



BL O/322/05

14 December 2005

PATENTS ACT 1977

BETWEEN

Attaca Limited

Claimant

and

(1) Myriad Genetics Inc
(2) Endorecherche Inc
(3) University of Pennsylvania
(4) HSC Res Dev LP

Defendants

PROCEEDINGS

Reference under section 72 of the Patents Act 1977 in
respect of patent number EP 0785216

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

- 1 This decision is concerned with the question of whether I should strike out a reference under section 72 for want of prosecution.

Background

- 2 EP 0785216 (“the patent”) entitled “Chromosome 13-linked breast cancer susceptibility gene BRCA2” was granted on 8 January 2003. The proprietors of the patent, who are the defendants in this action, were named as Myriad Genetics Inc, Endorecherche Inc, University of Pennsylvania and HSC Res Dev LP.
- 3 On 10 May 2004, Attaca Ltd (“the claimant”) filed Form 2/77 and a statement in which it sought a declaration of non-infringement under section 71 and costs, and in the event of failure to obtain the former, revocation of the patent under section 72.

- 4 The Office responded to both sides in a letter dated 30 July 2004 noting that a request under section 71 for a declaration of non-infringement can only be considered by the comptroller if there has first been an attempt by the claimant to obtain such a declaration from the proprietors of the patent and that this has been unsuccessful. The claimant was therefore advised to contact the proprietors. The office also proposed to stay the action under section 72 until the claimant had decided whether it wished to proceed with the action under section 71. Both parties were given 14 days in which to make any comments on this proposal. The claimant was also given 14 days in which to file several scientific papers referred to in its statement.
- 5 In a letter dated 13 August 2004, the defendants made a number of observations on the statement filed by the claimant. In particular they noted that the claims referred to in the statement are not the claims of the granted patent. A copy of the granted claims was enclosed with the letter. The letter went on to argue that since no proper reasoned attack has been made under section 72(1) against any granted claim of the patent then the application should be immediately dismissed.
- 6 In a letter dated 2 September 2004, the Office invited the claimant to comment by 4 October 2004 on the points raised by the defendants. A further copy of the defendants' letter of 13 August including a copy of the granted claims was subsequently sent to the claimant at the request of Mr Quigley who had filed the initial action on behalf of the claimant and who I assume is connected in some way to Attaca Ltd.
- 7 No response was received from the claimant. The Office therefore telephoned Mr Quigley on 11 November 2004. Mr Quigley informed the Office that he had been in hospital for 5 weeks and this had prevented him (and therefore presumably the claimant) from responding. He also suggested that the patent in suit had been revoked. The Office noted that, from the information that it had, the patent had not been revoked but invited Mr Quigley to provide any information to the contrary by 10 December 2004.
- 8 Again no response was received from the claimant. The Office therefore telephoned Mr Quigley on 24 February 2005 and followed up the conversation with a further letter of the same date. This letter included a copy of the European Patent Office register entry for the patent confirming that there had yet to be a decision in the opposition proceedings whether or not to revoke the patent. The claimant was again invited to provide details of any information that it had concerning the revocation of the patent by 10 March 2005.
- 9 A further attempt was made by the Office to obtain a response from the claimant in a letter dated 5 May 2005. In this letter the claimant was specifically warned that if it did not respond within two weeks from the date of the letter, in other words by 19 May 2005, a hearing officer would consider whether the proceedings should be allowed to continue. Copies of all previous correspondence from the Office to the claimant were also enclosed with the letter. A final opportunity for the claimant to make any comments was provided in a letter from the Office dated 11 July 2005. Again there was no response. I must now consider whether to strike out.

Abuse of process

- 10 This action has been initiated by the claimant and so the onus is on it to prosecute the case diligently. Over 19 months has now passed since the claimant launched the action and almost 16 months since the defendants first raised concerns about the contents of the claimant's statement. During that time the Office has received no further correspondence from the claimant despite numerous letters from the Office. Indeed the only contact between the claimant and the Office appears to have been two telephone conversations initiated by the Office. In one of these the claimant suggested that the patent had been revoked however it was not able to provide any confirmation of this despite again numerous requests from the Office to do so. The claimant also failed to respond to evidence provided to him by the Office showing that the patent had not in fact been revoked.
- 11 At one point Mr Quigley did advise the Office that he had been ill for 5 weeks however that in itself can not explain the claimant's failure to respond over the last 16 months. I am therefore satisfied that the conduct of the claimant in this matter amounts to an abuse of process.

Public interest

- 12 Normally an abuse of process such as this would lead to the action being struck out. However I need to consider whether this action has raised questions that the comptroller should consider further in the public interest. In their letter of 13 August 2004 the defendants note that the patent is:

“currently under opposition at the European Patent Office. Hence there would seem in any case no public interest reason for the GB Patent Office to further review the section 72 application in this instance”.

- 13 Since that letter an opposition division of the EPO has issued its decision maintaining the patent albeit in an amended form. The amended statement of claim now includes just a single claim which differs from any of the claims of the patent as granted. I have considered the grounds for revocation set out in the claimant's statement in the light of the amended claim and have concluded that no clear case of lack of novelty or inventive step arises against this claim which would justify the comptroller continuing this action.

Ruling

- 14 I have found that the claimant's conduct has amounted to an abuse of process and also that there is no public interest in the comptroller pursuing this action. The defendants have been left in a state of uncertainty for a considerable length of time and it would be unfair to prolong that uncertainty any longer. I therefore strike out the proceedings for want of prosecution.

Costs

- 15 The defendants have not requested an award of costs and therefore I make no award.

Appeal

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

Phil Thorpe
Deputy Director acting for the Comptroller.

