

PATENTS ACT 1977

IN THE MATTER OF

Patent Application No. GB 9522134.7

in the name of Colin Rooney

DECISION

1. The application in suit relates to animal husbandry sanitising compositions. Claim 1 defines such compositions as being in solid form and comprising an alkali metal peroxymonosulphate triple salt acting as a strongly oxidising source, sulphamic acid as an acid medium and chlorine acceptor, an alkali metal phosphate as sequestering agent, a surfactant and a chlorinated isocyanurate as an organic source of available chlorine. Claim 5 relates to a particular formulation which has become known as Virucidal Extra.

2. The application was filed in the name of Vincent Rooney on 30 October 1995 without a claim to priority. A deed of assignment dated 6 November 1998 subsequently transferred the application to Colin Rooney. The normal period for putting it in order for grant expired on 30 April 2000. However, the applicant has filed the necessary form and fee required under Rule 110(3) of the Patents Rules 1995 to extend that period by one month, as of right, so the final date for putting the application in order is now 30 May 2000. In spite of considerable correspondence between the examiner and the applicant there has not been agreement concerning, in particular, whether the invention as defined in claims 1 and 5 is novel as required by section 1(1)(a) of the Act. Since time for agreement was running out the applicant requested, in a letter dated 18 May 2000, that the matter be referred to a "senior officer" to be decided on the papers. It has fallen to me to make the decision.

3. Having studied all the papers it seems to me that this case presents some unusual features which I must address carefully in my decision. In view of the fact that I must give my

decision by the final date, 30 May 2000, I am aware that I will not have time to set out my reasons in detail so this decision will be brief and will be followed by a Statement of Reasons in due course.

4. Therefore, having considered all the arguments, I have come to the conclusion that the applicant has not shown satisfactorily, in the time allowed, that the invention as claimed in all the claims of the application is new as required by section 1(1)(a) of the Act. I can see no way in which he can remedy this situation and therefore I decline to allow the application to proceed to grant.

5. I will follow this decision with a Statement of Reasons in as short a time as reasonably possible.

6. Since this decision is on a matter which is other than procedural the applicant has a period of 6 weeks from the date of the decision in which to appeal. I realise, of course, that he will need to see my reasons before he can make such a decision. Therefore, should it be that when he gets my Statement of Reasons he considers he has insufficient time left within those 6 weeks to reasonably consider whether he should appeal he may apply to the Comptroller for an extension. Any application for an extension must be made prior to the expiry of the 6 week period I have just set. Only one period of extension can be granted by the Office.

Dated this 30th day of May 2000

D L WOOD

Deputy Director, acting for the Comptroller

THE PATENT OFFICE

PATENTS ACT 1977

IN THE MATTER OF

Patent Application No. GB 9522134.7

in the name of Colin Rooney

STATEMENT OF REASONS

1. This is the Statement of Reasons promised in my decision dated 30 May 2000 where I refused to allow the application to proceed to grant because of the failure of the applicant in the time allowed to show that it complied with section 1(1)(a) of the Act i.e that the claims related to an invention which was new.

2. In my decision I referred to the fact that, in general, the application relates to animal husbandry sanitising compositions. For the sake of this statement I need to set out in detail the two claims of the application which have most bearing on my decision, namely claims 1 and 5.

3. Claims 1 and 5 in the form standing at 30 May 2000 read as follows:-

“(1) An animal husbandry sanitising composition, in solid form, comprising an alkali metal peroxymonosulphate triple salt and acting as a strongly oxidising source; sulphamic acid as an acid medium and chlorine acceptor; a sequestering agent in the form of an alkali metal phosphate; a surfactant and an organic source of available chlorine in the form of a chlorinated isocyanurate.”

“(5) An animal husbandry sanitising composition, as in Claim 1, wherein a typical formulation is:-

	%w/w
<i>Caro's Acid Triple Salt</i>	50.00
<i>Sulphamic Acid</i>	15.00
<i>Sodium Dodecylbenzene Sulphonate</i>	5.00
<i>Sodium Dichloroisocyanurate</i>	5.00
<i>Sodium Hexametaphosphate</i>	25.00

4. The specific composition of claim 5 is marketed as Virucidal Extra and the argument between the examiner and the applicant has chiefly centred on the date of marketing of the composition. In the opinion of the applicant Virucidal Extra was not available to the public before 30 October 1995, the date of filing of the application, whereas it was the examiner's view that on the evidence on file it was available and it was this availability which meant that claims 1 and 5 could not be regarded as representing an invention which was new.

The law

5. Section 1(1) of the Act says that:-

1.-(1) A patent may be granted only for an invention in respect of which the following conditions are satisfied, that is to say-

- (a) the invention is new;*
- (b) it involves an inventive step*
- (c) it is capable of industrial application;*
- (d) the grant of a patent for it is not excluded by subsections (2) and (3) below;*

and references in this Act to a patentable invention shall be construed accordingly.

6. For the purposes of this statement only section 1(1)(a) above is applicable but I need also to refer to section 2 of the Act which defines what it is that allows an invention to be

taken as new. The relevant part of section 2 reads as follows:-

“2.-(1) An invention shall be taken to be new if it does not form part of the state of the art.

(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.

In this particular case the argument has been about what has “been made available to the public” before the priority date of the invention, which date is the filing date of 30 October 1995.

History of the proceedings

7. The search report on the application was issued on 22 January 1997 and the application was published on 7 May 1997. Only three documents of background interest were cited in the search report which might have suggested at the time that, when the application proceeded to substantive examination, progress towards grant of a patent should have been without too much of a problem. The fact that this was not the case is attributed to observations filed under section 21 by a third party firstly on 2 March 1998, secondly on 1 June 1999 and thirdly on 1 March 2000. These observations all related to the availability of Virucidal Extra, particularly by means of written description or use, prior to 30 October 1995.

8. The first examination report was issued by the examiner on 4 November 1998 and thereafter there was considerable correspondence between the applicant and examiner until a letter from the applicant of 18 May 2000 in response to a letter from the examiner dated 11 May 2000 indicated at point 6:-

“ 6. Your paragraph 4 indicates that you are not going to be able to reach an

agreement with us on the issue of “Novelty” so we have no alternative, before taking the matter any further, to request that all document (sic) be passed on to a “senior officer” to decide the matter.....”

I will refer to the third party observations and as much of the correspondence as is necessary to explain below my reasons for refusing the application.

The third party observations of 2 March 1998 and 1 June 1999

9. In some respects these observations relate to a different perspective on the availability of Virucidal Extra compared to the observations of 1 March 2000 and arise out of a court action in which Vincent Rooney was involved in April 1997. Vincent Rooney was named as the original applicant of the application before a deed of assignment transferred the case to Colin Rooney.

10. Reference was made in the observations of 2 March 1998 to a court action in *Auchincloss v. Agricultural & Veterinary Supplies Ltd.* reported in [1997] RPC at page 649. This was a case where Vincent Rooney as one of four defendants was accused of infringing European Patent(UK) 0260293 by selling Virucidal Extra. The outcome of the case is not important in the present context but what is important are various statements on pages 682 to 684 of the decision which I shall quote as follows:-

At page 682, line 51 to page 683, line 26:-

“It is quite clear that the First Defendants have sold more product than can be accounted for by the business documents they produced. Thus the affidavit of Mr Vincent Rooney sworn in the interlocutory proceedings on 18 October 1996 admitted they had been selling Virucidal Extra since at least 26 August 1994 and that the current turnover “is running at £1.2M per annum”. That would work out to about 240 tonnes since the average selling price is £5 per kilo. It would also require purchases of about 12 tonnes of NaDCC since this ingredient is present at 5% by

weight. Yet the defendants' documents, all in, at the end of the trial, accounted for a total of only 9 tonnes of NaDCC for the whole period July 1993 to December 1996.

Conceivably, the discrepancy could have been explained. For instance, the phrase "is running at £1.2M per annum" might have been accounted for by saying it was a temporary boom in production. If there was an explanation, the best person to give it would have been the maker of the affidavit himself.

Mr Vincent Rooney did not give evidence, despite having signed a witness statement and despite being in court. When Mr Howe announced his last witness, and it was not Mr Vincent Rooney, I intimated to him that if he applied to call that person I would consider the application on its merits. I did so because at that point it was quite clear that the plaintiffs were taking a point about the discrepancy.

Mr Rooney's secretary Mrs Walsh was called (and was in my judgement a truthful and careful witness) but she had not worked for the First Defendant company before February 1995. Her sources of information for matters before that date were Mr Vincent Rooney and Mr Hunniford. I found it strange that only the secretary was called to prove what her boss would know better.

Then at line 49 on page 683:-

In cross examination he (Mr Hunniford) was asked about the manufacture of Virucidal Extra. He stated that he was not aware of any before April 1995.

Q. You are not aware of any manufacture that took place before that?

A. No, I am not aware of any.

Q. And if it had taken place, you would have been aware of it, would you not?

- A. *If it had happened on my premises, I would certainly have been aware of it.*

Later on he reiterated:

All I can say is, the first major manufacturing of Virucidal Extra, of which I was involved was at Easter of 1995...

Asked about the approximate annual turnover in kilograms he replied that he just did not know. Pressed to explain the apparent discrepancy in amounts he replied "I just do not know without sitting down and actually being shown documents and doing calculations". Asked to explain Mr Vincent Rooney's admission in his affidavit that that the First Defendants had been manufacturing Virucidal Extra as long ago as August 1994, he said that he knew nothing about that. At the conclusion of his evidence, asked by me if it would be possible for the First Defendants to be buying supplies of Virucidal Extra without his knowledge, he said that it was. This was contrary to what he had said in chief. Other than that, my impression as he left the witness box was that he probably did not really know what had been going on outside his premises, and that maybe the First Defendants had been buying Virucidal Extra on the side from another contractor. He seemed to me to be a man of ready intelligence."

11. It is very little wonder then that, in the light of Vincent Rooney's sworn affidavit referred to in the reported decision, the examiner in his first examination report dated 4 November 1998 objected to the invention defined in all the claims of the application as not being new because Virucidal Extra, on Vincent Rooney's own admission, had been on the market since at least 26 August 1994, some 14 months prior to the filing date of the application. Indeed, I observe that even Mr Hunniford spoke of the first major manufacture of the product to his knowledge being at Easter 1995, some 6 months before the filing date.

12. Vincent Rooney's response to this is best taken verbatim from his letter in reply dated 29 April 1999 where on the opening page he says:-

“The reason for this (i.e. his non-appearance in the witness box) was that my memory and event recall was extremely poor at the time because about 19 months previously, on the 2nd September 1995, whilst on a business trip in the Irish Republic I was the victim of a “hit and run” road accident and sustained severe injuries, including multiple fractures of the skull, which caused me to be kept on a life support machine for a few days and held me in an intensive care Neurosurgical Ward for some 11 days in an unconscious state. To substantiate this I attach herewith a copy of a cutting from my local newspaper “Newtownards Chronicle” dated Thursday the 26th October 1995. It was because of my poor recall, which would have been exaggerated in a witness box environment, that my Counsel decided to run the trial without my verbal contribution.”

13. This unfortunate incident and its consequences, of course, only explain Vincent Rooney's non-appearance in the witness box but later on in the same letter he refers to his poor recall leading to him mixing up two very similar products of his, namely Virucidal Extra and Virucidal Plus so that, in effect when he referred to the former in his sworn evidence he really meant the latter. He put it like this:-

“I have spent some months since your letter of the 4th November 1998 and have used my office files as a memory bank and I can now say that although line 1 of page 683 of the trial transcript/judgement states that I admitted during interlocutory proceedings (18th October 1996) that I had been selling Virucidal Extra from at least 26th August 1994 I hope that you will logically deduce from my explanation and enclosures that this is not the case and my only explanation in defence is that my memory was not differentiating between my products Virucidal Plus and Virucidal Extra.”

Most of the remainder of Vincent Rooney's letter of 29 April 1999 is an explanation of

circumstances which he believed showed that Virucidal Extra was not available on the market prior to the date of filing the application.

14. Subsequently, there was an appeal to the Court of Appeal of the High Court decision referred to above and a report of the appeal appeared as [1999] RPC at page 397. The third party observations of 1 June 1999 drew attention to this further decision making the point that although Vincent Rooney maintained that his memory lapses were continuous until after the High Court hearing, in the Appeal Court hearing neither he or his counsel made any attempt to clarify what Vincent Rooney was now alleging i.e there were the two products Virucidal Extra and Virucidal Plus, the manufacturing dates of which he had confused. The observations concluded with the statement that Vincent Rooney had not shown sufficient proof that his sworn affidavit, used as evidence in the both the High Court and the Appeal Court, was false.

15. This, indeed, was the view also taken by the examiner and reported to Colin Rooney, to whom the application had now been assigned, in a letter dated 8 June 1999. Colin Rooney's reply dated 6 October 1999 made much reference to the relative manufacturing, approval and availability dates of Virucidal Extra and Virucidal Plus but the problem for the examiner was that until Vincent Rooney was prepared to swear otherwise he had to take the affidavit sworn for the purpose of the court proceedings to be true. So, in a letter dated 11 November 1999, he proposed what seems to me to be a reasonable solution to the dilemma.

16. What the examiner said was the following:-

"I require a sworn affidavit from Mr V Rooney which should refer to (a) the medical reasons why his statement before the Court was confused and wrong and (b) the historical facts about the manufacture and marketing of "Virucidal Extra". Evidence should be attached to the affidavit in the form of at least the Expert Report of Mr McCullins, the Official Certificate and Mr Mark Squire's evidence, all referred to in your letter dated 6 October 1999."

17. During February 2000 medical reports were received from surgeons Alan G Kerr

FRCS and Dermot P Byrnes FRCS and in anticipation of these reports alone not satisfying the examiner Colin Rooney in his letter of 16 February 2000 offered to arrange for the execution of an affidavit from Vincent Rooney should it be required by the examiner. It was required and the examiner communicated this in a letter dated 6 March 2000.

18. Unfortunately an affidavit has not been filed in spite of further reminders in letters during March and April 2000. For this reason alone I believe it would have been wrong to allow the application to proceed to grant. Although I have been perfectly willing to accept that Vincent Rooney could have been confused in his affidavit before the High Court about the earliest date when Virucidal Extra had been sold, the lack of a further affidavit, as requested by the examiner, swearing that this was the case does not allow me to just dismiss the validity of the High Court evidence. This is even more the case since, particularly before the High Court no attempt was made by counsel for Vincent Rooney to explain why the latter was not being called as a witness. If, as alleged, Vincent Rooney was likely to have become confused in the witness box I would have thought it very easy for counsel to have explained that and for the deputy judge to have understood why he was not being called. Thus, failure to take that simple remedy has not helped Vincent Rooney's case in the present proceedings.

19. Normally in pre-grant proceedings before the Patent Office the benefit of the doubt is given to an applicant in a situation where it is difficult to conclusively decide an argument one way or the other. However, in the present case, without the requested sworn affidavit, I would be wrong to ignore what Vincent Rooney had previously sworn before the High Court that Virucidal Extra had been sold since at least 26 August 1994. Therefore I am forced to the conclusion that the application must fail because it does not comply with the requirements of section 1(1)(a) of the Act.

20. In order to provide a comprehensive decision and to be fair to both Vincent and Colin Rooney I shall go on to consider the other issues raised by the third set of Third party observation filed on 1 March 2000.

The third party observations of 1 March 2000

21. With reference to six enclosures the observations of 1 March 2000 provided a raft of submissions as to why the invention of the application should not be regarded as new and therefore should be refused. All the enclosures were relied on by the examiner in a letter to Colin Rooney dated 7 April 2000 as being a good reason for maintaining the novelty objection.

22. Very briefly, the enclosures were:-

a) A copy of a sworn affidavit of Thomas Ralph Auchincloss dated 26 July 1996 and submitted in respect of the High Court proceedings referred to in my paragraph 10 above.

b) A letter and datasheet sent to a firm called Agro-Bio by AVS (NI) Limited (Mr Rooney's company) dated 24 August 1994.

c) A certificate issued by Ministry of Agriculture Fisheries and Food (MAFF) dated 23 August 1994 in respect of a disinfectant marketed as Virucidal Extra.

d) A further certificate issued by MAFF and dated 6 September 1995 which certifies the suitability of Virucidal Extra for use in Great Britain as an approved disinfectant.

e) A copy of page 21 of a publication entitled "ANIMAL PHARM" number 332, dated 15 September 1995.

f) A witness statement of Linda Jane Walsh, dated 11 January 1997 with its Annexures 1 to 5.

23. In a letter dated 26 April 2000 the examiner made it clear that he was not pursuing the objection in respect of the MAFF certificates and so I only need to concentrate on the other

four enclosures in the remainder of this statement.

24. Mr Auchincloss' affidavit under the heading "VIRUCIDAL EXTRA" refers, in fact, to the efforts made by a company called Antec International Limited to get hold of information about the sale of Virucidal Extra in the period both before and after the filing date of the present application. In paragraph 20 of the affidavit he comes to the conclusion that there was no indication whatsoever of the product being either promoted or sold in the UK prior to a date which I take to be around September 1995. This was in spite of, amongst other things, Agro-Bio being sent the letter and datasheet referred to above as enclosure (b). In that letter there is a comment that AVS. would like to market Virucidal Extra through companies like Agro-Bio and a datasheet, which does not refer to the composition of the product, is enclosed.

25. What I infer from all this, and I admit that the evidence before me is somewhat limited, is that AVS were anticipating getting into the UK market and that up to then they were working primarily on their export market. This information is consistent with what a Mr Jacques Van't Hart of AVS had apparently told Mr Francis Auchincloss, a cousin of Thomas Auchincloss some time around September 1994. So, although I am prepared to accept that Virucidal Extra had indeed been prepared and was ready for sale prior to the filing date of the application, the letter to Agro-Bio cannot of itself prove that it was not new in patent terms being as it is an offer to sell the product but not making it available in the terms expressed in section 2(2) of the Act.

26. However, there is, to my mind, a very significant annex attached to Thomas Auchincloss' affidavit which was not referred to by Colin Rooney in his rebuttal of much else in the affidavit and that is the letter of 21 September 1994 from Jacques Van't Hart to a Mr Dudley Page of a firm called Animal Health Supplies based in Suffolk. In the third paragraph of that letter Mr Van't Hart says the following:-

"The most interesting product is Virucidal Extra, the equivalent to Antec's Vircon S, which is sold in Northern Ireland between £12.00 - £14.00 per Kg. For your sales forecast A.V.S. will sell the product to you for approximately £7.00 Kg. With large

quantities a discount is possible.”

Again, this is only an offer to sell Virucidal Extra but without evidence to the contrary I cannot easily overlook the statement about sale in Northern Ireland from the General Manager of AVS. I must therefore take this statement as *prima facie* true particularly as Colin Rooney has not discharged the onus on him to prove otherwise and once again find the claims of the application as lacking in novelty.

27. Paragraph 15 of Thomas Auchincloss’ affidavit refers to the acquisition of a sample of Virucidal Extra on 27 March 1995 which was then sent for analysis by an independent laboratory. I do not propose to rely on this information as evidence of the lack of novelty of the product since there are no details of the conditions under which the acquisition took place especially any conditions of confidentiality which may have been attached. Moreover, there is argument in Colin Rooney’s letter to the Office dated 6 April 2000 which would make it even more unsafe for me to rely on this information alone to demonstrate the failure of the application for lack of novelty.

28. As to the disclosure in the magazine called ANIMAL PHARM this, under the heading “AVS launches disinfectant in UK”, announces that AVS has launched its new multi-purpose, broad- spectrum disinfectant, Virucidal Extra, in the UK. However, on Thomas Auchincloss’ own admission at paragraph 22 of his affidavit it proved impossible, despite this announcement, to find any indication that Virucidal Extra was either promoted or sold in the United Kingdom although apparently there was information about sales in the Irish Republic and Iran. The disclosure in ANIMAL PHARM therefore cannot be relied upon of itself as denying novelty to Virucidal Extra at the date of filing the application. Which brings me to the witness statement of Linda Jane Walsh.

29. Mrs Walsh’s witness statement refers to an order for 20,000 kg of Virucidal Extra dated 7 December 1994 and received from Damik Iran, a company based in Tehran. Confirmation of this is evidenced by a copy of the letter of credit annexed to her statement. Also annexed are copies of production control cards completed by Mr Van’t Hart and relating

to the batches fulfilling the order, copies of invoices for each of the components of Virucidal Extra used to fulfil the order and a copy of an inspection document dated 24 April 1995 showing that Virucidal Extra was available for inspection immediately prior to shipment. In the case of the latter this was a document produced by an independent inspection company called SGS Redwood Limited and was necessary so that the importer could obtain an import licence. It is of course possible that the components referred to could have been used to prepare other compositions but the other annexes are consistent in describing the product ordered, prepared and inspected as Virucidal Extra. Thus, Mrs Walsh's witness statement is significant *prima facie* evidence that large amounts of Virucidal Extra had been made and were available before the earliest date of the application.

30. In response to this Colin Rooney maintains, particularly in his letter of 6 April 2000, that irrespective of the nomenclature on the Redwood document the shipment to the Middle East and, indeed, all shipments prior to the date of the application were of Virucidal Plus and not Virucidal Extra. To support this contention he has filed copies of invoices to companies in the Middle and Far East as well as letters from such companies to show typical sales and enquiries about Virucidal Plus both before and after the date of the application. Absent, though, is any evidence that would show beyond doubt that the shipment to Damik Iran referred to in the paragraph above is Virucidal Plus rather than Virucidal Extra.

Conclusion

31. I have therefore come to the conclusion that, taking everything into account, Mr Rooney at the date by which this application needed to be put in order for grant, i.e. 30 May 2000, had not satisfied the examiner on the matter of whether the invention as defined in the claims met the requirement of section 1(1)(a) of the Act that it was new.

32. As already stated in my decision of 30 May 2000 I have no option but to refuse the application. I have done this with some reluctance because some of the arguments submitted by both Vincent and Colin Rooney have suggested that there might be a measure of force in what they have been saying. However, a number of the arguments against them from the third

party and pursued by the examiner have had considerable weight and have not been overcome by a somewhat selective choice of documents in attempt to prove the opposite. It has certainly been the case that a sworn affidavit was required from Vincent Rooney to overcome what he had submitted on oath in the reported Court proceedings. In my view, a further affidavit(s) would have been needed to overcome the nature of the arguments against them in respect of the availability of Virucidal Extra before 31 October 1995. The failure to file such affidavits as clearly requested by the examiner in his letter of 11 November 1999 has therefore been at the root of my finding that the requirement of section 1(1)(a) of the Act has not been met.

33. The period for appeal is 6 weeks from 30 May 2000 which is the date on which I issued my decision. If, because of the time it has taken to issue this statement of reasons, the applicant wishes to obtain an extension to this period he must apply to the Comptroller prior to the expiry of the 6 weeks period. Only one period of extension can be granted by the Office.

Dated this 15th day of June 2000.

D L WOOD

Deputy Director, acting for the Comptroller

THE PATENT OFFICE