

PATENTS ACT 1977

BETWEEN

James Campbell

Claimant

and

Aberdeen University

1st Defendant

Dr Mohammed Imbabi

2nd Defendant

PROCEEDINGS

Reference under section 12 of the Patents Act 1977 in
respect of patent application number WO 03/057470 A1
and equivalents (EP(UK) 1467858)

HEARING OFFICER Stephen Probert

PRELIMINARY DECISION — CONFIDENTIALITY

- 1 This decision concerns a request for confidentiality of a large number of documents that have been filed in these entitlement proceedings. The Comptroller will only direct that documents be treated as confidential if he is aware of good reasons for doing so — even if the parties themselves agree that the documents should be treated as confidential. In the event, the parties in this dispute were unable to agree between themselves whether the documents should be treated as confidential, and so a hearing was necessary anyway.
- 2 A hearing was held, by telephone, on Thursday 12th June 2008 to determine whether there were good reasons for treating the relevant documents as confidential. During the hearing, Mr Suer of Ablett & Stebbing represented Aberdeen University and Dr Imbabi, while Mr Campbell spoke for himself. Dr Imbabi and Dr Elizabeth Rattray from Aberdeen University also joined the telephone hearing. At the end of the hearing, I reserved my decision. I have now decided that there are good reasons for treating **some** of the documents as confidential, and I now specify those particular documents and give my reasons for so directing.

The Law

- 3 Rule 53 of the Patents Rules 2007 gives the comptroller power to direct confidentiality in the following terms:

Confidential documents

53.—(1) Where a person files a document at the Patent Office or sends it to an examiner or the comptroller, any person may request that the document be treated as a confidential document.

(2) The comptroller must refuse any request where it relates to—

- (a) a Patents Form; or
- (b) any document filed in connection with a request under section 74A.

(3) A request to treat a document as confidential must—

(a) be made before the end of the period of 14 days beginning with the date on which the document was—

- (i) filed at the Patent Office, or
- (ii) received by the comptroller, an examiner or the Patent Office; and

(b) include reasons for the request.

(4) Where a request has been made under paragraph (1), the document must be treated as confidential until the comptroller refuses that request or gives a direction under paragraph (5).

(5) If it appears to the comptroller that there is good reason for the document to remain confidential, he may direct that the document shall be treated as a confidential document; otherwise he must refuse the request made under paragraph (1).

(6) But where the comptroller believes there is no longer a good reason for the direction under paragraph (5) to continue in force, he must revoke it.

(7) In this rule references to a document include part of a document.

- 4 It is a well established rule that patent litigation should generally take place in public. See for example the judgment of the Court of Appeal in *Lilly Icos v Pfizer*¹, especially paragraphs 9, 12 & 18. This concerns documents filed in patent proceedings, as well as any oral hearings that might take place. That is presumably one of the reasons why rule 53 (above) is cast in such a way as to assume that each document filed in proceedings before the comptroller will be open to public inspection unless there is good reason to treat it as confidential.

- 5 So what is a good reason for treating a document as confidential? Lord Justice Buxton, giving the judgment of the court in *Lilly Icos v Pfizer*¹, said:

“25. It may be convenient to set out a number of considerations that have guided us.

- i) The court should start from the principle that very good reasons are required for departing from the normal rule of publicity. That is the normal rule because, as Lord Diplock put it in *Home Office v Harman* [1983] AC 280 at p303C, citing both Jeremy Bentham and Lord Shaw of Dunfermline in *Scott v Scott*,

“Publicity is the very soul of justice. It is the keenest spur to exertion, and the surest of all guards against improbity. It keeps the judge himself, while

¹ *Lilly Icos Ltd v Pfizer Ltd (No. 2)* [2002] EWCA Civ 2

trying, under trial.”

The already very strong English jurisprudence to this effect has only been reinforced by the addition to it of this country’s obligations under articles 6 and 10 of the European Convention.

- ii) When considering an application in respect of a particular document, the court should take into account the role that the document has played or will play in the trial, and thus its relevance to the process of scrutiny referred to by Lord Diplock. The court should start from the assumption that all documents in the case are necessary and relevant for that purpose, and should not accede to general arguments that it would be possible, or substantially possible, to understand the trial and judge the judge without access to a particular document. However, in particular cases the centrality of the document to the trial is a factor to be placed in the balance.
- iii) In dealing with issues of confidentiality between the parties, the court must have in mind any “chilling” effect of an order upon the interests of third parties: see paragraph 5 above.
- iv) Simple assertions of confidentiality and of the damage that will be done by publication, even if supported by both parties, should not prevail. The court will require specific reasons why a party would be damaged by the publication of a document. Those reasons will in appropriate cases be weighed in the light of the considerations referred to in sub-paragraph (ii) above.
- v) It is highly desirable, both in the general public interest and for simple convenience, to avoid the holding of trials in private, or partially in private. In the present case, the manner in which the documents were handled, together with the confidentiality agreement during trial, enabled the whole of the trial to be held in public, even though the judge regarded it as justified to retain confidentiality in respect of a significant number of those documents after the trial was over. The court should bear in mind that if too demanding a standard is imposed under CPR 31.22(2) in respect of documents that have been referred to inferentially or in short at the trial, it may be necessary, in order to protect genuine interests of the parties, for more trials or parts of trials to be held in private, or for instance for parts of witness statements or skeletons to be in closed form.
- vi) Patent cases are subject to the same general rules as any other cases, but they do present some particular problems and are subject to some particular considerations. As this court pointed out in *Connaught*, patent litigation is of peculiar public importance, as the present case itself shows. That means that the public must be properly informed; but it means at the same time that the issues must be properly explored, in the sense that parties should not feel constrained to hold back from relevant or potentially relevant issues because of (legitimate) fears of the effect of publicity. We venture in that connexion to repeat some words of one of our number in *Bonzel v Intervention Ltd* [1991] RPC 231 at p234.27:

“the duty placed upon the patentee to make full disclosure of all relevant documents (which is required in amendment proceedings) is one which should not be fettered by any action of the courts. Reluctance of this court to go into camera to hear evidence in relation to documents which are privileged which could be used in other jurisdictions, would tend to make patentees reluctant to disclose the full position. That of course would not be in the interest of the public.” ”

6 These then are the considerations that have guided me in reaching my decision.

The Documents

- 7 The documents concerned in this request for confidentiality include various technical research proposals, contracts, emails to/from Mr Campbell, and minutes of project management meetings. I have listed them in schedules 1 and 2 at the end of this decision. (In brief, schedule 2 identifies those documents that I am directing should be treated as confidential. I am not making any direction in relation to the documents listed in schedule 1.)
- 8 In each case it is the defendants, Aberdeen University and Dr Mohammed Imbabi, who have requested confidentiality; consequently the onus was on Mr Suer to establish that there is good reason for the comptroller to order confidentiality. Mr Campbell's position throughout has been that all the documents in these proceedings should be "in the public domain."

The Submissions

- 9 During the hearing, I noted five reasons that Mr Suer gave in support of the request for confidentiality.
- i) A lot of the documents filed by Mr Campbell (JC11, JC12, JC17, JC22, JC23, JC24 ² & JC27 as well as the unabridged versions of CS1D & CS1E) relate to contract agreements, licence issues and commercial interests involving third parties. The third parties have not given consent to publication of these documents. Mr Suer drew my attention to paragraph 118.13 of the Manual of Patent Practice (MoPP) which says:

"... In inter partes proceedings, evidence filed by one party, for example details of licence agreements, may be treated as confidential if its disclosure risks being harmful (eg commercially) to the party or the party's associates to an extent which overrides the requirement for public access."
 - ii) In the defendants' view, most of the documents (with the exception of CS1D and CS1E) are irrelevant to the issue in dispute, and are unlikely to form part of the substantive decision. In support of this reason, Mr Suer quoted another extract from the same paragraph of MoPP which says:

"(c) Material which is going to form no part of the decision can remain confidential."
 - iii) Most of the documents post-date the issue of inventorship, which is what these proceedings are all about. I think this refers back to ii) above; for I understood Mr Suer to be saying that documents generated **after** the earliest date of the patent in suit are unlikely to

² In an email dated 5th June 2008, Mr Suer specified a particular subset of the documents in JC22, JC23 & JC24 to which the defendants were prepared to restrict their request. I have taken this subset as the starting point for the defendants' request for confidentiality. (There were no documents from JC24 in the subset.)

have any direct bearing on the issue of inventorship (and hence entitlement) and therefore they are unlikely to figure in the substantive decision.

- iv) In relation to CS1D and CS1E, the defendants insist that these documents are not in the public domain.
- v) The defendants are not requesting a general order of confidentiality covering all the documents filed by Mr Campbell — eg. including a large number of emails between the parties — but have restricted their request to a comparatively small number of documents. Mr Suer said the defendants consider that a lot of other documents are also irrelevant, but because they do not specifically relate to details that are sensitive or that relate to ‘private’ contracts they can become part of the public record. Furthermore, he reminded me that the defendants have provided redacted versions of documents CS1D and CS1E in which the names of collaborators have been removed, and that the defendants are not seeking confidentiality in respect of these redacted versions.

- 10 Mr Campbell felt aggrieved that the defendants, Aberdeen University and Dr Imbabi, had (in his words) “completely contravened the confidentiality and IPR agreements” between them and himself. Mr Campbell gave a number of examples of situations where he considers that the defendants have acted in breach of their duty of confidence to him. In his opinion, this is a very serious matter that must be brought into the public domain. He added that the documents give a good background to the whole affair, and demonstrate how the research programs developed.
- 11 Turning to CS1D, Mr Campbell said that Dr Imbabi had given him a copy of this document “early on” in the relationship. He understood that this was part of a free exchange of information (between the parties) “that was in the public domain”. Mr Campbell said that there was no formal agreement (concerning confidentiality) between the parties until the Teaching Company Scheme (TCS) was established in November 2001, or possibly earlier when the parties made ‘declarations’ under the SMART award scheme. Nevertheless, Mr Campbell considered that the parties had always been under a non-contractual obligation of confidentiality towards each other.
- 12 As far as CS1E is concerned, Mr Campbell pointed out that he is named on the cover of the document as an associate. At the time, it appeared to me that what Mr Campbell was telling me was that this document must also already be in the public domain because he is named as a party to the research proposal outlined in the document. When I questioned him on the point, Mr Campbell was very clear that he regarded these documents (CS1D and CS1E) as being already in the public domain, and that they should not be treated as confidential.
- 13 In reply, Mr Suer argued that Mr Campbell had not brought forward any evidence to show that these documents were already in the public domain. In the event I haven’t given this argument much weight because the onus is on Mr Suer to show that there is good reason to treat the documents as confidential and not on Mr Campbell to show that there isn’t.

The result

- 14 It is true that some of the documents, or parts of documents, in respect of which the defendants are seeking confidentiality refer to contract agreements, licence issues and commercial interests involving third parties. While I recognise that the third parties involved may not have given permission for the documents to be made available to the public as part of these proceedings, having looked at them, I am not convinced that any harm would be done by publication. For example, they do not appear to contain any commercially sensitive information. If I were to make a direction based on this as the good reason, I would have needed some more specific details, or possibly even evidence, of the harm that might be done by publication.
- 15 I am a little confused by the practical effect of the difference between the parties as to whether or not the documents are already in the public domain. Mr Campbell's primary concern in opposing the request for confidentiality is that he considers that everything in the proceedings should be in the public domain. In this respect Mr Campbell is at one with the Court of Appeal (eg. in *Lilly Icos v Pfizer*), the Civil Procedure Rules, and the Patents Rules. Yet it was part of Mr Campbell's submission that these documents are already in the public domain. Clearly to the extent that this is so, it would not matter what decision I reached regarding confidentiality.
- 16 But ultimately I have reached my decision almost entirely on the basis of the second of Mr Suer's reasons — ie. (quoting from MoPP) "material which is going to form no part of the decision can remain confidential". This is essentially Lord Justice Buxton's second 'consideration' as stated in *Lilly Icos v Pfizer*¹ — ie. relevance.
- 17 I have read the statement and counterstatement to be sure what this dispute is about, and I have carefully considered the documents (in schedules 1 and 2) in respect of which confidentiality is requested. I agree with Mr Suer that **some** of these documents (or, where relevant, parts of documents) are unlikely to form part of any substantive decision in these proceedings. But I do not think that can be said of them all. Some of the documents (ie. those identified in schedule 1 below) could conceivably be relied upon quite heavily by Mr Campbell in presenting his case at a hearing. Whatever the eventual outcome of these proceedings, I think it is more than likely that the substantive decision will need to refer to these documents. Consequently the argument for directing confidentiality of these documents is significantly weakened. I have considered whether the remaining 'considerations' are sufficient to constitute "good reason" but I have concluded that they do not. In particular, I am not aware of any specific reasons why a party would be damaged by the publication of any of the documents in schedule 1.
- 18 Consequently **I direct that the documents listed in schedule 2 of this decision shall be treated as confidential documents**; but I make no direction in relation to the documents listed in schedule 1
- 19 Following a direction regarding confidentiality, rule 53(6) of the Patents Rules states that if the comptroller believes there is no longer a good reason for maintaining confidentiality, he must revoke the direction. Therefore, particularly in view of the "good reason" I have accepted for directing confidentiality, if one

or more of the documents in schedule 2 forms part of a subsequent decision in these proceedings, then the comptroller will consider whether this direction should be revoked — at least in relation to the document(s) concerned. I note that this approach is consistent with the position under the Civil Procedure Rules as summarised by LJ Buxton in *Lilly Icos v Pfizer* as follows:

“The central theme of these rules is the importance of the principle that justice is to be done in public, and within that principle the importance of those attending a public court understanding the case. They cannot do that if the contents of documents used in that process are concealed from them: hence the release of confidence once the document has been read or used in court.”

Appeal

- 20 Under the Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days. In the meantime, the comptroller will treat all of the documents identified in schedules 1 and 2 as confidential, until either the appeal period has expired or any appeal has been concluded.

S PROBERT

Deputy Director acting for the Comptroller

Schedule 1

- CS1D (Redacted version) EPSRC Research Proposal: "The Building Envelop As A Filter Of Urban Air Pollution", dated 1 Dec 1997.
- CS1E (Redacted version) RNET Outline Research Proposal: "Breathing Walls for Natural Ventilation and Filtration of Urban Air Pollution", dated 4 Oct 2000.

- JC22.0(3) SMART Scotland Competition. Entry form, guidance notes and business plan. (Dated 5 January 2001)
- JC22.2 Environmental Building System. A proposal in the name of Mr James Campbell and Dr Mohammed Imbabi dated 12 December 2000
- JC22.3 Environmental Building System. A SMART project proposal in the name of Mr James Campbell and Dr Mohammed Imbabi dated 15 December 2001
- JC22.4 Environmental Building System. A proposal in the name of Mr James Campbell and Dr Mohammed Imbabi dated 12 December 2000 (very similar to JC22.2)

Schedule 2

- JC11 TCS Contract Documents - List of signed agreements
- JC11.1 Draft Teaching Company Scheme Agreement between Aberdeen University and James Campbell Architects & Environmental
- JC11.2 Letter dated 20/8/2001 from E H Robson (DTI) to Mr R Brown at Aberdeen University about the TCS Programme between Aberdeen University and James Campbell Architects & Environmental
- JC11.3 Signed copy of the Teaching Company Scheme Agreement between Aberdeen University and James Campbell Architects & Environmental
- JC11.4 TCS Programme grant application and proposal form

- JC12 TCS Support Documents - List of key records
- JC12.1 TCS Local Management Committee Meeting - Minutes of LMC-00 - dated 30th August 2001
- JC12.2 TCS Local Management Committee Meeting - Agenda for LMC-01 - dated 24th January 2002 (and papers for the meeting)
- JC12.3 TCS Local Management Committee Meeting - Minutes of LMC-02 - dated 9th May 2002 (with annexes B, C, D & E)
- JC12.4 TCS Local Management Committee Meeting - Agenda for LMC-03 - dated 12th September 2002 (with annexes A, B, C, D & E)
- JC12.5 TCS Local Management Committee Meeting - Agenda for LMC-04 - dated 30th January 2003 (with annexes A, B, C, D & E)
- JC12.6 TCS Local Management Committee Meeting - Minutes of Extraordinary Meeting - dated 24th March 2003

- JC17 Robin Brown TCS Manager - Sample communications to and from
- JC17.0 Email from Robin Brown to James Campbell dated 19 July 2000
- JC17.1 Email from Robin Brown to James Campbell dated 23 October 2001
- JC17.2 Email from James Campbell to Robin Brown dated 31 October 2001
- JC17.3 Email from James Campbell to Robin Brown dated 7 April 2003

- JC22.7 A revised resubmission of the SMART proposal, by James Campbell and Mohammed Imbabi, dated 10 January 2002
- JC23.1 (SMART) Response to request for supplementary information, dated 27 February 2002
- JC23.3 Email, dated 4 April 2002, from Trudy Nicholson (Scotland Executive) to James Campbell
- JC23.4 Email, dated 5 April 2002, from James Campbell to Liz Rattray (Aberdeen University)
- JC27 Environmental Building Partnership - Company Documents Developing
JC27.1 Licence of Technology - University of Aberdeen and Environmental Building Partnership Limited. Dated 5 November 2002.
- JC27.2 Shareholders Agreement between James Campbell and Mohammed Imbabi and Aberdeen University and Environmental Building Partnership Limited. (Latest date August 2002)
- JC42.4 Unredacted version of appendix CS1D
- JC42.5 Unredacted version of appendix CS1E