



**PATENTS ACT 1977**

BETWEEN

|                                  |           |
|----------------------------------|-----------|
| Atlantic Plastics Limited        | Claimant  |
| and                              |           |
| Steve Leigh & Associates Limited | Defendant |

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PROCEEDINGS

Application under section 72 of the Patents Act 1977 for the revocation of patent number GB 2440412 B

HEARING OFFICER

Phil Thorpe

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**PRELIMINARY DECISION**

**Introduction**

- 1 Atlantic Plastics Limited launched revocation proceedings under section 72 against GB 2440412B in the name of Steve Leigh & Associates Limited on 31<sup>st</sup> March 2014. The statement of case claims that the invention in the patent is not new or is obvious given the disclosure in a single prior art document, GB 2321513A.
- 2 The defendant filed its counterstatement on 4<sup>th</sup> June 2014. It also submitted two sets of conditional amendments to the claims of the patent.
- 3 The IPO issued a preliminary evaluation on the 7<sup>th</sup> August 2014. This highlighted the issues in dispute and gave guidance on the matters on which the hearing officer wanted to be addressed at the hearing. The IPO at that time also set out the timetable for the evidence rounds. Shortly afterwards a hearing date was set for the week commencing 2<sup>nd</sup> February 2015.
- 4 Both sides filed their evidence in chief on 20<sup>th</sup> October 2014. The claimant in its evidence however now seeks to amend its statement of case to introduce a further challenge to the validity of the patent on the basis of prior public use. This is resisted by the defendant. It is to this point that this decision is directed. Both sides were content for the matter to be decided on the basis of the papers submitted.

## **Amendments of Statements of Case – General Principles**

- 5 Rule 82(1)(e) of the Patent Rules 2007 provides that “the comptroller may give such directions as to the management of the proceedings as he thinks fit, and in particular he may allow a statement of case to be amended”. Also relevant is rule 74 which requires the comptroller to seek to give effect to the overriding objective when exercising his discretion.
- 6 Both sides have referred to *Owens-Corning Fibreglas Corporations Patent*<sup>1</sup>. This is a case decided under the 1949 Patents Act. It concerns a request to amend a statement of case in a revocation action to include inter alia a new claim of prior public use. The factors taken into account in determining whether the amendment should be allowed in this case included a) whether the party seeking the amendment had acted diligently b) the relevance of the new art sought to be introduced c) the time that has elapsed since the filing of the application for revocation and d) whether delay will be caused which might be unjust to the patentee or against the public interest.
- 7 Although as noted this case was decided under the previous act I am satisfied that the factors considered in that case are also relevant to the question of dealing with this case justly. Normally, and this case does not seem to be an exception, no single factor will be decisive. Rather what I need to do is to consider all the factors in combination and take a view as to whether in all the circumstances it would be just to allow the amendment.

## **Application of these principles to the case in issue**

- 8 I turn now to the particular facts of this case. It is not the place here for a detailed analysis of the relevance of the new material, not least because further evidence may be submitted on that point. However I am satisfied that there is at least prima facia an arguable case in respect of the new material. This therefore points to allowing the amendment.
- 9 I turn next to the diligence of the claimant. The expectation is that each party will do its best to put its whole case forward at the outset and that where a party seeks to add to its case it should do so at the earliest possible opportunity. The claimant’s argument on this point is that the new evidence of prior use only came to light after it had filed its statement of case. At the time of filing its statement of case it thought that only evidence of secret prior use was available. Apparently the employee of the claimant who was dealing with this matter has changed and it was only when a new person took over that it was realised that there was also evidence of public prior use. The defendant notes that the claimant has not gone into any further detail about the particular circumstances of this change in personnel. The defendant has suggested that the claimant should provide more evidence for the reasons for the delay. I have resisted asking for more evidence in an attempt to avoid further prolonging these proceedings and also because if the delay had not been the result of a lack of diligence or competence on behalf of the claimant then it is reasonable to presume that the claimant would have already put in evidence to demonstrate this. The failure by the claimant to raise prior use from the outset would therefore seem to result from

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<sup>1</sup> 1972 RPC 684

either incompetence or a lack of diligence on its part and this in my view counts against allowing the amendment.

- 10 I will now consider the likely impact of allowing the amendment on the future prosecution of the case. Amendments that would likely cause the loss of the hearing date tend to be allowed only in exceptional cases. In this instance however the hearing date has already been lost as a result of having to consider the claimant's request to amend its statement. To the extent that the cancellation of the hearing has caused the defendant to incur additional cost then that is something that can be taken into account when costs are determined. A new date has yet to be set but even if I do not allow the amendment then I suspect the hearing will not be before March or April 2015. But would allowing the amendment unduly delay this even further?
- 11 Both sides have submitted their evidence in chief. The next stage was to be the simultaneous filing of the evidence in reply. If however I allow the claimant to amend its statement of case then I will first need to allow the claimant a brief period to file the amended statement. I would note that it would have been better had it filed with its evidence in chief a provisional statement with the proposed amendments clearly set out. It has unfortunately not done this though it has apparently filed the evidence in support of the claimed prior use. Once an amended statement is filed then it will be necessary to allow the defendant an opportunity to amend its counterstatement and submit any additional evidence in chief in relation to the prior use.
- 12 The claimant has been unable to provide what I would consider to be irrefutable documentary evidence to demonstrate that the particular product in question was actually made available to the public prior to the filing date of the patent in issue. Rather it relies on a statement from one of its employees to piece together a mosaic of documentary material some of which post dates the filing date of the patent in issue. This creates a potential new line of argument on the question of when the prior use occurred and this may require further evidence and submissions. It will therefore be necessary to allow the defendant a suitable period to consider this.
- 13 A period for both sides to file any evidence in reply would then also need to be provided. I would anticipate that all of these stages would be complete by around the end of March or early April 2015. This suggests, assuming no further delays, a rearranged hearing date in late April or May. This is not that much later than the likely rearranged date for the hearing if I decided not to allow the amendment. Hence although the further lengthening of these proceedings is regrettable I do not think it is of such a length as to weigh significantly against allowing the amendment.
- 14 Weighing up the various factors set out above and recognising the public interest in ensuring only valid patents remain on the register, I believe on balance that allowing the amendment is the more just approach to take. I would note however that to the extent that it ultimately results in the defendant incurring unnecessary costs then that is something that will be considered in any cost award.
- 15 I will therefore allow the claimant to amend its statement of case. An amended statement should be filed no later than 3 weeks after the date of this decision. The defendant will then be given a suitable period to file an amended counterstatement

and any additional evidence in chief. Both sides will then have a further period to file any evidence in reply.

### **Appeal**

- 16 Any appeal must be lodged within 28 days

Phil Thorpe