



BL O/358/06

12th December 2006

PATENTS ACT 1977

BETWEEN

Smith International

Claimant

and

Specialised Petroleum Services Group
Ltd

Defendant

PROCEEDINGS

Application for revocation under section 72 of the Patents Act 1977, application to amend under section 75 and a request for a certificate of contested validity under section 65 in respect of patent number GB2335687B

HEARING OFFICER

P Hayward

DECISION

Background

- 1 During revocation proceedings before the Patent Office, the defendant applied under section 75 to amend the claims of the patent as granted to distinguish them from prior art cited by the claimant. In the decision issued 1st December 2004 (O/352/04) I found that, even with the amendments requested, claims 1-5, and claims 9-11 when appendant to claims 1-5, were invalid for lack of novelty and claim 16 invalid as it included added matter. Some of the other claims had also been attacked, but I rejected those attacks. I allowed the defendant an opportunity to submit further amendments, and awarded costs to be paid by the defendant. I deferred issuing a certificate of contested validity, which had been requested by the defendant, until the patent was satisfactorily amended.
- 2 The period for submitting further amendments was subsequently stayed because my decision was appealed to the High Court. Mr Justice Lewison's judgment and Order (CH 2004 APP 887 and CH/2005/APP/0042) overturned my decision that amended claim 1 lacked novelty, thereby implicitly also overturning my decision in respect of subordinate claims 2-5 and 9-11. My finding on claim 16 was not appealed. The judge also set aside my award of costs and adjourned the defendant's application for a certificate of contested

validity with the liberty to restore. He remitted the proceedings back to the Office to consider (i) the application for permission to amend the patent, (ii) any further application for a certificate of contested validity and (iii) my order relating to the costs of the hearing before me.

- 3 Matters were then delayed by an appeal to the Court of Appeal (Appeal Number A3/2005/0990). That appeal was subsequently compromised and dismissed by a consent order dated 3rd October 2006. Thus the case is now back with me to consider the three issues identified by Lewison J.
- 4 For completeness, I should say that the defendant had also on the 21st January 2003 filed an application for post-grant amendment under section 27. The action under section 27 was stayed on the 24th April 2003 pending the outcome of the revocation proceeding under section 72 initiated by the claimant.

The outstanding issues

- 5 In a letter dated 20 June 2005 following the judgment of Lewison J, the defendant submitted a revised set of amended claims. These differ from the amendments that had been before me previously in just three respects. First, in the main independent claims the word “dedicated” has been deleted. I have already stated in my earlier decision that this amendment would be allowable. Second, claim 16 has been deleted. That is necessary because my finding that claim 16 was invalid had not been appealed. Third, there are a few alterations to the dependencies of subordinate claims to deal with the deletion of claim 16 and to rectify a couple of clerical errors, and I can see no problem with these. Thus what is now proposed is fully consistent with the combined outcome of my previous decision and the judgment of Lewison J.
- 6 There have been no objections to the amendments now proposed. The previous set of amendments had been advertised under section 75(1) and rule 78(1A) of the Patent Rules 1995, and I do not consider that the differences between those amendments and the present set are such as to warrant re-advertisement. I am therefore satisfied that the amendments to the claims are allowable in principle.
- 7 That leaves only the question of discretion, and I can deal with that very briefly. The defendant has provided a full explanation of the circumstances leading to the request to amend, insofar as they are not self-evident from the course of the proceedings. I discussed discretion fully in my previous decision. Whilst I see I did not explicitly say the amendments as they then stood were allowable, that was clearly implicit and was certainly accepted to be the position by both sides. However, I did not make a final ruling because I was anticipating further amendments. In the event, the only further amendments are one that I said I would allow, a claim-deleting amendment of a type that both sides had agreed was allowable and some trivial corrections. Accordingly I am satisfied it would be right to allow the amendments now requested.
- 8 The defendant has confirmed that it still seeks a certificate of contested validity. I am prepared to grant that in respect of the patent as amended.

- 9 Both sides have confirmed that there is no issue outstanding between them in respect of costs. Accordingly I shall make no order as to costs.

Conclusion and order

- 10 I order that the specification of the patent be amended as requested in the defendant's letter dated 20 June 2005. I make no order to revoke the patent and make no order as to costs.
- 11 I also certify that the validity of claims 1-5, 8-11, 13-17 and 22-30 in the patent as amended was contested on the grounds of lack of novelty and lack of inventive step in the light of the document identified as D6 in my previous decision, and the validity of claim 16 was contested on the ground that it disclosed additional matter, and these claims were found to be valid.
- 12 Finally, the defendant now has no need to pursue the application for post-grant amendment under section 27. Accordingly, I order that the section 27 action be terminated.

Appeal

- 13 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days.

P HAYWARD

Divisional Director acting for the Comptroller