



PATENTS ACT 1977
(THE PATENTS RULES 2007)

PATENTEE Ability International Limited
OPPONENT Monkey Tower Limited
ISSUE Application to amend UK Patent
GB2432573B under section 75
HEARING OFFICER H Jones

Mr Alan Johnson of Bristows LLP represented the Patentee
Mr Mark Vanhegan QC of 11 South Square, instructed by Sanderson & Co, represented the Opponent

PRELIMINARY DECISION

Introduction

- 1 In my decision concerning revocation of GB2432573 issued in August last year (BL O/334/13), I found that various claims of the granted patent and others submitted as conditional amendments in the course of proceedings were anticipated by the disclosure in US2961060. I also found that the wording of claim 2 of the conditional amendments relating to the offset-mast arrangement of the overhead platform was unclear, but considered that it would be possible to clarify the wording through amendment to arrive at an allowable form of claim. The patentees, Ability International Limited (“AIL”), were given six weeks to file amendments under section 75 or else the patent would be revoked.
- 2 The applicants for revocation, Monkey Tower Limited (“MTL”), appealed my decision on the basis that I should not have allowed AIL an opportunity to amend under section 75. The appeal was heard by Mr Henry Carr QC sitting as deputy judge of the High Court. In his judgment dismissing the appeal, Mr Carr QC said that in his view the exercise of discretion by the comptroller to allow amendment under section 75(1), post hearing, needs to have regard to all circumstances which are relevant to the question of procedural fairness to the parties, which are likely to include:
 - i) the resources already devoted by the parties to the proceedings,
 - ii) the extent of any re-litigation as a result of the amendment,
 - iii) the likelihood that a valid amendment can be proposed,
 - iv) whether there is evidence that prejudice will be caused.
- 3 Mr Carr QC noted that the decision under appeal was reached on the basis of short written submissions from the parties and that the patent was technically simple. He pointed to paragraph 26 of my decision where I said that it would be possible to “encapsulate the offset mast arrangement of the invention into a form of words that is

clear and does not add subject matter, and to avoid anticipation or be rendered obvious by D1 (US2961060).” He went on to say that in these circumstances:

“the opportunity for re-litigation is limited. MTL will of course be entitled to object to whatever amendment is proposed by AIL. Such amendment may not be accepted by the Comptroller. However, such further proceedings are likely to take the form of short written submissions, consistent with the admirable restraint that the parties have exercised to date.”

- 4 AIL filed amendments under section 75 on 17 February 2014 and these were advertised for opposition on 26 March 2014. MTL opposed the amendments on the grounds that the proposed form of claim 1 lacks novelty and/or inventive step with respect to twelve or so new pieces of prior art. Soon afterwards, AIL asked for large sections of MTL’s grounds for opposition to be struck out on the basis that they introduce new attacks on novelty and inventive step and that MTL should not be allowed to re-litigate the case under the guise of section 75. MTL insist that they are within their rights to introduce new prior art in opposition to the amendments, especially since the proposed claims were not available to them in the initial revocation action.
- 5 This preliminary decision is concerned with the scope of opposition to amendments under section 75. The parties appeared before me by telephone conference on 26 September 2014, with Mr Mark Vanhegan QC appearing as counsel for MTL and Mr Alan Johnson of Bristows LLP appearing for AIL.

The law

- 6 The relevant parts of section 75 of the Act are set out below:

s75 (1). In any proceedings before the court or the comptroller in which the validity of a patent may be put in issue the court or, as the case may be, the comptroller may, subject to section 76 below, allow the proprietor of the patent to amend the specification of the patent in such manner, and subject to such terms as to advertising the proposed amendment and as to costs, expenses or otherwise, as the court or comptroller thinks fit.

s75(2). A person may give notice to the court or the comptroller of his opposition to an amendment proposed by the proprietor of the patent under this section, and if he does so the court or the comptroller shall notify the proprietor and consider the opposition in deciding whether the amendment or any amendment should be allowed.

...

s75(5). In considering whether or not to allow an amendment proposed under this section, the court or the comptroller shall have regard to any relevant principles applicable under the European Patent Convention.

- 7 Section 75(5) was added by the Patents Act 2004 to ensure consistency with the new central amendment process for post-grant amendment of European patents under the European Patent Convention (EPC2000).
- 8 Opposition proceedings before the comptroller are governed by Part 7 of the Patents Rules 2007, the relevant parts of which are set out below:

r75. The comptroller must advertise in the journal any event to which it is possible to object under any of the provisions mentioned in Part 2 or 3 of Schedule 3, subject to rule 105(5). [Section 75(2) is listed under Part 2 of Schedule 3]

r76(1). Proceedings are started when a person files in duplicate -

- (a) the relevant form; and
- (b) his statement of grounds.

r76(2). Any person may give notice of opposition –

- (a) in the case of section 75(2), before the end of the period of two weeks beginning immediately after the date of the relevant notice; and
- (b) in the case of any of the other provisions mentioned in Part 2 of Schedule 3, before the end of the period of four weeks beginning immediately after the date of the relevant notice.

.....

r83(1). A party may apply to the comptroller for him to strike out a statement of case or to give summary judgment.

r83(2) If it appears to the comptroller that –

- (a) the statement of case discloses no reasonable grounds for bringing or defending the claim;
- (b) the statement of case is an abuse of process or is otherwise likely to obstruct the just disposal of the proceedings; or
- (c) there has been a failure to comply with a section, a rule or a previous direction given by the comptroller,

he may strike out the statement of case.

Arguments and analysis

- 9 MTL say that section 75(5) requires the comptroller to have regard to any relevant principle under the European Patent Convention (EPC) in considering whether or not to allow an amendment in revocation proceedings. They argue that the comptroller must therefore have regard to whether the proposed amended patent would still be invalid whether for internal validity – added matter, lack of clarity, etc. – or for substantive invalidity such as lack of novelty, obviousness, etc. They also say that since the proposed amendments were not before me when I made my decision on revocation, the issue as to the validity of the claims of the proposed amended patent has not been litigated before and so it would be procedurally unfair to prevent them from attacking the validity of the claims now when they would have been allowed to do so in the revocation proceedings. As a result, the construction and the validity of the proposed new amended claims must be considered afresh and any person, be that the original applicant for revocation or any other third party, is entitled to raise any such objections and any such prior art in respect of such claims as deemed fit (rule 76(2)). They contend that not only are they entitled to rely on the prior art pleaded in the original revocation proceedings but they are also entitled to rely on newly cited prior art in their opposition to the proposed amendments.
- 10 MTL rely on the following case law in support of their arguments: *Dudgeon v Thomson & Donaldson* (1877-78) LR 3 App Cas 34, *Nikken v Pioneer* [2006] FSR 4, *Vector Corp v Glatt* [2008] RPC 10 and *Nokia v Ipcorn* [2011] FSR 15. They say that the Court of Appeal has repeatedly refused to exercise discretion to allow post decision amendments because of the foreseeable consequence, which they say is the case here, that the opponent would be entitled to raise any such prior art as it considers apposite and that it will typically (and almost inevitably) lead to and require

a further trial. They say that the comments of Jacob LJ at paragraphs 11-13 in *Nikken v Pioneer* are particularly relevant:

11. *Class (c)*¹ involves something different, a proposed claim which was not under attack and could not have been under attack prior to trial. If the court is to allow such a claim to be propounded after trial, there is almost bound to be a further battle which would arise in the proposed amendment proceedings. That battle will be over whether or not the proposed amended claim is valid. I say “almost bound” because I can just conceive a case where the point was covered by the main litigation is some way or other.

12. That is not the case here. Mr Baldwin frankly accepted that if the proposed amendment proceedings were to go ahead, it would be open to Pioneer to advance a case on obviousness, a different case from the one they were advancing before.....No evidence was directed to whether or not it was obvious to implement [prior art] in that way and there was no need to put any such evidence in because it was not an issue before [the trial judge] at the first trial.

13. So what is proposed here will or could lead to two trials instead of one...

11 MTL say that this is consistent with the comments of Mr Carr QC during the appeal in which he accepted that MTL were entitled in principle to object to whatever amendment proposed by AIL (at paragraphs 21(c) and 26 of his judgment). MTL also directed me to *Union Switch and Signal Co’s Application (1914) 31 RPC 289* at p.293, as noted in section 15-90 of Terrell Ed.17, which they say supports their argument that an opponent to an amendment would have been “at liberty to argue the matter afresh”.

12 For the sake of completeness I note that the other two situations set out *Nikken v Pioneer* in which the exercise of discretion to allow amendment may be sought are a) before a trial; and b) after trial, where certain claims have been held valid but other claims held invalid, and where the patentee simply wishes to delete the invalid claims. The court will normally allow amendment in the case of classes a) and b) for the reasons set out by Jacob LJ at paragraphs 9-10:

9. Clearly, if the amendment is proposed in sufficient time before trial the defendant has a full opportunity to attack the proposed amended claims, not only on their allowability or in the exercise of discretion, but on their ultimate validity. The existing procedure for an application to amend the patent specification is governed by CPR Part 63.10. The procedure is by way of an application notice, service on the Comptroller, subsequent advertisement and so on. The procedures can, in appropriate circumstances, be gone through quickly or gone through provisionally on the basis that probably no third party will ever come in to oppose. It may be noted that the rules specifically require by Part 63.10 that the patentee must state whether he will contend that the claims prior to amendment are valid. That means that in advance of trial everyone knows where they stand. The patentee is either saying that the original claims are all right or not, and he is plainly also saying that the proposed amendment claims are all right.

10. In case (b), after trial but where effectively no more than claim dependency is being dealt with, again the position is clear. Following a conclusion that some claims are valid and others are not, the patentee is normally entitled to relief pursuant to section 63 of the Act. Normally the court will impose as a condition of relief that the invalid claims be amended by deletion. Problems may arise if it were held that the patentee had been covetous in some way or other and ought not to be allowed to amend at all. Nothing of the question arises here.

¹ Amendments submitted after trial in which all claims have been held invalid but the patentee wishes to insert what he hopes are validating amendments.

- 13 MTL argue that the facts of the present case are very similar to those before the Court of Appeal in both *Nikken v Pioneer* and *Vector Corp v Glatt*. In *Nikken v Pioneer*, Jacob LJ said that if the proposed amendment proceedings had gone ahead then it would have been open to the defendant to advance a new case on obviousness that hadn't been advanced before (paragraph 12). In *Vector Corp v Glatt*, Jacob LJ said at paragraphs 40-41 that if the proposed amendment were to go ahead then there would be a new insufficiency argument to be made which had not previously been raised and that this "could be the subject of a significant further debate – a fresh trial". MTL suggest that these are clear examples of the Court of Appeal's view that new arguments can be raised in opposition to amendments proposed in the course of validity proceedings. The way in which the Court of Appeal sought to avoid the need for a further trial in these situations was to exercise its discretion under section 75(1) to not allow the patentee to propose amendments in the first place.
- 14 ALL argue that any opposition to an amendment under section 75 must be limited to the question of whether the proposed amendments overcome the issues identified in the validity proceedings. They submit that the "any relevant principles" specified in section 75(5) does not mean "all principles", but rather only those principles which are relevant to the enquiry to hand. They say that in the context of a sub-section concerned with amendment following revocation proceedings, the matter to hand is whether the amendment overcomes the validity attack made upon the claim in the revocation proceedings. They, too, refer to paragraphs 26-28 of my decision and to paragraph 26 of Mr Carr QC's judgment as setting out the parameters for assessing the allowability of the proposed amendments, namely an assessment of the proposed claim to see whether it is clear, that it does not add subject matter, it is not anticipated by US2961060, and no more. They say that this is precisely what Mr Carr had in mind when he said that the nature of the amendments required to overcome the deficiencies identified in my decision would provide limited opportunity for re-litigation, requiring merely "short written submissions" by way of opposition.
- 15 In their initial request to strike out many of MTL's grounds for opposition, ALL referred to the judgment of Mr Justice Whitford in *Great Lakes Carbon Corporation's Patent [1971] RPC 117* where he upheld a decision of the comptroller to strike out a much more limited attack on validity than the one presented in the present case and said that it would be "lamentable" if amendment proceedings were allowed to develop into a roving enquiry into validity. The relevant passages of the judgment appear at pages 125 and 126:

Only general references were made to the suggested difference between the approach in High Court amendment proceedings and the approach in Patent Office proceedings. As has been pointed out by the superintending examiner it must be remembered that where amendment is sought in the High Court, whether in a revocation proceeding or in an infringement action the patent is already invariably under attack. No doubt in such circumstances the court will always consider how far the amendments meet the attacks advanced on the pleadings and the extent to which the amendments may be open to an objection on their face.

The Patent Office has for years as a matter of practice directed its attention to the question as to whether the amendment sought can properly be said to meet the defect which it seeks to cure. The Office has always considered whether the amendment sought on the face of the patent or in the light of the grounds for amendment advanced is open to objection. I think it would be lamentable if the procedure under section 29 were to be allowed to develop into the sort of roving inquiry which the opponents seek to conduct in

this case. If they are right on the issue of validity they could no doubt have opposed the grant of this patent or sought to revoke it at the Office. It will still always be open to them to apply to revoke it in the High Court. These are the proper procedures for raising the general issue which they seek to introduce into this amendment proceeding.

- 16 As MTL point out in their skeleton arguments, the situation before Whitford J was different to the one in the present case. The amendments in *Great Lakes Carbon* were made under section 29 of the Patents Act 1949 and related to “voluntary” amendments initiated by the patentee where the validity of the patent was not in issue (the equivalent of section 27 of Patents Act 1977). In these circumstances, MTL say that it is right for the comptroller to prevent any opponent from citing prior art which will turn the amendment proceedings into, in effect, revocation proceedings. AIL say that the two situations are the same to the extent that opposition proceedings in both section 27 and section 75 are a mechanism for allowing an opponent to challenge whether the amendments proposed by the patentee have the effect of curing the defects they seek to overcome: in revocation proceedings, the challenge will (or at least may) include checking that the amendments overcome the validity challenges made in the revocation proceedings and that they do not add subject matter.
- 17 In answer to MTL’s point about depriving MTL the opportunity to litigate the validity of the proposed claim on wider grounds, e.g. by attacking the novelty of the proposed claim with newly cited prior art, AIL contend that it would be perfectly possible for MTL to do so by commencing new revocation proceedings or by way of a defence in infringement proceedings. On MTL’s point about the proposed claims not being available to me for a full assessment of validity in the revocation proceedings, AIL say that the proposed claim is substantially no different to that in issue before me save for some alterations necessary to address the specific deficiencies identified in my decision. AIL accept that MTL are entitled to question whether the amendment achieves its purpose of overcoming the deficiencies identified in my decision, but they cannot, they say, start a completely new attack based on quite different grounds. AIL say that this is an abuse of process and that aspects of MTL’s statement of case should be struck out under rule 83(2)(b).
- 18 The question of whether the decision I issued in August last year was an interim decision or a final decision was addressed by both sides at the hearing, but neither side suggested that the arguments presented above would be affected by the status of the decision in any way. I understood this to be a question of semantics rather than of substance.
- 19 This case is unusual in the sense that the comptroller receives very few oppositions to amendments under section 75; in fact, it would appear from Litigation Section records that no oppositions under section 75 have been filed at the IPO this century. I suspect that this must also be the case for oppositions before the court given Jacob LJ’s comment in *Nikken v Pioneer* that “*probably no party will ever come in to oppose*”. The question of what would happen if someone did “come in to oppose” lies at the heart of this dispute.
- 20 It is clear from the various Court of Appeal cases cited by MTL in this dispute and before Mr Carr QC in the appeal of my earlier decision, that the court and the comptroller should be reluctant to exercise discretion in favour of allowing amendments under section 75 when such amendments could give rise to new arguments being raised and where a new trial would be necessary. In *Nikken v*

Pioneer, the Court of Appeal described two classes of amendment that would be unlikely to give rise to new objections, classes a) and b), and a third class, class c), that would. The Court of Appeal said that a patentee should normally be allowed to propose amendments of the type described by classes a) and b) but should not be allowed to do so in class c).

- 21 A problem with this approach has been highlighted by the present case. Even if the type of amendment being proposed by a patentee in revocation proceedings can be categorised as a “class a)” or a “class b)” amendment, i.e. where the court or comptroller does not anticipate any new arguments being raised by the applicant for revocation, it appears that it would still be possible for a third party to raise new objections in opposition proceedings after the proposed amendments had been advertised. Section 75(2) does not, prima facie, limit the grounds upon which a person can oppose a proposed amendment. So, if an opponent were to raise new prior art after trial as in the present case, how then can the court or comptroller prevent the further litigation which the Court of Appeal has said is to be avoided after the patentee has been allowed to propose amendments?
- 22 The statutory requirements concerning post grant amendment in infringement or revocation proceedings can be summarised as follows. Under section 75(1), the court or comptroller may allow the proprietor of the patent to amend the specification in such a manner as the court or comptroller sees fit. Rule 75 then requires the comptroller to advertise the proposed amendments for opposition. Section 75(2) says that any person may oppose an amendment proposed by the proprietor and that the court or comptroller shall consider the opposition in deciding whether the proposed amendment should be allowed. Section 75(5) says that the court or comptroller shall have regard to any relevant principles applicable under the EPC in allowing an amendment proposed by the proprietor.
- 23 In the cases before the Court of Appeal referred to above, the particular circumstances meant that the proprietor was not allowed to propose amendments to the patent and therefore the problem of further litigation was avoided at the outset.
- 24 However, had the patentee been allowed to propose amendments after trial as is the case here or even in the theoretical case of class b) in *Nikken v Pioneer*, and had a third party opposed the proposed amendments to the extent that further litigation appeared necessary, e.g. by citing new prior art, then how can the court or comptroller prevent the inevitable further litigation which the Court of Appeal has said should be avoided within the statutory requirements for dealing with oppositions under section 75? Or are the two requirements, i.e. from the Act and the Rules and from the Court of Appeal, incompatible in cases where new grounds for objection are filed in opposition?
- 25 ALL suggest that one way of avoiding this further litigation would be for the court or comptroller to decide the question of whether the proposed amendments are allowable on the basis of whether they overcome the issues identified in the validity proceedings (as well as meeting the requirements of section 76, i.e. they do not add matter and do not extend scope of protection). They contend that the comptroller should not take into consideration any other ground for opposition that would likely give rise to further litigation. As I have noted above, they submit that the “any relevant principles” specified in section 75(5) does not mean “all principles”, but rather only those principles which are relevant to the enquiry to hand. They make a

comparison with oppositions under section 27 where one of the tests for deciding whether post-grant amendments are allowable is to consider whether they have the effect of curing the defects that they seek to overcome, and suggest that the same consideration ought to be made in oppositions under section 75. MTL say that there is no single authority or single item of law to support this suggestion.

- 26 The situation in the present case is slightly different to the hypothetical one posed above in the sense that it is the applicant for revocation, who is already a party to proceedings, who opposes the amendment under section 75. MTL were aware of the conditional amendments submitted as part of revocation proceedings and had an opportunity to present arguments against them. MTL's arguments were taken into account when I decided that claim 2 of the conditional amendments could be saved from an attack on novelty and inventive step by clarifying the nature of the offset mast arrangement. On appeal, Mr Carr QC agreed that I was right to allow AIL an opportunity to clarify the nature of the offset mast arrangement by way of amendment under section 75.
- 27 MTL are right to say that they had not seen the precise form of the proposed claim at the time of the revocation proceedings. However, as Mr Carr QC recognised in his judgment, the nature of the amendments necessary to overcome my concerns on clarity would only give rise to limited opportunity for opposition. What I take from this is that it was not expected that an amended claim would be attacked for lack of novelty and/or inventive step with respect to twelve or so new pieces of prior art. The amendments being proposed now by AIL are not radically to the wording of the conditional amendments I considered in my decision, and I agree with AIL that this opposition by MTL, if allowed, would permit them to re-litigate a form of claim that was in substance the same one under attack in the revocation proceedings. The view of the Court of Appeal is that this should be avoided at all costs.
- 28 How then can further litigation be avoided while still meeting the requirements for opposition under section 75? AIL suggest that the court and comptroller should take a narrow view of what is meant by "any relevant principles" under section 75(5) and should allow amendments when they overcome any or all defects. AIL draw a comparison with amendments under section 27 where defects are voluntarily identified by the patentee after grant and amendments are proposed to overcome them. For amendments under section 75, the defects are normally identified in the course of revocation proceedings, and AIL say that the patentee should be allowed to propose amendments which overcome such defects without having to defend new claims of invalidity based on newly cited prior art.
- 29 This comparison with the general power to amend a patent after grant is an interesting one. The Manual of Patent Practice at paragraph 27.28 suggest that an opponent in section 27 proceedings must address himself solely to the allowability of the proposed amendments and may not attack the validity of the proposed amendment unless the amendment is sought to overcome an admitted defect casting doubt on the validity of the patent. The paragraph has a cross-reference to section 74(2), which states that:

s74(2). The validity of a patent may not be put in issue in any other proceedings and, in particular, no proceedings may be initiated (whether under this Act or otherwise) seeking only a declaration as to the validity or invalidity of a patent.

- 30 Section 74(1) sets out the proceedings in which validity of a patent may be put in issue. It does not specify proceedings under section 27 or section 75.
- 31 The relevance of section 74(2) to opposition proceedings under section 27 or section 75 was not addressed by the parties at hearing, so I invited further submissions on this specific point.
- 32 MTL accept that section 74(2) applies to proceedings under section 27 but argue that it has no application to proceedings under section 75. They say that the current amendment proceedings arise as a direct result of revocation proceedings under section 72 and that the amendments should be treated as forming part of these proceedings. They say that the very title of section 75 confirms this: "Amendment of patent in infringement or revocation proceedings".
- 33 ALL submit that there is no basis for distinguishing the effect of section 74(2) between proceedings under section 27 and proceedings section 75. They make an additional point that section 27(6) is written in identical terms to the wording of section 75(5), which was also added to ensure consistency with the new central amendment process for post-grant amendment of European patents under EPC2000, and suggest that this further supports their argument that what is true for section 27 proceedings must also true for section 75 proceedings, i.e. an opponent may only attack the validity of a proposed amendment in the context of whether it overcomes a known defect casting doubt on validity.
- 34 Dealing first with MTL's point about the relevant proceedings. Rule 76 of the Patents Rules makes clear that proceedings commence when a person files the relevant form and a statement of grounds. In the case of oppositions under section 75(2), the relevant form is Patents Form 15 and it must be filed within two weeks of the date on which the proposed amendment was advertised. For oppositions under section 27, the relevant form is again the Patents Form 15, but the deadline for filing it is four weeks from the date on which the proposed amendment was advertised. It is clear from this that if oppositions under section 27 are to be regarded as separate proceedings then so too must oppositions under section 75.
- 35 The question then remains of whether proceedings under section 75 fall within the wider ambit of section 72 proceedings such that section 74(2) does not apply. It seems to me that proceedings under section 75 are completely separate to the initial proceedings in which the validity of a patent has been put in issue: first of all, there is nothing in section 75 which states that a third party wishing to oppose an amendment as advertised by the Office becomes joined to the original proceedings, only that their opposition will be taken into account in deciding whether the amendment should be allowed; secondly, the Patents Rules clearly indicate that oppositions are to be treated as proceedings in their own right and have their own formal requirements for commencement; and finally, returning to the question of whether my initial decision was an interim decision or a final decision, it is necessary to note that in accordance with Office guidance my original decision in respect of the revocation proceedings should have been an interim decision pending resolution of the section 75 proceedings, so the wording was not merely an issue of semantics as suggested above.
- 36 With that being the case and taking all of the above into account, I believe that section 74(2) is equally applicable in section 75 proceedings as it is in section 27

proceedings and that it has the effect of limiting an opponent's ability to attack the validity of a proposed amendment beyond the known defect identified in the original proceedings. If I am wrong on this point, i.e. that opposition to amendments under section 75 are part of proceedings under section 72 and are not affected by section 74(2), then, as I have indicated above, the possibility exists for third parties to intervene with new grounds for opposition even in cases where the court or comptroller had not anticipated further litigation being likely, which the Court of Appeal has said should be avoided at all costs. In order to avoid this possibility, AIL suggest that the wording "any relevant principles" specified in section 75(5) should be interpreted to mean only those principles which are relevant to the enquiry to hand, i.e. whether the amendment overcomes the validity attack made upon the claim in the revocation proceedings, that the claim is clear and that it does not add subject matter.

- 37 I agree with AIL on this point: the discretion available to the court or comptroller to prevent a patentee from proposing amendments when further litigation appears likely does not avoid the possibility of further litigation by a third party opponent when amendments have already been proposed. If the only way of avoiding this further litigation is to refuse the patentee permission to amend in the first place then section 75 becomes redundant. Some other means is therefore necessary, and if that other means is not the limitation provided by section 74(2) then I consider it must be through the interpretation to section 75(5) proposed by AIL. Either way, the end result should be consistent with the very clear guidance from the Court of Appeal of avoiding further litigation and also with the comments of Mr Carr QC's on appeal, i.e. that the opportunity for re-litigation should be limited.
- 38 A final point worth noting is that MTL would be perfectly entitled to attack the validity of the patent on the basis of new prior art by commencing new revocation proceedings or as a defence in infringement proceedings. That would be a completely separate issue, for separate proceedings. MTL say that there is an obligation on the comptroller to deal with the case justly, to save expense and to ensure that the case is dealt with expeditiously, and that I should deal with all the substantive issues on validity currently before me rather than cause a yet further delay and the extra cost involved in the commencement of further proceedings. I agree with this, but the opportunity for dealing with all of the new substantive issues on validity was in the initial validity proceedings and not in these proceedings on amendment. I believe this to be consistent with the principle in *Henderson v Henderson* [1843] 3 Hare 100 that in the interests of finality of litigation the parties should bring forward their whole case at the outset, and that a party should not be twice vexed in the same matter. MTL say that the new prior art is being raised in response to the new amended version of the claim. However, the substance of the claim is no different from that which was in issue in the revocation proceedings save for some minor changes to overcome the deficiencies identified in my original decision, so MTL could have raised the new prior art in order to attack validity before now if they wanted to. It remains to be decided whether the proposed changes do have the effect of overcoming the deficiencies identified in my original decision, which I believe is the full extent of the remaining enquiry before me in the these amendment proceedings.

Conclusion

- 39 I have found that MTL's opposition to amendments proposed by AIL under section 75 must be limited to the questions of whether the amendments overcome the defects identified in the original revocation proceedings and meet the requirements of sections 76. All other grounds for opposition set out in their statement of case will be struck out on the basis that they are an abuse of the opposition process.

Costs

- 40 AIL have said that they will address the question of costs once a finding on the merits of their case for strike out has been made. I will give parties a period of four weeks from the date of this decision to make written submission on the issue of costs.

Appeal

- 41 Any appeal must be lodged within 28 days.

H Jones

Deputy Director acting for the Comptroller