

14th April 2008

PATENTS ACT 1977

BETWEEN

Rita Rusk Claimant

and

Wilson Gunn LLP Opponent

PROCEEDINGS

Application under Section 27 of the Patents Act 1977
To amend GB 2414932 B

HEARING OFFICER Peter Back

DECISION

Introduction

1. UK patent GB 2414932 B (“the patent”) was granted on 23 May 2006. The proprietor, Rita Rusk Innovations Ltd. (“the Applicant”), filed a request to amend the patent under section 27(1) on 19 January 2007. The proposed amendments were advertised in the Patents and Designs Journal on 4 April 2007. On 4 June 2007, a notice of opposition under section 27(5) to the proposed amendments was filed by Wilson Gunn LLP (“the Opponent”) and their statement of grounds of opposition followed on 18 June 2007.
2. The Applicant was informed that under Rule 40(4) of the Patent Rules 1995 it had until the 20 August 2007 to file a counter statement. A request for an extension of time of one month, for the period for reply and filing of a counterstatement was made on 8 August 2007. The Opponent objected to the request for an extension of time of one month but was prepared to agree to an extension of two weeks and this was duly allowed giving a response date of 3 September 2007.
3. No counterstatement was received by 3 September 2007 and the Attorney for the Applicant stated that it had not been instructed to file a counter statement in the proceedings on 29 September 2007. No further submissions from the applicant had been received by the 14 October 2007 so the proceedings were

then treated as unopposed. The Opponents then stated their wish to be heard. The Opponent's attention was drawn to *Norsk Hydro AS's Patent* [1997] RPC 1989 ("Norsk Hydro") which is a decision where the Hearing Officer found that an application to amend a granted patent was considered to be withdrawn when no counter statement was filed in response to an opposition to the allowance of the amendments filed by another party. The Opponent stated that it still wished to be heard and was given an opportunity to make further submissions to address the hearing officer on *Norsk Hydro*. Further submissions were received on the 10 January 2008.

4. The matter came before me at a hearing on 24th January 2007. The Opponent was represented by its patent attorney, Mr David Slattery. The Applicant did not appear and was not represented at the hearing.
5. This opposition must be considered in the light of a previous decision, *Norsk Hydro AS's Patent*, and Mr Slattery firstly addressed me on this issue.
6. Mr Slattery proceeded to distinguish the facts in the *Norsk Hydro AS's Patent* case from those of the application at hand. In *Norsk Hydro* the Hearing Officer found that an application to amend a granted patent should be considered to be withdrawn when no counter statement was filed in response to an opposition to the allowance of the amendments filed by another party.
7. In *Norsk Hydro*, in addition to the section 27 proceedings, there were also pending revocation proceedings under section 72; these proceedings including amendments filed under section 75.
8. As such, whether or not there was a consideration of the merits of amendments submitted under section 27, the merits of the amendments under section 75 were free to be considered as part of the revocation proceedings. Therefore, the opponent/applicant for revocation could have its substantive objections fully considered and the public interest in properly examining the proposed amendments would be upheld. This is not the case in the current application.
9. In *Norsk Hydro*, the patentee actively attempted to continue with the section 27 proceedings, even if it was subsequently determined that these steps had been taken too late. In the current application, the applicant appears to have no further interest in continuing the application as it has not filed any counter arguments to the opposition. However, it has not withdrawn their application to amend.
10. Mr Slattery noted that earlier decisions of Hearing Officers are not necessarily binding (Patents Hearings Manual paragraph 1.84) although they should of course be given due regard.
11. I have considered the Opponent's position with regard to *Norsk Hydro*, I am mindful of the fact that the Applicant could have withdrawn its request to amend or could have contested the opposition and it chose to do neither. I have also taken account of the wider public interest in coming to a decision on

this point, and I am of the opinion that the opposition to the amendments should be allowed to proceed and be heard.

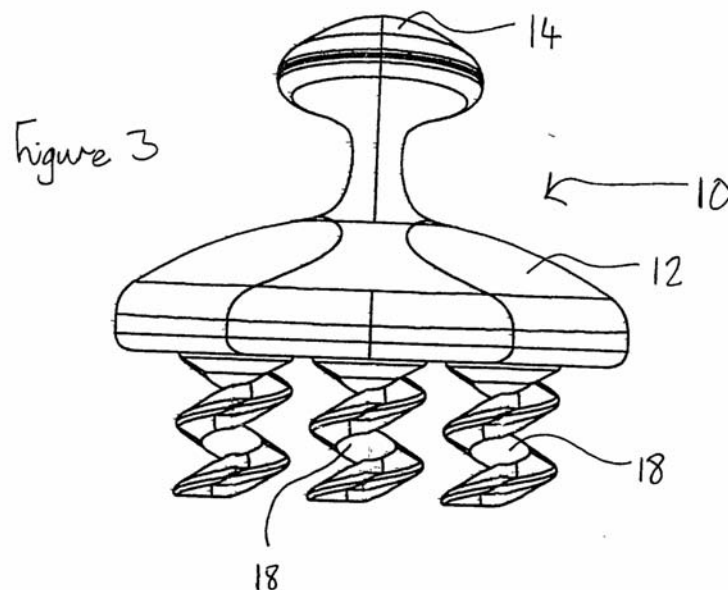
The patent

12. The patent relates to a hair styling tool. The key feature of the tool is a number of spiral members extending from the base of the tool which engage with the hair in order to create the desired effect. The purpose of which is stated as creating volume, movement and texture for hair.

13. The unamended specification contains 17 claims. Independent claim 1 defines the construction of the hair styling tool, and reads:

A hair styling tool comprising: at least one spiral member extending from a base of the hair styling tool, the at least one spiral member defining an empty inner space; wherein the hair may interact with the at least one spiral member or may enter the empty inner space defined by the at least one spiral member.

14. This claim is easier to understand by reference to Figure 3 of the drawings accompanying the patent and which is reproduced below.



15. The remaining claims are all dependent on claim 1. Claims 12-16 define a method of styling hair; claim 17 represents an omnibus claim to the tool described in the accompanying figures.

The proposed amendments

16. The proposed amendments essentially involve the incorporation of the subject matter of lines 15-16 on page 2 of the original description, into claim 1.

Claim 1 as proposed to be amended reads (with amendments underlines):

A hair styling tool comprising: 2 to 20 spiral members extending from a base of the hair styling tool, the 2 to 20 spiral members defining empty inner spaces in the form of substantially central bores within the spiral members; wherein the hair may interact with the 2 to 20 spiral members or may enter the empty inner spaces in the form of substantially central bores defined by the 2 to 20 spiral members.

17. The Applicant also submitted amended claims 2-15. Original claim 2 had minor amendments to address grammatical issues in the light of the proposed amendments to claim 1. Original claims 3 and 4 were deleted, with consequential re-numbering of the remaining claims. Finally, consequential amendments to page 2 of the description were also submitted. Thus the only amendment of substance is that to claim 1 as set out above.

Background to request for amendment

18. The reason given for the request to amend is “*new prior art*”. The prior art was listed in the covering letter accompanying the request for amendment and was: JP 07-289341; US 482257; EP 52990; US 1377408; GB 3623; US 2455715; US 6758221; GB 21486; US 5878755; US 5495861; DE 230465 and US 5318054. No further light as been shed on the motivation of the applicant to request the amendment.

The Opposition

19. The basis of the opposition as set out in the Opponent’s statement of grounds is that the proposed amendments do not distinguish the patent from the prior art set out in GB 3623 (“D1”) and the other documents, highlighted in the applicant’s request for amendment and therefore does not cure the defect identified by the Applicant.
20. It is only claim 1 that has undergone substantial amendment, barring the deletion of claims 3 and 4 and the grammatical and renumbering changes made to the remaining claims. In his skeleton argument, Mr Slattery attempted to address the validity of all of the claims, however as is clearly stated in the Manual of Patent Practice at paragraph 27.28, an opponent must address himself solely to the allowability of the proposed amendments, and may not attack the validity of the patent as it would be after amendment, except that if the amendments have been sought in order to remove an admitted defect casting doubt on the validity of the patent, the opponent may argue that the proposed amendments are not adequate to remove the defect. Accordingly, I will confine myself to Mr Slattery’s arguments on that point with respect to claim 1.

The law

21. The application to amend is made under section 27 of the Act, the relevant paragraphs of which read as follows:

Section 27(1)

Subject to the following provisions of this section and to section 76 below, the comptroller may, on an application made by the proprietor of a patent, allow the specification of the patent to be amended subject to such conditions, if any, as he thinks fit.

Section 27(5)

A person may give notice to the comptroller of his opposition to an application under this section by the proprietor of a patent, and if he does so the comptroller shall notify the proprietor and consider the opposition in deciding whether to grant the application.

22. Section 27(1) makes amendment subject to the provisions of section 76. The relevant part of which reads as follows:

Section 76(3)

No amendment of the specification of a patent shall be allowed under section 27(1), 73 or 75 if it –

(a) results in the specification disclosing additional matter, or

(b) extends the protection conferred by the patent.

23. Amendment under section 27 is a discretionary matter. The patentee must demonstrate that the application to amend was made in good faith, that the request for amendment is justified, and that there are no statutory grounds for refusal. It is well established that the burden of proof to demonstrate allowability of the amendment is on the patentee.

24. The Applicant appears to have acted in good faith and in an expedient manner from the time that the existence of the prior art came to its attention and the filing of a request for an amendment in accordance with section 27.

25. Furthermore, I find that the proposed amended claim 1 meets the requirements of section 76(3) because the proposed amendment essentially involves the incorporation of the matter of page 2, lines 15-16 of the specification as filed.

26. It is, of course, not sufficient for an Applicant for amendment to demonstrate that the circumstances and its behaviour are such that the comptroller should favourably exercise his discretion. To be allowable, the proposed

amendments must also resolve the defect which they seek to cure and this formed the basis this opposition.

27. In deciding whether the proposed amendments will cure the defect of invalidity of claim 1, I shall therefore need to consider both the novelty and the inventive step of the proposed amended claim in the light of the prior art identified by the Applicant.

28. The case put by the Opponent is substantially that the amendments to the claim should be refused because the patentee has not provided a satisfactory explanation as to how the amendments distinguish the alleged invention over the prior art identified by the patentee. I take the word “distinguish” in the context of the 1977 Act, as embracing both novelty and inventive step.

Novelty

29. I will first turn to novelty. The relevant section of the Act is section 2, which reads:

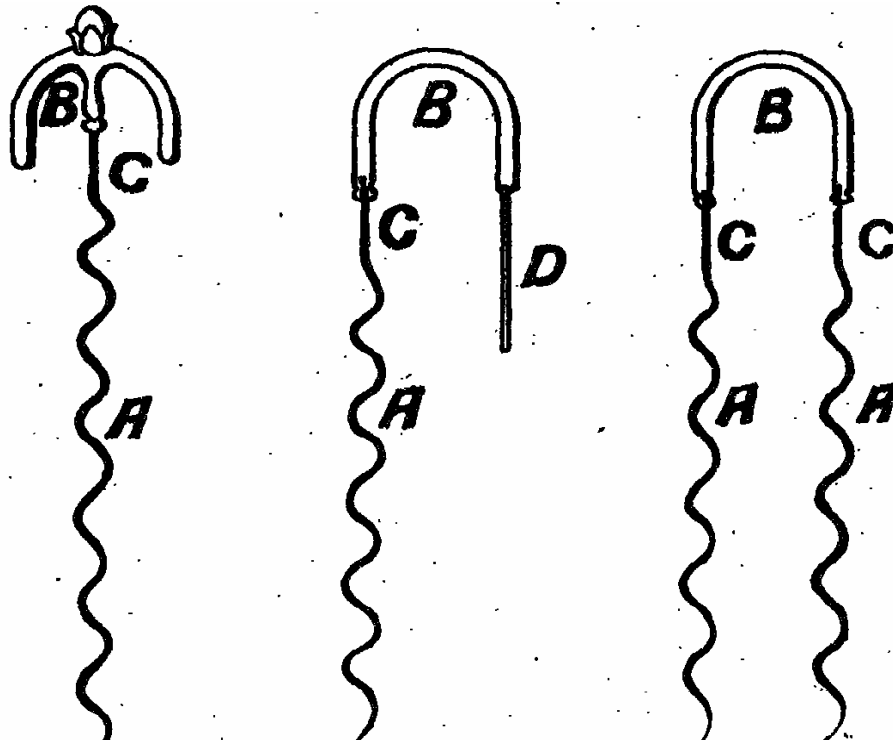
Section 2(1)

An invention shall be taken to be new if it does not form part of the state of the art.

Section 2(2)

The state of the art in the case of an invention shall be taken to comprise all matter (whether a product, a process, information about either, or anything else) which has at any time before the priority date of that invention been made available to the public (whether in the United Kingdom or elsewhere) by written or oral description, by use or in any other way.

30. Mr Slattery identified the specification of D1 as particularly relevant to the novelty of the proposed amendment. This document discloses three embodiments of a hairpin. These are shown below:



Figures 1-3 of D1- GB 3623 A (from left to right)

31. In the third embodiment shown above, figure 3 discloses a hair styling tool with a pair of spiral members (A) extending from a cap (B). Mr Slattery argued that the cap (B) can be considered to represent a base and that each of the spiral members clearly defines an empty inner space in the form of a substantially central bore. As is highlighted by the accompanying text of D1 at page 1 line 20: *"..spiral or cork-screw spiral. A...with any sufficient number of involved circles and with such space between them as will cause the penetrating part to revolve when the end or ends (if more than one spiral is used) of it, is, or are fitted into a cap B,..in such a way that when the cap is pressed or pulled in the act of using it, the spiral or spirals will revolve quickly and wind into or out of anything in which it may be used.."* and at lines 5-8: *"The object of my invention is to provide a pin made with one or more revolving spirals of suitable length or lengths for use in the hair of women.."*
32. Mr Slattery put it to me that this disclosure therefore represents a hair styling tool with two spiral members (which clearly falls within the range 2 to 20 of the amended claim) extending from a base of the tool, where the spiral members define empty inner spaces in the form of substantially central bore within the spiral members so that hair may interact with said members and enter the empty inner space. On this basis he argued that the proposed amendment to claim 1 is not sufficient to distinguish it from D1 in terms of novelty and I agree. It is accordingly not necessary for me to go in to consider the amendments in terms of inventive step.

Conclusion

33. I have carefully considered all of the arguments and submissions before me and in the absence of any arguments from the Applicant, I have concluded that the amendments should not be considered withdrawn, as in the *Norsk Hydro* case, but that the proposed amendments are not such as to cure the defect identified by the Applicant in that they do not distinguish the amended patent from the cited prior. Accordingly, the request to amend the patent is refused.

Costs

34. No application for costs was made at the hearing but I agreed to allow the Opponent the opportunity to make submissions on costs once this decision had issued. Accordingly I allow the Opponent 14 days from the date of this decision to make submissions on costs and, although they were not present at the Hearing, I allow the Applicant the same period to make such submissions as they may wish on the issue of costs.

Appeal

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

Peter Back

Divisional Director acting for the Comptroller