Intellectual Property Office

BL O/246/18

20 April 2018

PATENTS ACT 1977

BETWEEN

Burren Precast Concrete Ltd	Claimant
and	
Carlow Precast Concrete Engineering	Defendant

PROCEEDINGS

Application under section 72 for revocation of patent number EP(UK)1522638

HEARING OFFICER Phil Thorpe

PRELIMINARY DECISION

Introduction

1. Burren Precast Concrete Ltd ("Burren") initiated revocation proceedings in respect of EP(UK)1522638 ("the patent") on the 10th January 2018. The statement of case was served on the proprietor of the patent and the defendant in these proceedings, Carlow Precast Concrete Engineering ("Carlow") on the 19th January 2018. Carlow were invited to file a counterstatement by 2nd March 2018.

2. In correspondence dated 21st February 2018 Carlow sought strikeout of parts of the statement of case and an extension to the period for filing its counterstatement. All of this was resisted by Burren in a submission dated 9th March 2018.

3. The matter subsequently came before at a telephone hearing on 13th April 2018 where Burren were represented by Mr Michael Lucey of PurdyLucey Intellectual Property and Carlow by Mr David Night of Fieldfisher. At that hearing I gave a number of directions. These together with the reasons behind them are set out below.

Reasoning and orders

4. Carlow argued that the challenge to the priority date of the patent in section 6 of Burren's statement of case has no relevance to the question of validity as none of the prior disclosure relied on by Burren falls in the period between the priority date and the filing date of the application. Burren accepted that the priority date of the patent was not material to its current case on revocation however it believed that striking out this part of its case could place it at a disadvantage later.

5. I was not persuaded by Burren's arguments. It is incumbent on the claimant to bring its full case from the off. If it has relevant prior disclosures that falls between the priority date and the filing date of the patent then it should put those forward now. If it doesn't have any such prior disclosure then it is a waste of the defendant's time to have to answer questions on priority and a waste of this tribunal's time as well. For that reason I struck out section 6 of the statement of case.

6. I noted that should Carlow seek to challenge the publication date of any of the prior disclosures already submitted such that the priority date of the patent becomes an issue then Burren can then seek to challenge that date.

7. Carlow further argued that I should strike out the final two paragraphs of section 7.5 of the statement of case. These read as follows:

> We also note that the European Search Examiner in the Opinion accompanying the European Search Report was of the opinion that dependent Claims 2 to 14 (which correspond to Claims 1 (in part) to Claim 10 of the Patent) did not contain any feature which, in combination with the features of any claim to which they refer, are either new or involve an inventive step with respect to the cited state of the art. The Examiner concluded that the reasons are that the additional features are either known from the cited documents (D1 (US3429473); D2 (GB560861); D3(2658552); D4 (US1807296) of the Search Report, all of which are enclosed herewith as D20 to D23 respectively) or are a combination of features obvious to the main skilled in the art in consideration of the disclosure of the cited prior art or they concern only minor modifications thereto which lie within the normal practice of the person skilled in the art, especially concerning very conventional precast concrete unit techniques in combination with sealing techniques of joints of such units. The Search Examiner made an equivalent comments regarding dependent Claims 16 to 21 (which correspond to Claims 11 (in part) to Claim 15 of the Patent), stating that the features/steps claimed in the method claims are clearly that what normally happens on a site where buildings made of precast units are assembled. No surprising steps could be found.
>
> Therefore, it is submitted that the dependent claims lack novelty and an inventive step over the cited prior art.

8. Carlow argued that these paragraphs contain mere assertions rather than clearly defined pleadings. It noted that four pieces of prior art are referred to without any clear indication how they relate to the 15 claims in the patent. In response Burren contended that Carlow is fully aware of the contents and relevance of these documents as they were cited during the prosecution of the patent before the EPO. That may be the case however it is still necessary to more clearly set out how each of these documents relate to the claims of the patent. This was a defect in the statement of case that I believed could be cured by amendment. I therefore allowed the claimant a period of two weeks

to provide the required specificity or in the alternative to delete these paragraphs from its statement of case.

9. The final issue I was asked to consider was the period allowed for Carlow to file its counterstatement. At the hearing Carlow suggested it should be at least 4 weeks from the time that Burren files any amended statement of case. Burren was keen to ensure that there were no further delays in the proceedings. I indicated that I would consider the nature of any changes made to the statement of case before setting the period though I did observe that Carlow had had the statement of case from 19th January 2018 and that they requested strike-out of part of the statement on 22nd February 2018. Carlow therefore already has had a number of weeks to prepare its response to those parts of the case unrelated to the issues discussed above.

Orders

10. I ordered that section 6 of the statement of case be struck out.

11. I further ordered the claimant, Burren, to provide within 2 weeks of the hearing an amended statement of case either without the final 2 paragraphs of section 7.5 or with a properly pleaded case in respect of each of the four prior art documents cited in that section.

Costs

12. The issue of costs was not discussed at the hearing however Carlow has on the whole been successful with its challenge to the statement of case and is therefore entitled to an award of costs. I will provide a period of three weeks from the date of this decision for the parties to make submissions on costs should they wish. I would note that my preliminary view is that an award in line with the comptroller's published scale of £200 is appropriate. In reaching that sum I am mindful that Burren was content for these matters to be decided on the basis of the papers whilst Carlow requested a hearing. I believe that Burren's position was the more reasonable in the circumstances and hence it would be unjust to award costs against it in respect of the preparation and participation in the hearing. In the absence of any submissions from either party then that sum will become payable by Burren to Carlow within seven weeks from this decision.

Phil Thorpe
Deputy Director acting for the comptroller