



BL O/317/05

9 December 2005

PATENTS ACT 1977

BETWEEN

Dr. Pavel Pinkava

Claimant

and

LIFFE Administration and Management

Defendant

PROCEEDINGS

Reference under section 12 in
respect of certain US patent applications

HEARING OFFICER

R J Walker

DECISION

- 1 On 18th August 2005 Dr. Pavel Pinkava filed a reference under section 12 of the Act concerning four United States patent applications which were not identified by reference to their application numbers. Nevertheless, copies of these applications were filed with the reference. A covering letter from Dr. Pinkava's solicitors, Wragge & Co., explained that the request to commence these proceedings before the comptroller was part of an ongoing action in the Patents Court in relation to the ownership of confidential information in the patent applications. The letter concluded with a request that the comptroller decline to deal with the reference under section 12(2).
- 2 In a letter dated 19th September 2005, the firm of solicitors, Clifford Chance, acting for the defendant, LIFFE Administration and Management, stated that it had no objection to Dr. Pinkava's request that the comptroller decline to deal with the entitlement proceedings. In view of this and given that it would be undesirable to have the same or largely similar issues litigated before the comptroller and the court, under section 12(2) I decline to deal with the reference.
- 3 In a letter, dated 14th September 2005, Wragge & Co. requested that both the statement of grounds and the copies of the four US patent applications, which had not as yet been published, be treated as confidential under rule 94(1) of the Patents Rules 1995. Unfortunately, this request was made after the fourteen day period set out under rule 94(1) for doing so, by which time copies of the documents had already been sent to the defendant. In view of these circumstances the Office wrote to Dr. Pinkava and invited

his comments on how it might deal with this matter. Wragge & Co. replied on 11th October 2005 by requesting that the rule 94(1) period be extended under rule 110(1) and stated that there was no issue with the documents that had already been copied to the defendant. In view of the reasons given, and in particular the nature of four of the documents concerned, i.e. unpublished US patent applications, I allow the requested extension of the period specified in rule 94(1) and I also direct under this rule that the documents, identified in the Wragge & Co. letter of 14th September 2005 and held by the Office, be treated as confidential until such time as the information contained in them enters the public domain. To this end Wragge & Co. have undertaken to inform the Office as soon as the US applications are made public.

Costs

- 4 Neither side has asked for costs in respect of this matter.

Appeal

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

R J WALKER

Divisional Director acting for the Comptroller