

PATENTS ACT 1977

IN THE MATTER OF an opposition under section 27(5) by Baxi Heating Limited to an application to amend patent No GB 2305499 in the name of Robinson Willey Limited

PRELIMINARY DECISION

Introduction

- 1 Notice of grant of patent No GB 2305499 entitled “Gas burner safety device” to Robinson Willey Limited (“the proprietors”) was published in the Patents and Designs Journal on 10 February 1999. The patent relates to a burner for a gas fire which is responsive to oxygen depletion in the ambient atmosphere but avoids the expense of the separate gas supply pipe and valve associated with known oxygen-depletion sensing pilot lights. On 23 September 1999 the proprietors applied under section 27 of the Patents Act 1977 to amend the patent on account of Japanese prior art of which they had been made aware.
- 2 On 26 January 2000 patent agents Franks & Co (who had filed a number of observations on patentability under section 21 of the Act before the patent was granted) wrote to the Office to draw attention to further prior art which they wished the Office to consider in its examination of the application to amend. Having been advised that their remedy was to formally oppose the application to amend after the amendments had been advertised in the Patents and Designs Journal (which advertisement took place on 22 August 2001), Franks & Co, acting for Baxi Heating Limited (“the opponents”), filed notice of opposition 19 October 2001, followed on 24 October 2001 by a statement of case as prescribed by rule 40(3) of the Patents Rules 1995.
- 3 In accordance with rule 40(4) the proprietors were given until 15 January 2002 to file a counter-statement, but on 14 January 2002 they asked for a six-week extension of this period on account of the disruption caused by the departure of their technical director, who was the inventor and who had been responsible for the conduct of the section 27 proceedings. A shorter extension, until 13 February 2002, was mutually agreed between the parties.
- 4 On 12 February 2002, stating that this was “under pressure of limited time”, the proprietors filed a counter-statement, but on 13 February 2002 they filed an amended version. Upon enquiry by the Office as to the reasons for this, the proprietors said that they had rectified transcription errors and tried to deal more fully with the issues that the opponents had raised.
- 5 The opponents objected to the admission of the amended version, and outlined their reasons in a statement of comments (“comments”) filed on 13 March 2002. The proprietors replied on 25 March 2002, opining that the opponents ought not to have been unduly inconvenienced or disadvantaged, and that they appeared to proceeding on a

technicality rather than on the merits of the case.

- 6 In the absence of agreement between the parties, the admissibility of the amended counter-statement falls to me to decide, and both parties are agreed that I should make my decision on the basis of the papers on file.
- 7 In order to set this dispute in context, it will be helpful to summarise briefly the issues underlying the opposition. The opponents consider that, in the light of the prior art (which is extensively reviewed), the patent is invalid as applied for, as granted, and as proposed to be amended. They allege that the proprietors have shown bad faith by covetously claiming protection to which they were not entitled, and by seeking to amend in a way which attempts to validate an invalid patent and which contravenes the prohibition of section 76 of the Act on the disclosure of additional matter and the extension of the protection conferred by the patent.
- 8 The essence of the proprietors' case is that the amendments are allowable and the prior art documents raised by the opponents do not invalidate the claims as proposed to be amended. The proprietors also submit that the opponents are not entitled to put validity in issue, and that obviousness should not be considered.
- 9 The amendments in the second counter-statement are not extensive: the existing paragraph numbering is retained with some modification and expansion of the wording. Indeed the opponents (at paragraph 5 of their comments) accept that the second counter-statement is better phrased and more specific in its response to the allegations made - although they then argue in paragraph 6 that it does not better particularise or clarify any of denials of the grounds of opposition in the first counter-statement.

Analysis

- 10 The grounds upon which the opponents oppose the admission of the amended counter-statement can I think be summarised in the light of their comments as follows:
 - that rule 40(4) of the Patents Rules 1995 does not provide for the filing of more than one counter-statement and that, since the first counter-statement was arguably sufficient in that it denied each of the grounds of opposition in general terms with each denial being accompanied by a supporting general statement, no amendment should be allowed, and
 - that, because the setting by the Patent Office of the period for filing the counter-statement was delayed by about four weeks to await verifications of translations of Japanese prior art, and because the period once set was extended by three weeks as explained above, the proprietors have effectively had a 13-week period which should have been sufficient to prepare an adequate counter-statement.
- 11 In support of the first of these grounds the opponents have drawn my attention to the decisions of the Comptroller in *Marshall's Application* [1969] RPC 83 (a decision in an opposition under the Patents Act 1949 subsequently affirmed by the Patents Appeal Tribunal) and *Concrete Repairs' Patent* (BL O/67/97) (a preliminary decision in an application for revocation under section 72 of the 1977 Act). These they cite as authority

for the proposition that a counter-statement needs only to address each ground of opposition by way of admission, denial, or offer to amend and need not be particularly detailed in its supporting arguments. The opponents (in paragraphs 9, 16 and 17 of the comments) further regard *Concrete Repairs* as authority for the proposition that no amendment of the counter-statement is possible simply to reword responses which might have been better put, or to correct typographical errors.

- 12 I am grateful for the guidance given in these precedent cases as to the adequacy or otherwise of the counter-statement, which on that point appears to me to be persuasive even though neither decision relates to opposed amendment proceedings under section 27 of the 1977 Act. However, I do not think it follows from this that amendment of a counter-statement which is *prima facie* adequate is necessarily prohibited. Such a result would in any case be difficult to square with the fact that statements and counter-statements are not infrequently amended in proceedings before the comptroller.
- 13 In *Marshall* and *Concrete Repairs* the allegation in each case was that the counter-statement was inadequate and the question to be decided was whether further amendment should be ordered to make it adequate. In contrast, in the present case the allegation is that the first counter-statement is already adequate and the question to be decided is whether the voluntary amendment submitted by the proprietors is admissible. Although *Marshall* and *Concrete Repairs* may help to establish some baseline of adequacy against which the desirability of amendment can be assessed, I do not read either decision as necessarily prohibiting further voluntary amendment.
- 14 I am mindful that in *Concrete Repairs* there is (at page 4 lines 23 -26) an admission by the party filing the counterstatement that with the benefit of hindsight some responses might have been better put, and that a typographical error might be present. However no amendments to cure these defects were before the hearing officer, and I do not read his decision as saying that no clarification can ever be made and no typographical error ever corrected.
- 15 The admissibility of the amendments is a matter for the discretion of the comptroller. In my view, in the absence of further authority, I must when exercising this discretion have particular regard to the relevance, substance and extent of the amendment, the *bona fides* of the proprietors and their diligence in preparing their case, the disadvantage to the opponents, and the wider public interest.
- 16 As to the relevance, substance and extent of the amendments, it would appear to be common ground that the amendments do not materially alter the nature of the proceedings, and that at the very least the amendment is better phrased and more specific in its responses. However, as explained above, whilst the proprietors state that they are dealing more fully with the opponents' allegations, the opponents state that the amendments are mere embellishments which do not in fact better particularise or clarify the proprietors' original denials. Having carefully read the original and the amended counter-statements I am in agreement with the proprietors. It seems to me that the amendments are helpful clarifications and amplifications of the original text, which also sweep up a small number of transcribing errors, and that it would be in the public interest for the proceedings to go forward with all these amendments taken into the counter-statement.

17 I do not think that there is anything before me to suggest that the proprietors are acting *mal fide* in pursuing this amendment. The opponents contend that rule 40(4), which reads:

“..... the applicant shall, if he wishes to continue with the application, file a counter-statement in duplicate “,

requires a single counter-statement. They observe in paragraph 2 of their comments that “no provision is given to the filing of numerous counter-statements within the six week period whereby the patentee is allowed to select the more suitable statement at the end of this period”. I do not read rule 40(4) as precluding the amendment of a counter-statement after filing: in any case, as stated above, such an interpretation would be difficult to square with practice in proceedings before the comptroller under this and similarly-worded rules in the Patents Rules 1995.

18 I also find it very difficult to regard the almost immediate replacement of one counter-statement by another as the filing of “numerous” counter-statements with intent to keep the other party in the dark as to its intentions, which appears to be the implication of the opponents’ allegation above.

19 On balance I do not think that the proprietors have shown any lack of diligence in pursuing their case. Even though they had in the result effectively been allowed longer than the usual six weeks to “get it right first time”, and although they could have been more forthcoming at the time of filing as to the reasons for making the amendment, that amendment was made only one day after the original. It was also still within the extended period agreed by the parties for filing the counter-statement, albeit on the last day of that period.

20 By the same token, I do not think that the opponents can realistically claim to have been significantly inconvenienced by the appearance of the amendment one day after the original, and before any evidence rounds had been set by the Patent Office. Their comments do not appear to make any allegation that this is the case.

Findings and orders

21 In the light of the analysis above I conclude that the amended counter-statement is admissible. It follows that there is no need for me to consider the proprietors’ “fall-back” proposal to correct the transcribing errors in the first counter-statement (although the errors drawn to my attention by the proprietors seem to me to be *de minimis*).

22 Although the opponents have argued their case on the basis that the first counter-statement was sufficient, their comments at paragraph 12 include the following:

“Alternatively it may be argued that neither the first nor the second counter-statement specifically addresses this second ground of opposition and as such both counter-statements are insufficient A rigorous analysis of the first and second counter-statement as to whether both specifically address the second ground of opposition is not presented herein however, this point will be explored in full should discussions continue as to the admission of the replacement counter-statement.”

As this point has not been argued I make no finding on it. I would only observe that any subsequent argument by the opponents that either version of the counter-statement is insufficient would seem difficult, if not impossible, to square with the remainder of the comments.

- 23 I therefore order the amended counter-statement to be admitted into the proceedings to replace the version first filed.
- 24 Under rule 40(5) the subsequent procedure is for the comptroller to direct. The Office's letter of 16 April 2002 suspended the filing of evidence until the preliminary issue had been resolved, and foreshadowed an opportunity for the opponents to file an amended or supplementary statement in the event that the amended counter-statement was allowed. Since the opponents have therefore already had some time to consider the matter, I direct that they shall have a period of two weeks from the date of this decision to file an amended or supplementary statement should they so desire; I also direct that the periods for the parties to file their evidence should now be set and should run in parallel with this two-week period.

Costs

- 25 It is now the practice for the comptroller, where appropriate, to award costs as the cause of them arises. In this case, I believe that to be the right course of action. The opponents have not succeeded on this preliminary point, and I agree with the proprietors' view of their conduct stated in their letter of 25 March 2002 mentioned above. To my mind the opponents have pursued their case on the basis of a narrow legal argument which shut out any consideration of the merits of the amendments, their relatively modest extent, and the speed with which they were submitted - a course of action which was bound to delay the proceedings. In the light of this the opponents' stated concern in paragraph 18 of the comments to avoid further expense and delay rings somewhat hollow.
- 26 Therefore, having regard to the standard scale of costs for proceedings launched after 22 May 2000 (the opposition was launched on 19 October 2001), I direct that the opponents shall within 7 days of the expiry of the appeal period pay the proprietors the sum of £200 as a contribution to the costs of considering and replying to the opponents' comments in relation to the amended counter-statement.

Appeal

- 27 This being a procedural matter, the period for appeal is 14 days.

Dated this 30th day of May 2002

R C KENNEL

Deputy Director acting for the Comptroller

THE PATENT OFFICE