



BL O/016/07

12 January 2007

PATENTS ACT 1977

BETWEEN

Microscience Technologies Ltd

Claimant

and

CRP Group Limited

Defendant

PROCEEDINGS

Reference under section 8 of the Patents Act 1977 in
respect of patent application GB 0607356.3

HEARING OFFICER

P Thorpe

Order

Background

- 1 This order is concerned with whether Microscience Technologies Limited (hereinafter "MST") can submit certain documents in support of its statement of case.
- 2 The statement of case and subsequent supplementary statement of grounds, which were filed on 7 September 2005 and 30 October 2006 respectively, seek a determination by the Comptroller under section 8 as to the true proprietor of patent application GB 0607356.3. The patent application was filed on 12 April 2006 and is currently proceeding in the name of CRP Group Limited (hereinafter "CRP").
- 3 In its statement of case, which I will take to include also the supplementary statement of grounds, MST claims either sole or joint entitlement to the patent application. It argues that it made specific confidential disclosures to CRP prior to CRP filing the application. The statement of case makes reference to a number of exhibits and copies of some of these have been included with the statement of case. However some exhibits have not been copied to the Office.
- 4 The Office wrote to MST to request that copies of the missing exhibits be submitted. The letter made reference to Rule 112 of the Patent Rules 1995 as

amended which reads as follows:

Where a document, other than a published United Kingdom specification or application, is referred to in any reference, notice, statement, counter-statement, observations or evidence required by the Act or these Rules to be filed at the Patent Office or sent to the comptroller, copies of the document shall be furnished to the Patent Office within the same period as the reference, notice, statement, counter-statement, observations or evidence in which they are first referred to may be filed and in the following number-

(a) where the document in which they were so referred to had to be filed or sent in duplicate or the original document had to be accompanied by a copy thereof, in duplicate; and

(b) in all other cases, one:

Provided that where a copy of any evidence or observations is required by the Act or these Rules to be sent direct to any person, a copy of any document referred to in that document shall also be sent direct to that person.

5 In a response dated 30 October, MST's representative from Murgitroyd & Company, Mr Craig Thomson, observed that his client would:

"wish to make a full and frank disclosure of all communications that are pertinent to establishing the entitlement of British patent application No. 0607356.3, and so would wish to provide the Office with the omitted communications. However, despite our assurances that we would request that the omitted communications be kept off the public part of the UK Patent Office file, Trelleborg CRP Limited have refused their consent to disclose the omitted Exhibits to the UK Patent Office."

6 The letter went on:

"Accordingly, we request the UK Patent Office exercise their discretion to order specific disclosure of the documents referred to herein as Nos. 12, 14-16, 18, 20, 24, 25, 27, 32 and 34. The Office are reminded that my client is already in possession of each of the omitted communications and that my client is happy for these communications to be kept off the publically available part of the official file. There can, therefore, be no justifiable reason for Trelleborg CRP Group to deny the disclosure of the relevant documents specifically to the UK Patent Office."

7 In a further letter dated 14 November 2006, Mr Thomson extended the request for disclosure to a further document consisting of another email exchange between the two sides. Mr Thomson confirmed that his client also already had a copy of the particular email. I shall for the time being refer to the exhibits specifically mentioned above and the email referred to in the letter of 14 November 2006 as "these documents".

8 At first glance it seems surprising that MST did not simply submit these documents, of which by its own admission it had copies, to the Office. The reason why it didn't do this but instead sought the assistance of the Comptroller appears to be that it felt vulnerable to a possible action for breach of confidence. Indeed this is alluded to in a letter from Mr Hutchinson of CRP's representatives, W.P Thompson & Co. to Mr Thomson dated 30 October 2006 which has been copied to the Patent Office. This letter refers to a confidentiality agreement that existed between the two sides. In this letter Mr

Hutchinson also notes that:

“I have now had an opportunity to consider the communications attached to your 20 October 2006 fax and it appears to me that the communications in question contain confidential and/or commercially sensitive information, including confidential and/or commercially sensitive information unrelated to the subject matter of United Kingdom Patent Application No: 0607356.3.

Accordingly, my client, Trelleborg CRP Limited, does not consent to your disclosure of any of the contents of any of the communications appended to your 20 October 2006 fax to any third party, including the Patent Office.”

- 9 I have been asked to resolve this impasse and both sides have agreed that I do so on the basis of the papers filed.
- 10 I will begin by confessing that I am unaware of any situation similar to this arising before the Comptroller. Neither side has referred to any case law nor has either side provided me with any legal argument. This is perhaps not surprising since the whole dispute seems to stem from a number of misunderstandings by both sides.
- 11 I will start with the role of the Patent Office or more precisely the Comptroller in disputes about entitlement to patents. The Comptroller is a tribunal empowered under the Patents Act 1977 to be the first instance jurisdiction for disputes relating to entitlement to patents and patent applications. The Comptroller's status is therefore not that of “any third party”. Here we have a dispute as to entitlement to a patent application that has been referred under section 8 to the Comptroller. Rule 54 prescribes that such a reference shall be accompanied by a statement setting out fully the nature of the question, the facts upon which the person making the reference relies and the order which he is seeking. As noted above Rule 112 requires that copies of any document referred to in a statement should be sent to the Patent Office.
- 12 It is well established that the contents of a statement and indeed the nature of any evidence filed in support of the case set out in the statement is a matter for the claimant. Where the respondent believes that material submitted by claimant should not be admitted then again there are well established procedures for it to object.
- 13 The most common reason for objecting is that the material is privileged. In this case the question of privilege was referred to in some of the earlier correspondence however later correspondence, in particular the letter from Thompson & Co dated 30 October 2006, suggests that privilege is no longer an issue with these documents. Rather the objection against the filing of these documents is now based solely on CRP's claim that they contain confidential and commercially sensitive information. However it is quite common for such information to be submitted in entitlement cases. Where a party has concerns about issues of confidentiality then the proper course of action is to request that the hearing officer issue an order under Rule 94 treating the material as confidential. Guidance on this is provided in paragraphs 3.36-3.39 of the

Patent Hearings Manual¹.

- 14 The defendant is clearly aware of this provision since it has asked that I make such an order if the documents are admitted. Yet despite this it is maintaining its position that the claimants are not permitted to submit these documents solely because they contain confidential or commercially sensitive material.
- 15 I believe such a position is simply indefensible. A claimant must remain free to put forward whatever arguments and evidence it considers necessary to do justice to its case. Any concerns regarding confidentiality of material once submitted can be dealt with under the safeguards that clearly exist.
- 16 It is therefore my view that these documents should be admitted. Do I need to do more than just saying that? Strictly speaking I do not believe I do. The claimant however appears to want more and has asked for me to order specific disclosure of these documents.
- 17 However I cannot see how a disclosure order is of any assistance to the claimant in this respect. This is for the simply reason that a disclosure order would only provide for the claimant to inspect or receive copies of the relevant documents from the defendant. It would not require the defendant or the claimant to submit them to the Office. Therefore since the claimant already has copies of the documents nothing would be gained by such an order.
- 18 What I can do and what I will do in order to progress these proceedings is to make an order using my powers under Rule 106. This reads:
- At any stage of any proceedings before the comptroller he may direct that such documents, information or evidence as he may require shall be furnished within such period as he may fix.
- 19 Such an order will require MST to submit the relevant documents.
- 20 I need also to consider the subsequent treatment of these documents once they have been submitted and also what CRP also now needs to do. CRP has requested that these documents, if admitted, be kept off the public record pursuant to Rule 94(1). MST has raised no objection to this indeed it too has suggested that they be kept off the open part of the Official file.
- 21 However it is not just the views of the parties that I need to take into account. This is made clear in paragraph 3.37 of the Patents Hearing Manual which reads:
- As explained by the Court of Appeal in *Lilly Icos Ltd v Pfizer Ltd (No2)* [2002] EWCA Civ 2, [2002] 1 WLR 2253, the starting point should be that very good reasons are required for departing from the normal rule of publicity, and a simple assertion of confidentiality, even if supported by both parties, will not suffice.
- 22 At present the only reasons put forward by CRP why these documents should

¹. Patent Hearings Manual at <http://www.patent.gov.uk/hearings-chapter03.pdf>.

be kept confidential is that they contain “*confidential and/or commercially sensitive information, including confidentially sensitive information unrelated to the subject matter of United Kingdom Patent application No:0607356.3*”.

- 23 Such vague statements as this are I am afraid simply not good enough. They certainly do not provide sufficient justification for me to place a blanket confidentiality order on the whole contents of what is not an insignificant number of documents. I am therefore not prepared to make any order under Rule 94 at this time but will instead invite further submissions on this matter. Any such submissions should take into account the guidance provided in Section 118 of the Manual of Patent Practice and the corresponding sections of the CIPA Guide to the Patents Act. In the meantime whilst this issue is still outstanding, these documents will remain Not Open to Public Inspection.
- 24 I will set the period for filing any such submissions to six weeks from the date of this decision. This is on the generous side but is intended to ensure that work on any submissions does not hinder the timely filing of the counterstatement. Since CRP already has copies of the documents referred to in this decision, there seems no reason why the period for filing the counterstatement, which is six weeks, should not also run from the date of this decision.

Order

- 25 I order that MST submits to the Patent Office any documents referred to in its statement of case or supplementary statement of grounds that have not already been submitted together with the email referred to in its letter of 14 November 2006 within 2 weeks of this decision.
- 26 I also order that CRP files its counterstatement within 6 weeks of this decision.
- 27 I also order that CRP, and MST if it so chooses, submit further argument in support of the request that these documents be treated as confidential under Rule 94 within 6 weeks of this decision.

Costs

- 28 Neither side has sought an award for costs in this matter therefore I make no such award.

Appeal

- 29 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