

PATENTS ACT 1977

IN THE MATTER OF

an application by Contra Vision Limited
to amend Patent Number GB 2165292 C
and an opposition thereto by Clear Focus Imaging Inc

DECISION

Introduction

1. Patent Number GB 2165292 C ("the UK patent") was filed under the Patents Act 1977 ("the Act") on 24 July 1985 claiming earlier priority dates of 28 July 1984 and 19 February 1985, and was granted on 25 May 1988 to Contra Vision Limited ("Contra Vision"). Two applications by Contra Vision under section 117 for correction of errors in the patent specification were allowed on 17 January 1991 and 29 October 1997 respectively. On 2 December 1996 Contra Vision filed a request under section 27(1) to amend the specification of the UK patent. Following preliminary consideration by the Patent Office, the amendments were advertised in the *Patents and Designs Journal* of 21 May 1997.

2. On 17 July 1997 notice of opposition to the application to amend was given under section 27(5) by Avery Dennison Corporation ("Avery") and followed on 29 August 1997 by a statement of grounds; on 18 July 1997 notice of opposition under section 27(5) was given by Clear Focus Imaging Inc ("Clear Focus") and followed on 31 July 1997 by its statement of grounds. On 4 November 1997 Contra Vision filed a counterstatement which was superseded by an amended counterstatement filed on 7 May 1998. In a letter dated 22 December 1997 Avery unequivocally withdrew its opposition, a letter from Contra Vision explaining that this was because Avery had agreed to take a licence under the patent. Both parties requested that no award of costs be made in respect of the opposition by Avery, and Avery's opposition was therefore treated by the Office as withdrawn leaving no matters outstanding.

3. Of course Clear Focus's opposition remained, and that matter came before me at a hearing

on 12 July 1999 at which Mr Colin Birss, instructed by patent agents Wilson Gunn M'Caw, appeared as Counsel for Contra Vision, and Mr Alan Burrington of Alan Burrington & Associates appeared as agent for Clear Focus.

Evidence

4. Evidence in this matter was filed on behalf of Contra Vision on 2 December 1996, 24 January 1997, 11 November 1997 and 7 May 1998 in the form of four affidavits by Mr George Roland Hill, chairman and managing director of Contra Vision; and on 2 December 1996 in the form of an affidavit by Mr Peter John Low, a partner in the firm of Wilson, Gunn, M'Caw. Evidence was filed on behalf of Clear Focus on 6 August 1998 in the form of a statutory declaration by Professor John Roland Crookall, Professor Emeritus of Manufacturing, Cranfield University.

5. Mr Burrington sought at the hearing and with no prior warning to have admitted in evidence a document which he understood to be concerned with the latest step in proceedings in the US Patent and Trademark Office ("USPTO") concerning US Patent No 4673609 ("the US patent"), the US equivalent of the UK patent. He argued that since Contra Vision refers in its evidence to parallel proceedings in the United States, then either the evidence on those proceedings should be brought right up to date or any references in Contra Vision's case concerning those US proceedings should be struck out. Mr Birss argued that the document should not be admitted on the grounds that it is both too late and of at best peripheral relevance.

6. I concluded at the hearing that since the matter I am being called upon to consider is the allowability of amendments to the UK patent under UK law, evidence on proceedings in the United States would be unlikely to be determinative, and that in consequence the significance of the document was unlikely to be such as to justify its admission at such a very late stage. I therefore refused to admit it. I also decided not to strike out any material already put in by Contra Vision in relation to the position in the United States, noting that such evidence was likely to be informative rather than determinative since my decision in the present case will not turn on the situation in the United States.

The Legal Basis for the Application to Amend

7. As noted above the request for amendment was originally filed under section 27, and was opposed under the relevant provisions of that same section. However, on 18 July 1997 Clear Focus applied to the comptroller under section 71(1) for a declaration of non-infringement of the UK patent. Thus, although it was not the case when the application to amend was lodged, it is now the position that concurrent with the present amendment proceedings are further proceedings under section 71 in which the validity of the patent may be put in issue. Section 27(2) of the Act reads:

"(2) No such amendment shall be allowed under this section where there are pending before the court or the comptroller proceedings in which the validity of the patent may be put in issue."

8. Both parties, Contra Vision and Clear Focus, indicated in correspondence a preference for the amendment proceedings to be determined before those under section 71, but in doing so neither party addressed the relevance of section 27(2). In a letter of 22 September 1998 the Office drew the parties' attention to section 27(2) and invited their views on its meaning and effect in the present circumstances. Both parties' responses were considered in a further official letter of 6 January 1999 which, in respect of this question, concluded:

"As the proprietor has noted, there is little case law in relation to section 27(2). However, paragraph 27.09 of *The CIPA Guide to the Patents Acts* refers to the case of *Wilkinson Sword v Warner-Lambert* (unreported, SRIS C/124/87) in which a stay of court proceedings under sections 71 and 72 pending resolution by the comptroller of section 27 proceedings was refused by the court, which also indicated that the amendment proceedings should be recommenced before the court under section 75. While the circumstances of that case are not identical with the present ones, the degree of similarity makes it relevant for consideration, and in the Office's preliminary view lends some support to the adoption of the proprietor's alternative suggestion of converting the present section 27 proceedings to proceedings under section 75.

The Office therefore proposes that as suggested by the proprietor, the proceedings under section 27 be converted to proceedings under section 75. No further forms will be required to do this, merely the parties' agreement to the proposal. Both parties are therefore invited to indicate their agreement or disagreement with this proposal.”

Both parties did agree in writing to this procedure, which satisfies their wish to have these amendment proceedings determined ahead of the application under section 71(1) rather than stayed pending resolution of it.

9. At the hearing Mr Birss noted that whereas section 27 provides a free-standing power to amend, section 75 does not; the power to amend under section 75 arises from pending proceedings, and therefore the amendment issue, if it is now to find a basis under section 75, has to be regarded as a preliminary issue to the section 71 proceedings. The point was, however, not fully argued before me, and as I understood Mr Birss he was not making an issue of it; he remained content for the section 27 proceedings to be converted to proceedings under section 75. I do not therefore propose to consider the point further, nor do I believe, and I understood Mr Birss to take the same view, that it materially affects the approach that I should take in considering the request for amendment.

The Law on Discretion

10. Mr Birss also raised the question of the comptroller's discretion under section 75. Section 75(1) reads as follows (my emphasis added):

“**75.-** (1) In any proceedings before the court or the comptroller in which the validity of a patent is 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.”

It is perhaps worth noting that section 27(1) uses similar language, in that it says “... the comptroller *may* ...allow the specification of the patent to be amended subject to such conditions,

if any, as he thinks fit". The use of the word "may" in both sections has been taken to mean that the comptroller has a discretion, which may be favourably exercised or withheld, in relation to an application to amend.

11. In this context Mr Birss referred me to the judgment of Laddie J in *Kimberly-Clark Worldwide Inc v Procter & Gamble Limited and the Procter & Gamble Company* (6 July 1999). The nub of Mr Birss's submission at the hearing, made having heard the oral judgment but before having the final written text to hand, was that this judgment held that there was no such discretion under the Act. However, Mr Birss went on to say that *Kimberly-Clark* was under appeal and to acknowledge that the then still binding authority was the Court of Appeal's judgment in *Hsiung's Patent* [1992] RPC 497, which upheld the existence of a discretion. Mr Birss then suggested that I might decide the present case both on the basis that the comptroller does have discretion and on the basis that she does not.

12. I was at the time of the hearing not persuaded that I had any alternative other than to follow the superior authority and exercise the comptroller's discretion consistent with the manner approved in *Hsiung*. Nonetheless, it was my declared intention at the hearing to allow the parties to make written submissions to me on the relevance to the case in hand of Laddie J's judgment in *Kimberly-Clark*. However, since the hearing the Court of Appeal has in a judgment dated 24 November 1999 allowed the appeal in *Kimberly-Clark* and reaffirmed the place of discretionary factors in amendment proceedings under section 75. Accordingly, I believe that there is not now any reason to invite any fresh submissions on this point, and that I can proceed in the present case on the basis of a clear position on this question of discretion.

The UK Patent

13. The UK patent relates to a transparent or translucent panel bearing a design superimposed on or forming part of a so-called "silhouette pattern", such that from one side of the panel the design is visible and from the other side it is not. According to page 6 of the corrected specification, "the term "silhouette pattern" as used herein is intended to mean any arrangement of opaque material which subdivides the panel into a plurality of opaque areas and/or a plurality of transparent or translucent areas". The pattern may for example comprise a uniform pattern of

dark dots applied to one surface of the panel, with the free surfaces of the dots carrying different coloured inks which together form a design. Viewing from the inked side an observer will see the design; viewing from the other side the observer will just see the dark surfaces of all the dots, the inked design being obscured thereby (although these effects may be dependent on the relative levels of illumination of the two sides). Many variations and corresponding methods of manufacture are described in the description of sixty-three pages with reference to twenty pages of drawings. The invention may be used to provide one way vision, that is to obstruct vision from the side from which the design is visible and to provide clear vision from the other, and finds many applications, including privacy or security glazing for buildings, screens for sporting events and advertising glazing for commercial vehicles.

14. The unamended specification contains sixty-five claims. Independent claims 1 and 2 read:

“1. A panel comprising a colourless or light coloured transparent or translucent material and a design visible from one side of the panel and not visible from the other side of the panel, said design being superimposed on or forming part of a silhouette pattern (as herein defined).

2. A panel comprising a colourless or light coloured transparent or translucent material having a first design visible from one side of the panel and not visible from the other side of the panel, and a second design visible from other side of the panel and not visible from the said one side of the panel each design being superimposed on or forming part of a silhouette pattern (as herein defined).”

15. Claims 3 to 39 are also directed to a panel and are dependent on one or both of these claims. Claim 40 is to “a glazing assembly comprising two panels as claimed in any preceding claim”, and to which claims 41 to 53 also to an assembly are appendant. Claims 54 (to which claim 55 is appended), 56, 57, 58 (to which claims 59 to 61 are appended), 62 and 63 are each directed to a different “method of producing a panel or panel assembly” as claimed in any of claims 1 to 53. Claims 64 and 65 are independent panel and method claims respectively in the omnibus form.

The Proposed Amendments

16. The request is extensive, as is well summarised in exhibit GRH6. It comprises amendments to claims 1, 3, 5, and 6 of the granted claims, and the introduction of new claims 66 to 239 which would result in a total of sixty-eight independent claims. Consequential amendments to the description are also requested.

17. The reasons given on Form 11/77 for the requested amendments are as follows:

- "1. Two prior art specifications viz:
US Patent No. 4358488 Dunklin
Japanese Utility Model 51-86049 Giken
2. Amendments consequential on amendments made in respect of the prior art listed in 1.
3. Amendments to read more closely onto products of competitors.
4. Amendments to provide a position against prior art alleged to exist and be relevant, but not disclosed to the Patentee."

Background to the Amendment Request

18. The background to the request is set out by Mr Hill in his first affidavit. He describes the history of Contra Vision and associated companies, and lists in exhibit GRH1 Contra Vision's patents worldwide relating or corresponding to the UK patent, including the US patent. In 1993 the US arm of Contra Vision terminated the licence of a US corporation under the US patent for non-payment of royalties. The defendant countersued on many counts, one of which was invalidity of the US patent, and instigated re-examination of it in the USPTO citing certain prior art listed in paragraph 7 of Mr Hill's first affidavit. Mr Hill also took the opportunity afforded by the re-examination process to amend the claims to direct some of them more specifically to

certain embodiments and to put before the USPTO additional prior art of which he was then aware. In response to objections made by the USPTO examiner, amendments to the US patent were eventually agreed, and published in a Reexamination Certificate which is exhibited at GRH4. These amendments include the incorporation into claim 1 of the US patent of the following passage:

"and wherein a principal perceived image when viewing said panel changes from said design to a space on said other side when the illumination is altered from relative light on the one side and relative dark on the other side to relative light on the other side and relative dark on the one side".

19. Mr Hill makes clear that although he did amend claim 1 of the US patent to include this wording which the USPTO examiner found acceptable, he did not believe that the claim was not already distinguished from the prior art by virtue of the following passage:

"and wherein said design is decreasingly perceptible from the side of the panel from which said design is normally visible as the level of illumination through the panel from the other side increases".

20. Mr Hill goes on to say that towards the end of 1994 or early in 1995 he was advised by his UK patent agent that amendment of the UK patent should be considered in the light of the re-examination of the US patent, and accordingly the requested amendments include incorporating into claim 1 the passage quoted in paragraph 18 above.

21. Mr Hill discusses at some length prior art that has come to light over the years and from various sources, and in exhibit GRH5 (as corrected at GRH7 to his second affidavit) provides a very extensive list of some 150 references. In paragraphs 15 to 18 of his first affidavit he describes the circumstances under which he became aware of the two particular documents referred to in the present request to amend, namely US Patent No 4358488 ("Dunklin") and Japanese Utility Model No 51-86049 ("Giken"). Dunklin was originally referred by the requester for the US re-examination to Contra Vision's US attorney in September 1994, was not considered necessary by that attorney to be referred to the USPTO, but was subsequently (in February 1995)

referred to the USPTO by a second US attorney appointed in November 1994 to replace the first. Giken was brought to Mr Hill's attention on 26 October 1995 by the 3M Company, a licensee under the US and other corresponding patents. Mr Hill states in paragraph 18 of his first affidavit that "the Dunklin and Giken references on their own or in conjunction with other references, do seem to me to be relevant to granted claim 1 of the '292 [UK] patent and make amendment of the '292 patent desirable, in my opinion and that of my UK patent agent, Peter Low".

22. Finally Mr Hill refers to the wish to amend having regard to prior art alleged to exist by certain US companies trading internationally, but which such companies are not prepared to disclose to him, and also to amend to read more closely onto certain competitors' products which he believes are on the market. Exhibit GRH6 tabulates the requested amendments to the claims and the reasons for each. Mr Low provides confirmation in his affidavit of much of Mr Hill's evidence.

Opposition by Clear Focus

23. The grounds of opposition to the proposed amendments set out in Clear Focus's statement of 31 July 1997 are variously: (a) that the amendments to the claims introduce new subject matter; (b) that the amendments do not cure the defects stated by the proprietor; (c) that the reasons given for the amendments are unclear; and (d) that because of Contra Vision's behaviour, specifically that it has not acted in good faith, the comptroller's discretion should not be exercised in favour of allowing the requested amendments.

24. At the hearing Mr Burrington concentrated his submissions almost entirely on the request to amend claim 1, and left the statement by Clear Focus to set out its case against the other proposed amendments. I shall therefore begin by considering the proposed amendment of claim 1 before moving on to the other aspects of Clear Focus's opposition.

Claim 1

25. Mr Burrington focussed his attack on the proposed introduction into claim 1 of the

following passage (hereafter “the proposed passage”):

“and wherein a principal perceived image when viewing said panel changes from said design to a space on said other side when the illumination is altered from relative light on the one side and relative dark on the other side to relative light on the other side and relative dark on the one side.”

He inferred from paragraph 10 of Mr Hill’s first affidavit and from paragraph 2 of Mr Hill’s fourth affidavit that Contra Vision views the proposed passage as the key feature which distinguishes the invention from the prior art.

26. Mr Burrington noted that the final sentence of paragraph 6 of the amended counterstatement promises to show “that the amendment proposed [to claim 1] is an effective limitation to the claim and clearly distinguishes over all available prior art” but that paragraph 2 of Mr Hill’s fourth affidavit, which purports to provide the required support, contains no more than a bare assertion by Mr Hill that the proposed amendment is a technical feature which imposes a limitation on the claim.

27. Mr Burrington turned to the evidence of Professor Crookall, in which the effect that various illumination levels have on the balance of reflected and transmitted light is discussed with reference to a number of general examples and then with reference to the UK patent in particular. In paragraph 15 of his statutory declaration Professor Crookall opines that the proposed passage does not introduce any structural limitation to the panels. In paragraph 17, he concludes that “the choice of the phrase ‘principal perceived image’ does not impart any substantive limitation on the construction of the panel because that phrase simply describes the optical phenomenon which inevitably occurs with this kind of product when the illumination levels on either side of the panel are changed relatively to one another”. In paragraphs 19 and 20 Professor Crookall also concludes that the proposed passage describes the inevitable operating characteristics of the arrangement disclosed in Dunklin. Mr Burrington asserted that it is clear from Professor Crookall’s evidence that the proposed passage, and especially the phrase “principal perceived image”, is a mere turn of phrase which appears to have been concocted by Contra Vision to describe what is an optical visual phenomenon or effect well known before the priority date of

the invention.

28. Drawing together these points, Mr Burrington concluded that the proposed passage introduces no limitation to the scope of claim 1 and does not therefore cure the stated defect, that is it does not distinguish the claim from the prior art. In passing, he noted that claim 193 contained a passage similar to the proposed passage and was therefore open to the same objection. Finally, he submitted that if the proposed passage were the key distinguishing feature, then it should be in all of the independent claims, and since it is not then these claims should also be refused.

29. On the last point, Mr Birss argued that although the proposed passage was not an unimportant feature, in none of the quoted paragraphs does Mr Hill say that it is a “key feature”; he says that it distinguishes, but not that its presence is necessary to make every claim inventive. In consequence Mr Birss held that there is no support for the argument that all the independent claims should be so amended. Having considered the totality and context of Mr Hill’s evidence, I find myself in agreement with Mr Birss on this point. Mr Hill clearly says that the proposed passage distinguishes claim 1 from the prior art, but does not state that this is the only feature in the claims to do so. Indeed, it might be strange if he did, given that the proposed passage is the same as the passage (quoted in paragraph 18 above) which was introduced into the admittedly different claim 1 of the US patent with Mr Hill asserting it was not necessary. I would also add that since the provisions of section 26 preclude objection to a patent or an amendment of a patent on the grounds that the claims relate to more than one inventive concept, it seems that no objection lies in the mere fact that different claims might be differently distinguished from the prior art.

30. Mr Birss went on to argue that a large proportion of Professor Crookall’s evidence was inadmissible because it is no more than his opinion on the meaning of ordinary English words. In addition he asserted there was a straightforward conflict of evidence between two witnesses, Professor Crookall and Mr Hill, which, in the absence of cross-examination of the two, cannot be resolved, and it would not be right to refuse the amendment in such circumstances. If I understood him correctly, however, Mr Birss agreed that failure to cure invalidity would be a reason for refusal, as indeed it would. On whether or not the proposed passage is capable of

distinguishing some panels from others, Mr Birss gave an example, namely a pane of glass painted black with tiny holes in the paint, of what he felt was a panel construction which met the original claim 1 but not claim 1 as proposed to be amended.

31. Turning first to the evidence of Professor Crookall, I find myself in disagreement with Mr Birss that this evidence is largely inadmissible because it is no more than his opinion on the meaning of ordinary English words. It seems to me that Professor Crookall has taken pains to describe certain well known optical phenomena and to compare them with the particular circumstances of the present case. In so doing he has had to interpret the meaning of patent claims, and it is inevitable that in the process he will have had to interpret individual words and phrases, but in my view in no sense can his evidence taken as a whole be described as being mere interpretation of ordinary words. Nor do I subscribe to Mr Birss's view that I am faced by a wholly irreconcilable conflict of evidence. Having carefully considered all of the evidence and submissions from both parties, I find myself in agreement with Professor Crookall in his conclusion that the proposed passage or "phrase simply describes the optical phenomenon which inevitably occurs with this kind of product when the illumination levels on either side of the panel are changed relatively to one another". However, it seems to me that the further conclusion that Professor Crookall draws from this, namely that the choice of the phrase 'principal perceived image' does not impart any substantive limitation on the construction of the panel, does not inevitably follow. Instead I believe Mr Hill in paragraph 2 of his fourth affidavit is right that the proposed passage "recites the effects which will occur in the panel of the invention under specified operating conditions and therefore ... represents a technical feature which imposes a limitation on the claim", and that "... either a structure is able to satisfy this feature or it is not". I am therefore at one with Mr Birss and Mr Hill that there will be panel constructions that meet the terms of the unamended claim 1 but do not meet the terms of claim 1 amended as proposed. I conclude therefore that the proposed passage, although describing a well known optical phenomenon, does effectively add a limitation to the scope of claim 1 (and that the similar phrase used in claim 193 also provides an effective limitation).

32. To be allowable the proposed amendment to claim 1 must not add new subject matter, that is it must find support in the original specification. In raising an objection on these grounds, Clear Focus in its statement of 31 July 1997 submits that the amendment to claim 1 "is either substantive and has no basis in the specification as originally filed or is simply a statement of the

visual effect which would inevitably occur under certain operating conditions and therefore does not constitute any effective limitation to the claim". This, it seems to me, is an attempt to have it both ways. Having already concluded, on the basis among other things of Professor Crookall's evidence put in by Clear Focus itself, that the proposed passage describes a known visual effect that would inevitably occur when working the claimed panel under certain operating conditions, it seems to me that it must follow that Clear Focus's objection on the grounds of lack of support or added subject matter cannot be sustained.

33. To be allowable, the proposed amendment must also cure the stated defect, that is it needs to add to claim 1 a feature which distinguishes it from Dunklin and Giken. Clear Focus argues that the amendment does not cure the defect because it does not effectively limit the claim; this is an objection I have already dismissed. Perhaps rather surprisingly neither Mr Burrington, who was alleging that claim 1 as proposed to be amended was not inventively distinguished over the prior art, nor Mr Birss for Contra Vision whose reasons for seeking amendment cite the two prior art specifications, referred to the technical content of Dunklin and Giken, so I find no assistance there. Professor Crookall in paragraphs 19 and 20 of his statutory declaration provides a theoretical analysis of the operation of the screen described in Dunklin, giving consideration to the different effects that in his view would result under daylight conditions and at night-time. He concludes that the Dunklin screen would inevitably exhibit the effect described in the proposed passage. He offers no opinion on Giken. Mr Hill in paragraph 2 of his fourth affidavit makes the bald statement that "I do not believe that the feature [described in the proposed passage] ..is disclosed in any of the prior art".

34. Looking first at Dunklin, there is shown a panel in which a principal perceived image when viewing said panel changes from a design (30) to a space on the other side of the panel when the illumination is altered from relative light on the one side and relative dark on the other side to relative light on the other side and relative dark on the one side. Turning to Giken, there is shown a panel in which a principal perceived image when viewing said panel changes from a design (colour patterns which can be applied to the luminous body (4)) to a space on the other side of the panel when the illumination is altered from relative light on the one side and relative dark on the other side to relative light on the other side and relative dark on the one side. On this basis, both pieces of prior art can be said to contain the feature it is proposed to import into claim

1. It seems to me that the onus is on Contra Vision to demonstrate that the proposed amendment cures the stated defect, that is that the introduction of the proposed passage into claim 1 serves to distinguish it from Dunklin and Giken. In the light of all the evidence and submissions from both parties, I am not persuaded that they have discharged that onus. I do not therefore find myself in a position to conclude that the proposed amendment to claim 1 (and claim 193) does cure the stated defect.

35. To summarise then, I have found that the proposed passage effectively adds a limitation to the scope of claim 1 (and claim 193), finds a basis in the description and does not therefore introduce new subject matter, but does not cure the stated defect. On this last count, it is therefore not allowable.

36. This substantially ended Mr Burrington's oral submissions, so I now fall back on Contra Vision's statement for its case.

Perforate Structures (Claims 95, 126, 132 and 134)

37. I turn next to the submission by Clear Focus in its statement of 31 July 1997 that nowhere in the specification as originally filed is it suggested that the panel could be anything other than an imperforate structure, and that in consequence any of the proposed claims, and in particular claims 95, 126, 132 and 134, insofar as they could be interpreted to cover a panel having a perforate structure, introduce added matter and should be refused. Mr Burrington referred to this submission at the hearing but without developing it beyond stating that "there is absolutely nothing in this patent specification as originally filed which would give a basis for a claim which covers perforate".

38. It seems to me that on the question of added subject matter and contravention of section 76, the onus originally lay with Clear Focus to identify where it felt that section 76 had been contravened. This has been done in the context of perforate structures, especially but not exclusively by specific reference to the proposed claims 95, 126, 132 and 134. In my view the onus then shifted to Contra Vision to demonstrate that the proposed amendments, again especially but not exclusively with respect to those particular claims, would not introduce added

matter. In this regard Mr Birss referred me to the panels shown in figures 1, 2 and 3 of the UK patent, pointing out that each panel comprises a sheet (10) carrying a pattern, and whilst the sheet may properly be described as imperforate, the blobs of material and the holes between the blobs, which together make up the pattern, constitute a perforate structure. With respect, I have to say that in my view this stretches the ambit of the term “perforate structure” beyond its reasonable limits. It is akin to saying that paint that has been daubed in a series of crossed lines on a sheet of paper constitutes a “perforate structure”. Mr Birss’s submission is in my judgment untenable.

39. I have to say that I did not find the generality of the submissions made at the hearing particularly helpful in considering whether or not the detailed structures set out in the specified claims, for example, do indeed introduce new matter; and none of the evidence appears to address the matter. The question is far from straightforward given the length and complexity of the specification of the UK patent. Nonetheless, unguided as I am by submissions, I must venture into the specification if I am to reach a view on whether Contra Vision has discharged or not the onus placed upon it.

40. Reading the unamended specification, it seems to me there are very few references to any form of structure which might reasonably be called “perforate”. On page 15 there is a reference to a perforated stencil, but that stencil is removed in making the panel, so that the completed panel cannot be said to have this perforated element in it. Likewise, on page 22 there is a reference to a stencil which may be a perforated film, but again the stencil is not part of the finished panel. Page 26 of the UK patent talks of a “cut film”, but that is not I think a basis for a reference to a perforated one. On page 27 there is such a reference, this time to a “perforated membrane”. On that page it is said that the holes may be formed after printing or otherwise applying the required design, or the required design may be produced after the holes have been formed. Such patterned perforated sheets or membranes may then be formed within, attached to or be independent of transparent sheet or film materials. Finally, page 37 of the patent specification speaks of the silhouette pattern being punched, drilled or otherwise cut into the material, and includes a reference to “holes”.

41. Turning to the proposed amendments, claim 95 appears to relate to the method of manufacture shown in figure 19 and described at page 50, line 16 to page 51, line 5 (the passages

at page 17, lines 3 to 19 and page 18, line 15 to page 19, line 4 may also be relevant). It seems to me that it is questionable whether claim 95 finds support from these passages insofar as it requires a perforated carrying member. Claims 126, 132 and 134 appear to relate to the method of manufacture shown in figure 25 and described at page 54, line 12 to page 55, line 4 (the passage at page 26, line 17 to page 27, line 12 may also be relevant). Again, it seems to me that it is questionable whether claims 126 and 134 find support insofar as they require the protective film layer to be perforated. Claim 132, however, which requires a material layer to be perforated before application of a design, arguably finds support from the passage at page 27, lines 2 to 12, which refers at page 27, line 4 to a “perforated membrane” and at page 27, lines 9 and 10 states that “the required design may be produced after the holes have been formed”.

42. In the light of this reading of the unamended patent and the proposed amendments to it, I do not believe I can conclude that Contra Vision has discharged the onus placed on it to demonstrate that the proposed amendments which relate to perforated structures, at least so far they relate to claims 95, 126, and 134, do not contravene section 76. In consequence, I feel unable to allow these to be made.

Request Unclear

43. I turn next to the submission by Clear Focus in its statement that the request to amend "to provide a position against prior art alleged to exist and be relevant, but not disclosed to the Patentee" is not clear. This is, Clear Focus says in its statement, firstly because if the Patentee does not know what the prior art is then it follows that amendments cannot be framed in order to distinguish from that prior art, and secondly because the use of the word “position” is not clear.

44. These issues were not developed at the hearing by Mr Burrington, but it seems to me that the first point is largely answered by the letter exhibited as GRH1 by Mr Hill with his fourth affidavit, to which Mr Birss fleetingly referred me. This is a letter dated 25 March 1997 from Clear Focus to Contra Vision's US attorneys. It states that “.. there are a number of outstanding issues between Contra Vision and Clear Focus. We have been advised by our patent attorneys not to provide you with any more prior art with respect to Contra Vision's '609 patent”, that is, the US patent equivalent to the UK patent. This it seems to me, whilst having the inevitable

consequence of causing Contra Vision to operate in the dark, does provide them with a valid reason to reconsider what they are claiming. While it may be questionable how far Contra Vision can justify each and every amendment on this ground, it is an understandable reason for at least some of their motivation for seeking amendment. The second point, based as it is on Clear Focus's alleged difficulty in understanding the word "position", appears to me to be trivial and without substance. I do not therefore find any reason here to refuse the request.

Contra Vision's Behaviour and the Comptroller's Discretion

45. I turn now to the submission by Clear Focus in its statement that the comptroller's discretion should not be exercised in allowing any of the requested amendments because Contra Vision "is acting in bad faith". On the question of "bad faith", Clear Focus submits that Mr Hill has been warning at least some customers of Clear Focus that their products infringe the UK patent, which it argues is inconsistent with the present request to amend "to read more closely onto products of competitors"; either the unamended claims are being infringed and these amendments are unnecessary, or the amendments are necessary in order to substantiate infringement in which case past allegations of infringement have no basis.

46. The particular point at issue here was again not developed at the hearing by either side. However, it seems to me that it is perfectly possible, speaking purely hypothetically, for certain products to infringe the UK patent and at the same time for amendment to be necessary or desirable. In addition, in relation to the general question of discretion, no reason has been advanced to dispute, or cast doubt in my mind over, the extensive history provided by Mr Hill and summarised earlier in this decision. I am therefore not persuaded that there is any reason here for withholding the exercise of the comptroller's discretion.

Prolixity

47. Before moving on to the withdrawn opposition by Avery, I feel obliged to consider the issue of prolixity of claims, or to put it more straightforwardly - are there too many claims? It is established practice that amendments to a patent, be they under section 75 or section 27, as well as having to meet the requirements of section 76 which is specifically referred to in those

sections, must not introduce, plurality of invention apart, any other objection of substance, such as non-compliance with section 14(5). The requirement of section 14(5)(b) that the claims shall be concise refers to the claims in their entirety as well as to the individual claims. The number of claims must of course be considered in relation to the nature of the invention being protected. In view of this requirement of section 14(5)(b) that the claim or claims shall “be clear and concise” I raised the matter of prolixity of claims at the hearing.

48. Mr Birss admitted that the present request was unusual, and that he was not aware of a series of amendments to a patent quite as extensive as this one. He conceded that 239 is an awful lot of claims. His view was though that if prolixity caused confusion and thereby disadvantaged the public then that would indeed be a reason for refusing the amendments, but if it were merely a question of the time and effort it took the reader to come to grips with the claims then that was not a reason for refusal. He argued that in the present case, although there was “an awful lot of repetition of wording”, this was for good reason because it is the way in which the claims have been structured.

49. As I have already noted, the request for amendment is in anyone’s terms extensive. Mr Hill acknowledges that in paragraph 21 of his first affidavit, and explains the reasons why it is so. Aside from the amendments to existing claims 1, 3, 5, and 6, the request involves the introduction of new claims 66 to 239 which would result in a total of sixty-eight independent claims. Consequential amendments to the description are also requested. As Mr Birss said there is indeed a great deal of repetition here, to the extent that there is a total of 51 pages of claims in the request. I think there is some substance in Mr Birss’s point that prolixity causing confusion is more sinful than prolixity wasting time, although there is no such distinction made in section 14. However, in the present case I am not persuaded that the sheer number of independent claims, and indeed dependent ones, can be other than confusing. Even if it were not, it seems to me that the question of the time required to analyse the claims becomes an issue of consequence when it exceeds a certain level, and when there is an alternative, more straightforward way of claiming the invention or inventions. I am not persuaded that there is no alternative here. Equally, the argument that this amount of repetition is a consequence of the way the claims have been structured is, it seems to me, a tautology rather than a justification; the choice of claim structure as set out in the proposed amendments is not inevitable, it lies with Contra Vision.

50. For these reasons I am not persuaded that the prolixity inherent in this request for amendment is tolerable. Although the choice of wording of a patent's claims is the proprietor's own, that choice is not unfettered, and section 14(5)(b) demands reasonable conciseness. It cannot be in the public interest that a request for amendment whose principal ground is to distinguish from two prior disclosures should result in the total number of claims rising four fold and the number of independent claims rising to sixty-eight. I believe I would not be serving that public interest were I, other considerations or objections aside, to allow such claim inflation to pass. On this ground I feel obliged to refuse the request for amendment as a whole.

Opposition by Avery

51. The grounds of opposition set out in the statement of 29 August 1997 by Avery are (A) that the favourable exercise of the comptroller's discretion should be refused, (B) that the amendments to the claims are not adequate to remove the defect, that is they do not distinguish the claims over the prior art, (C) that certain of the amendments do not meet the requirements of section 76, and (D) that certain of the amended claims are not clear and concise.

52. As noted above Avery has withdrawn its opposition and taken a licence under the patent. As I pointed out at the hearing, were it not for the continuing action by the second opponent, Clear Focus, then the comptroller's normal practice would, in the public interest, have been to consider the matters brought forward in the first opposition. Mr Birss argued that Avery's taking a licence is an indication that that is preferable to opposing the amendments. In respect of the voluminous prior art introduced by Avery, he submitted that it would be futile and unnecessary to go through all the prior art citations and effectively re-examine 239 claims. In this regard, he drew my attention to *Minister of Agriculture's Patent* [1990] RPC 61 and in particular to headnote (1) which reads as follows:

“(1) The validity of the claims as proposed to be amended could be contested but only on the grounds of lack of novelty or inventive step over the two publications cited by the proprietor as matter from which the invention was to be distinguished. The attack on validity could not be bolstered by introducing further documents ..”

The headnote relates to a decision by the comptroller under section 27, which was upheld on appeal to the Patents Court. On page 64 of the decision, the judgment of Whitford J in *Great Lakes Carbon Corp's Patent* [1971] RPC 117 is quoted as follows:

“I think it would be lamentable if the procedure [for opposing amendment] ... were to be allowed to develop into the sort of roving enquiry which the opponent seeks to conduct in this case. If they are right on the issue of validity they could no doubt have .. sought to revoke it ...”

53. I can see no justification for not following this line, albeit that the present case is now proceeding under section 75, and to this extent I agree with Mr Birss that proceedings such as these should not be allowed to develop into a roving enquiry on validity. However, Mr Burrington raised the equally valid opposite position at the hearing in the form of a question, namely: “why did the patentees feel it necessary to burden us all with long lists of prior art if it was not intended that they should be looked at at all?” His formulation of the question reflects the significant fact that the extensive lists of prior art were put in evidence in these proceedings by Contra Vision itself, not by Avery. It is therefore surely implicit in Contra Vision’s position that the proposed amendments are intended to distinguish the claims over that prior art too, and not just Dunklin and Giken. It therefore seems to me that I should steer a middle course between eschewing a roving enquiry and ignoring entirely the prior art put in by Contra Vision itself.

54. At the hearing, Mr Birss did deal briefly with certain of the prior art raised by Avery and put in evidence by Mr Hill, especially US Patent No 3451877 (“Herschman”) and Japanese Utility Model No 1982-14101 (“Morimoto”), and I noted what seemed to me to be the particular *prima facie* relevance of Morimoto. Of Morimoto, Mr Birss said that it is extremely confused and difficult to follow, but does not disclose a design which is not visible from the other side of the panel. Contra Vision therefore regarded claim 1 as granted as being sufficiently distinct from Morimoto as to be patentable. Neither, added Mr Birss, does Morimoto have the feature of the proposed passage of the requested amendment. Although I have considered those submissions very carefully, and agree that Morimoto is not the easiest specification to construe, they do not it seems to me take proper account of the disclosure of Morimoto. Giving the specification a careful reading, it can be seen to disclose a see-through substrate (2) which carries coloured portions (6) comprising dark coloured layers (3) and light coloured layers (4), leaving portions

(7) uncoloured. Page 6 of the translation, referring to figure 12, indicates that the light coloured layers (4) may be multicoloured so as to exhibit a certain figure. The description on page 1 of the translation seems to me to describe a panel which operates in the same way as that of claim 1, with or without addition of the proposed passage. On this reading, Morimoto anticipates the unamended and amended claim 1 at least.

55. Herschman was hardly considered at the hearing. However, I would observe that the figures when read in conjunction with lines 40 to 71 of column 4 seem to disclose a panel falling within the scope of claim 1 before and after the addition of the proposed passage.

56. Paragraph 6 of the counterstatement asserts “that the amendment proposed [to claim 1] ... clearly distinguishes over all available prior art”. Setting to one side Dunklin and Giken, which I have already considered under another head in paragraph 34 above, it seems to me that the assertion in the counterstatement is incorrect in relation to Morimoto and Herschman at least. The onus here is on Mr Birss to persuade me that the proposed amendments do cure the defect identified. Insofar as Morimoto and Herschman form part of the “defect” identified in Contra Vision’s list of prior art put in by Mr Hill, he has not discharged that onus, and I feel obliged to refuse the proposed amendment to claim 1 at least on this count too.

57. Having already come to this conclusion, I do not believe that I need go further here in considering prior art documents. To do so would constitute the roving enquiry into validity which I consider I should eschew in amendment proceedings but which can be raised, if necessary, in other proceedings intended for that purpose.

58. Turning to the remaining grounds raised by Avery, and the extent to which I should go into those grounds, it is necessary as I have already mentioned to consider the comptroller’s responsibility to protect the public interest. It seems to me, however, that this responsibility is reduced by the judgment in *Minister of Agriculture*, which restricts the extent to which I can consider the prime issues of novelty and inventive step. In addition, I do not think I can ignore the fact of Avery’s withdrawal of its opposition and its taking a licence under the patent; at a general level I think that fact, in the context of these proceedings being pursued by another

opponent, inevitably weakens the weight of whatever submissions it has previously made and of the public interest argument of the comptroller of her own motion pursuing a separate line of objection. Taking account of these points, of the fact that the issues raised in the Avery opposition have not been argued before me (other than where they overlap the Clear Focus opposition), and of my findings against Contra Vision above, I conclude that I am justified in not pursuing this aspect further.

Conclusions

59. In summary, having considered carefully all the evidence and argument before me, I refuse the request to amend the patent on the grounds that:

- C the proposed amendment to claim 1 at least does not cure the stated defect, in that it does not serve to distinguish the claim over the prior art;
- C the request, at least insofar as it relates to claims 95, 126, and 134, adds new matter in contravention of section 76;
- C the request as a whole introduces unacceptable prolixity of claims.

Next Steps

60. I am inclined to the view that Contra Vision should be allowed an opportunity to submit revised amendments to the patent to remedy the deficiencies I have found currently to exist in the proposed amendments, and in such a way that others are not introduced. The sort of order I have in mind might take the following terms:

“Considering it appropriate in the circumstances of the present case, I hereby allow the proprietor a period of two months within which to submit to the Patent Office revised proposals for amendment with a view to overcoming the deficiencies I have found in the present ones. The proprietor should send a copy of the revised proposals to the opponent, who will then have a period of one month from the date of receiving the copy within

which to submit any comments to the Patent Office, copied to the proprietor. I will then determine how matters should proceed. It being clear from my findings that the amendments as a whole are not acceptable in their present form, I must therefore refuse them if the position remains as at present. Thus, if no revised amendments are submitted by the proprietor within the period I have set, I will issue a decision refusing the application to amend.”

61. This procedural course was not, however, canvassed at the hearing, and I do not think I should make any order laying down such a procedure without first giving the parties a chance to comment on it, both as to the principle and as to its detail. **I therefore allow both parties two months from the date of this decision within which to consider and comment on the notion and content of the draft order set out in the previous paragraph.** After that period, I shall consider any comments submitted in deciding how to proceed.

Costs

62. Although both parties have in their statements of case requested an award of costs, the matter was not argued before me at the hearing. I shall therefore defer the question for the time being.

Appeal

63. As this is a decision other than on a matter of procedure, any appeal shall be filed within six weeks from the date of this decision.

Dated this 3rd day of March 2000

S N DENNEHEY

Divisional Director, acting for the comptroller

THE PATENT OFFICE