decisions in *Chr Hansen's Laboratorium A/S v Unilever NV* (SRIS 0/144/1994) and *Johnson Matthey PLC v Sumitomo Special Metals Co Ltd* (SRIS 0/145/94).

13. However, this case is different from these previous cases in that there are parallel High Court proceedings concerning the patents A and B. On 11 September 1997 the current proprietors issued a Writ of Summons (Action No CH 1997 5024) claiming an injunction to restrain the applicants from infringing patents A and B, an Order for the destruction or delivery up of relevant articles, an inquiry as to damages suffered by the current proprietors, costs and other relief.

14. Despite Mr Shaw's arguments to the contrary, I find that the defects in the section 71 application were such that it could never be said to have been launched. Even disregarding the issues as to whether full and consistent details of the potentially infringing act were supplied in writing, it seems to me that the application clearly falls anyway on the ground that no formal application has been made to the current proprietors as required by section 71(1)(a). This being the case, I find that section 74(7) prevents me from granting the requested extension of time to what is, in effect, make a fresh section 71 application. I might add that it seems to me that this would be equally so even if the applicants had acted to put their application in order within the six weeks allowed but after 11 September 1997 when the High Court proceedings were launched. In fact, Mr Wolff suggested that the current proprietors might be impelled to raise this as a fresh issue if the decision on the extension of time went against them, but the point was not fully argued at the preliminary hearing.

15. It may be worth commenting that even if I had found for the applicants in this action, *ie* on the basis that their application was not so flawed as to prohibit it being read onto the words of section 71(1)(a), I would in any case have been minded to stay the Patent Office action. Where there are parallel court proceedings for infringement, application could be made to the court to stay the proceedings pending the outcome of the section 71 proceedings as in *Hawker Siddeley Dynamics Engineering Ltd v Real Time Developments Ltd* [1983] RPC 395. However, it is more usual for the Patent Office to stay its proceedings in favour of the High Court proceedings for

infringement of a patent. Moreover, as Mr Wolff pointed out at the hearing, the High Court should be addressing all the issues in its proceedings.

16. In summary, therefore, I refuse to grant the applicants, Sean Cayless and Sci-Sport Limited, the extension of time requested in their agent's letter dated 30 January 1998 to satisfy the requirements set out in the Official letter dated 19 December 1997. In consequence, the action under section 71 falls since I have found that it was never properly launched and section 74(7) prevents rectification of that situation.

17. Although the current proprietors include costs amongst the relief asked for in their counterstatement, there were no submissions in this regard at the hearing. I am not inclined to award any costs in view of the circumstances of this case.

18. As this is a decision on a matter of procedure, under the Rules of the Supreme Court, any appeal from this decision should be lodged within two weeks of the date of this decision.

Dated this 18th Day of May 1998

G M BRIDGES

Superintending Examiner, acting for the Comptroller

THE PATENT OFFICE