BL O/111/05

22 April 2005

PATENTS ACT 1977

BETWEEN

The British Pre-cast Concrete Federation Limited	Claimant
and	
Coventry University	Defendant

PROCEEDINGS

Opposition to an application under section 27 to amend patent number GB 2294077

HEARING OFFICER R J Walker

PRELIMINARY DECISION

This preliminary decision was given orally. The attached is the transcript of the decision as approved by the hearing officer.

THE PATENT OFFICE

Video Conference Suite
Concept House
Cardiff Road
Fos: 42 Newport
Gwent, NP10 8QQ
Friday, 22nd April, 2005

Before:
MR ROGER WALKER
(Divisional Director)
(Sitting for the Comptroller-General of Patents, etc.)

B E T W E E N : -

BRITISH PRE-CAST CONCRETE FEDERATION LIMITED Claimant

-and-

COVENTRY UNIVERSITY Defendant

Transcript of the Shorthand Notes of Harry Counsell (Wales)
41, Llewellyn Park Drive, Morriston, Swansea, SA6 8PF
(Tel: 01792 773001 Fax: 01792 700815 e-mail: HarryCounsellW@aol.com)
Verbatim Reporters

MR JULIAN BARDO (of Messrs Abel & Imray, Patent & Trade Mark Attorneys, 3 Chapel Row, Queen Square, Bath BA1 1HN), assisted by MS JUDITH COUGHLAN, appeared on behalf of the Claimant

MR PETER COLLEY (instructed by Messrs Marks & Clerk, Patent & Trade Mark Attorneys, 144 New Walk, Leicester LE1 7JA), assisted by MR VINCE HALLAM, appeared at Harmsworth House on behalf of the Defendant by means of video link

PRELIMINARY DECISION
As Approved by the Hearing Officer

THE HEARING OFFICER: I think it would be useful to set out a little of the background to this hearing before I get into the actual substance of the decision.

The substantive issue relates to an application, made on 11th July 2002, to amend under section 27 of the Patents Act, 1977 in relation to UK Patent No 2294077 in the name of Coventry University.

Notice of Opposition to this application was lodged on 10th September 2003 by The British Pre-Cast Concrete Federation Limited. Three grounds for opposition were given -

(1) the claims as proposed to be amended do not comply with section 14(5), nor does the amended specification meet the requirements of section 76;

(2) favourable exercise of the Comptroller's discretion to allow the requested amendments should be refused; and finally

(3) the claims as proposed to be amended are not distinguished from prior art which the University (that is Coventry University) is aware of, and the amendment does not cure the defect to be overcome.

The University's counterstatement did not admit any of these grounds.

During the course of the proceedings that followed the defendant (that is the University) filed their evidence-in-chief on 25th February 2004. This evidence included a witness statement by Professor Pratt. Professor Pratt incidentally is the named inventor on the relevant patent. The claimant (that is The Federation) filed their evidence on 15th December 2004. That evidence included witness statements by Mr Wharton and Mr Hodson.

The Office wrote to both parties on 13th January 2005 to arrange a date for the substantive hearing. In this letter the Office set a deadline of 7th February 2005 for both sides -

- to agree a date for the substantive hearing between 31st January 2005 and 13th April 2005; and also
- to inform the Office if cross-examination was being sought.

Both sides subsequently agreed to extend the deadline for responding to the Office's letter to 13th April 2005. It was also agreed to extend the deadline for holding the substantive hearing until 11th May 2005.

The defendant's patent agent, Marks & Clerk, wrote on 12th April 2005 informing the claimant's patent agent, Abel & Imray, of their intention to cross-examine Messrs Hodson and Wharton at the substantive hearing. The claimant's patent agent then wrote to the Office on 14th April 2005 to request a preliminary hearing to determine whether or not there should be cross-examination of any witnesses. The claimant's patent agent also requested that the Office should defer the substantive hearing until the earliest mutually convenient date in June or July, in the event that cross-examination is required.

Against this background the matter came before me today to decide whether to direct that Messrs Hodson and Wharton should be cross-examined. The claimant requested that Professor Pratt should be cross-examined in the event that cross-examination of Messrs Wharton and Hodson was allowed.

At the hearing before me today Mr Peter Colley (instructed by Marks & Clerk) appeared for the patentee, and Mr Julian Bardo (of the firm Abel & Imray) appeared for the claimant.

The Arguments

Regarding the arguments that were advanced today, I started by reminding both parties that the main purpose of evidence is to prove the facts. This seemed necessary because some of the evidence contained in the witness

statements of Mr Wharton, Mr Hodson and Professor Pratt appeared to reflect their opinions in relation to the facts. I also noted that none of these witness statements had been formally presented as expert opinion.

Mr Colley explained that it might help the hearing officer at the substantive hearing to see the facts through expert eyes. For example, the evidence of Messrs Wharton and Hodson and Professor Pratt may assist the hearing officer to form a view of what was common general knowledge at the relevant time. Mr Colley nevertheless noted that the need for cross-examination of Messrs Wharton and Hodson would disappear if their evidence was withdrawn. This was something that Mr Bardo could not accept: he wanted to keep this evidence in.

Therefore, although I raised the question about this evidence, I am content to admit it and leave it to the hearing officer at the substantive hearing to give this evidence appropriate weight.

Having dealt with that point, Mr Colley went on to explain that he wanted to cross-examine Messrs Wharton and Hodson to test and assess their evidence, including testing their respective recollections, independence, expertise, reliability, the basis of their respective understandings underpinning their evidence, and the basis on which their evidence was given.

On the basis of what was said by Lawton LJ in J Sainsbury Limited's Application [1981] FSR 406 and what was said by Jacob LJ in Markem Corporation and another v Zipher Ltd [2005] EWCA CIV 267, Mr Colley stressed that he did not want to find himself in the position of inviting the hearing officer not to believe parts of the evidence of Mr Wharton and Mr Hodson without testing that evidence on cross-examination. He emphasized that even if on one small

point he wanted the hearing officer to prefer the opinion of one expert over the other, the evidence must have been tested. In his submission, where there was reason to doubt or question the accuracy or veracity of the evidence of a witness, it was entirely right and fair that that evidence be explored by cross-examination if the opposing party so requests. He also advanced the view that the lack of contrary evidence does not preclude the need to test evidence. He put forward the view that the field relating to the invention (which is concrete blocks) is neither trivial nor simple; there could be wrinkles which will need to be explored at the substantive hearing. Finally, Mr Colley observed that reasonable notice had been given of the wish to cross-examine both Mr Wharton and Mr Hodson.

For the claimant, Mr Bardo made the points that (a) the defendant had only filed one witness statement in reply and this was largely consistent with the evidence of both Mr Hodson and Mr Wharton; (b) there is no conflict between the parties in relation to the facts; and (c) the attack on the validity of the amended claim is plainly based on documentary evidence. The claimant was not seeking to establish invalidity based on prior use. Therefore in Mr Bardo's view there was no need for cross-examination.

Referring to the evidence of another of the defendant's witnesses, Mr Hallam, Mr Bardo explained that Mr Hallam had effectively admitted that paving blocks, which were known as Ceepy blocks, were the same as the blocks disclosed in certain documents which were before the hearing officer, and were therefore in the public domain. Indeed, it was said that much of the evidence of Messrs Wharton and Hodson was for the purpose of demonstrating clear disclosure of Ceepy blocks in these documents. Accordingly, it was felt that the only question to be determined is the relevance of these to the amended patent.

Assessment

That is a summary of the arguments put to me this morning. I think from these emerge an important consideration as to whether I should allow cross-examination, and that is, whether cross-examination is likely to elucidate the facts needed to determine the substantive matter.

I am persuaded by Mr Colley's submission that there is a need to test and assess the evidence of Messrs Wharton and Hodson, for the reasons he gave: that is, testing their respective recollections (some of which are nearly 20 years old), independence, expertise, reliability, the basis for their respective understandings underpinning their evidence, and the basis on which their evidence was given. Moreover, in the light of the Sainsbury and Markem authorities (which were presented to me at the hearing) I am reluctant to deny the defendant this opportunity. Moreover, despite the apparent simplicity of the technology involved, I am not persuaded that there are no wrinkles that might need to be explored.

I have some sympathy for the claimant's view that the defendant has chosen not to contradict in evidence the evidence of both Mr Wharton and Mr Hodson. Nevertheless, in the interest of fairness, I do not consider this a sufficient reason to direct that both Mr Wharton and Mr Hodson should not be cross-examined. I also cannot be totally certain that conflict between the parties might emerge from cross-examination. Thus, the present apparent absence of any significant conflict on the facts does not provide a secure ground for denying cross-examination.

Although there appears to be agreement between the parties that certain documents in this case relate to Ceepy blocks, nevertheless in my view there

may be an underlying prior use argument. For example, Mr Wharton has introduced a Ceepy block as an exhibit to his witness statement. In addition it sems to me that cross-examination will help the hearing officer to establish the boundary between opinion and fact.

Conclusion

Therefore I direct that Messrs Wharton and Hodson should be available for cross-examination at the substantive hearing.

In the event that this was my decision, Mr Bardo indicated that the claimant would want to cross-examine Professor Pratt. I note that Mr Colley said he had no objection to that.

Costs

Both Mr Colley and Mr Bardo addressed me on costs. The defendant has succeeded today on the question of cross-examination. I therefore award costs according to the standard Patent Office scale of £500 to the defendant.

Appeal

As is normal, under Practice Direction to Part 52 of the Civil Procedure Rules, any appeal must be lodged within 28 days from the date of this decision.

That concludes my decision, but we still have the matter of fixing a hearing date.

MR COLLEY: Sir, yes. If I could just address you briefly on that? The position as we understand it is that we did try and provide dates which ran beyond 11th May, but Mr Bardo did not have or was not in a position to provide corresponding dates, and indeed is contingent upon being able to obtain the services of counsel. Could I suggest that we be given a chance to make the appointment through the clerks again, or rather through Mr Bardo's clerk and through my clerk, with you setting a new "hear by" date, I think on the assumption that the hearing will be perhaps one and a half or possibly two days now with cross-examination?

THE HEARING OFFICER: I don't know exactly what you intend by a "hear by" date - whether that is the latest date for the hearing?

MR COLLEY: Yes. Sorry, that is what I meant. In the past you have set a “hear by” date of 11th May, if I can use “hear by” as a shorthand. If you set a new “hear by" date, that will ensure that matters don’t drift. Mr Bardo can take instruction on the availability of counsel and his witnesses, and we can liaise again with the Office through our clerks and through Mr Bardo in an attempt to agree mutually convenient dates.

THE HEARING OFFICER: If I suggested a “hear by" date of the end of June, would that cause either side real difficulties?

MR COLLEY: No. We were certainly thinking that it should be sooner rather than later, and we were trying to get dates to take us to the end of June, so we were reasonably well prepared to address that issue. The end of June seems to us to be sensible.

THE HEARING OFFICER: Mr Bardo?

MR BARDO: So far as I am aware, we should be able to manage by the end of June, provided that we can have a degree of equitability in terms of how many dates we each provide.

MR COLLEY: Well, I think what we proposed (and indeed what my clerk was working to) was a list of everybody’s dates, but I’m afraid they don’t go quite far enough to the end of June. So that in preparing, for example, Professor Pratt, Mr Hallam, the other patent attorney concerned and myself, if my clerk has all those diaries to the end of June, Mr Bardo can do likewise with his counsel and with Mr Wharton and Mr Hodson and of course his own availability, and then by putting all that information together for the Listings Clerk in the Patent Office it should be possible to find dates which are mutually convenient, I would have thought, by the end of June.

THE HEARING OFFICER: Yes. And of course there is another issue, and that is the availability of hearing rooms ---

MR COLLEY: Oh, indeed, yes.

THE HEARING OFFICER: --- but that is probably the least of our difficulties.

MR COLLEY: Yes. Sir, I have got one consequential point on the costs order: could we ask - as is now the norm in the High Court - that the costs of £500 be paid within 14 days?

THE HEARING OFFICER: Yes, I agree to that.

MR COLLEY: Thank you very much. Unless there is anything else which we can assist you with, sir, I think we have no more submissions, and I think we are clear as to where we are going.

THE HEARING OFFICER: Can I just confirm that we have agreed that I have ordered that the deadline for the hearing should be the end of June? I think it would be convenient if I also set a deadline for agreeing a date of one week. So if we could have a date agreed by this time next week?

MR COLLEY: Yes. I am not sure about the imposition to agree. I think it would be sensible that they attempt to agree and, if not, the Office imposes. So would it be an attempt to agree by the 29th?

THE HEARING OFFICER: Attempt to agree by the 29th.

MR COLLEY: By the 29th April and, in default of agreement, the Office then sets a date before the 30th of June.

THE HEARING OFFICER: Mr Bardo, do you want to say anything?

MR BARDO: Yes. Can I say something to that, please? I have been in touch with Mr Tappin's clerk, and I have established that he is generally around, but I don't know how easy it is going to be within the next week starting from total coldness to get his availability sorted, because he has got to discover what he is being asked to do here.

MR COLLEY: With respect to Mr Bardo, I think the position is this. It is really a matter for Mr Tappin's clerk if it is Mr Tappin who will make the representations. The clerks all have electronic diaries. And I think as part of Mr Bardo's inquiry he foreshadows having to produce a skeleton in the week before whatever the hearing date is for Mr Tappin. Mr Tappin's clerk should be able to answer from the state of his diary whether that is possible. So if instead of just focusing on the dates for the hearing he looks at the week beforehand as well, it should be possible to get that information, in my submission. We all work from effectively a common diary these days.

MR BARDO: So the date would be - what?

THE HEARING OFFICER: The date would be a hearing by the end of June, but I think what ---

MR BARDO: Yes, but the other date, the settling date?

THE HEARING OFFICER: The settling date, by the 29th of April. So that is a week today.

MR COLLEY: If it would help, we don't have a problem with perhaps giving Mr Bardo an extra seven days for the "settling by" date, if he wanted to add seven days to the 29th of April to take us through to the 6th of May, if that gives him more leeway to find out what Mr Tappin's availability is. We would have no difficulty with that.

THE HEARING OFFICER: I would be content with that as well. So shall we say a settling date by the 6th of May?

MR COLLEY: Failing which, the Office will give a direction?

THE HEARING OFFICER: Yes. And the objective should be to hold the hearing before the end of June.

MR COLLEY: Yes. That seems perfectly sensible, sir. Thank you very much.

THE HEARING OFFICER: Is there anything else I need to deal with?

MR COLLEY: Sir, there is one point. I am assuming, although you have not directed it - our offer was, assuming that Professor Pratt is available for the mutually agreeable date, that we have no difficulty in tendering him. You have given the direction against Mr Bardo's resistance. I am content that you do not need to give a direction about Professor Pratt. I just wanted to make sure that was your understanding.

THE HEARING OFFICER: It was not a direction. It was ---

MR COLLEY: No, indeed.

THE HEARING OFFICER: --- a conclusion just to record your contentment to the availability of Professor Pratt for cross-examination.

MR COLLEY: Indeed, sir. Thank you very much.

THE HEARING OFFICER: Are we done?

MR COLLEY: We are, sir. Thank you very much indeed.

THE HEARING OFFICER: Thank you very much for your arguments.

MR BARDO: Thank you.
