



beyond those cited by the patentee in its application to amend, should not be considered in section 27 proceedings. It says that case law establishes a clear principle that an opposition under section 27 cannot be allowed to develop into a roving inquiry into the validity of the patent because the proper course for doing this, if the opponent wished to do so, would be to bring a revocation action under section 72.

5 In its response the Opponent argues that the substantive issues of novelty and inventive step had been raised by the Patentee in its application to amend and that it was legitimate to oppose the amendment on these grounds with, it would seem, whatever prior art was relevant. The Opponent makes the further point that having referred to the Opinion issued by the Office in its application to amend, the Patentee had by default introduced documents D1-D3 into proceedings as these were documents the examiner had referred to in the Opinion as having been considered during prosecution of the patent. The Opponent's final point is that the Manual of Patent Practice states at paragraph 27.09 that the amendments must be both novel and involve an inventive step having regard to the prior art taken into account during examination of the application for the patent. The paragraph also states that the invention must be both novel and involve an inventive step having regard to the specified prior art when considered in the light of common general knowledge, and the statement of grounds makes clear that documents D1-D5 are illustrative of the common general knowledge of a person skilled in the art necessary in making such an assessment.

6 At the hearing Mr Moss set out the Opponent's position on the question of strike out more clearly than perhaps had been the case in written submissions. The Opponent's argument is this. Paragraph 27.28 of the Manual of Patent Practice ("the Manual") sets out the grounds of opposition under sections 27:

*27.28 Both in the notice of opposition and supporting statement and in any subsequent proceedings the opponent must address himself solely to the allowability of the proposed amendments, and may not attack the validity of the patent as it would be after amendment, except that if the amendments have been sought in order to remove an admitted defect casting doubt on the validity of the patent, the opponent may argue that the proposed amendments are not adequate to remove the defect...*

7 Guidance concerning the allowability of the proposed amendments is set out at paragraphs 27.09-27.11 of the Manual:

*27.09 When the amendments are proposed to distinguish the invention from specified prior art they must be such that the invention is both novel and involves an inventive step having regard to the specified prior art when considered in the light of common general knowledge and of the prior art taken into account during examination of the application for the patent.*

*27.10 [Deleted]*

*27.11 The amendments must not add matter nor must they extend the protection conferred by the patent (see 76.24).....*

8 When amendments are proposed to distinguish the invention from specified prior art as is the case here, the guidance states that the amendments must be such that the invention is novel and involves an inventive step having regard to i) the prior art specified by the patentee in the light of common general knowledge, and ii) the prior art taken into account during examination of the application for the patent.

- 9 The Patentee is seeking to strike out paragraphs 19 to 27, 32, 33 and 41 from the Opponent's statement of grounds. Mr Moss explained that each of these paragraphs addresses the question of novelty of the invention in the light of prior art taken into account during the examination of the application for the patent, i.e. D3, or refer to documents which assist in establishing the common general knowledge for assessing inventive step over the specified prior art (HP768), i.e. D1-D5. Mr Moss argues that there is no basis for striking out these paragraphs from the Opponent's statement.
- 10 Mr Moss did not dispute Mr Ambrosini's contention that a general principle had been established in case law that opposition proceedings under section 27 should not become a roving inquiry into the validity of the patent. Mr Ambrosini referred me to a number of Office decisions in which this principle was applied with approval: *Baxi Heating Limited v Robinson Willey Limited*<sup>3</sup>, *Clear Focus Imaging Inc v Contra Vision Limited*<sup>4</sup> and *Crown Cork and Seal Technology Limited v Calix Technology Limited*<sup>5</sup>.
- 11 Mr Ambrosini referred also to a number of Office decisions relating to requests for Opinions under section 74A and the extent to which such Opinions should deal with questions sufficiently considered in earlier proceedings (BL O/289/07, BL O/298/07, BL O/370/07). Mr Ambrosini stated that it has long been a standard practice of the Office to refuse to issue an Opinion on the basis of prior art already considered by an examiner during substantive examination, as matter which has either been sufficiently considered in earlier proceedings under section 74A(3)(a) of the Act and rule 94(1)(b) of the Patents Rules, or which is considered inappropriate in all the circumstances to reconsider under section 74A(3)(b). He argued that a similar approach should be adopted in proceedings under section 27.
- 12 I agree with Mr Ambrosini that the legislation concerning requests for Opinions allows the Office to refuse a request for an Opinion when the question upon which the Opinion is sought has been sufficiently considered in any relevant proceedings. As seems clear from the Hearing Officer's comments at paragraphs 19-21 of BL O/289/07 (*Franks & Co v Amazon.com*), it was always the intention when the Opinions service was introduced that it should not be used to repeat or in some way reappraise the examination of the patent performed in the Office, as is evidenced by the arguments in support of the legislation when it passed through Parliament. It is no surprise therefore that this intention was deliberately worded into legislation. However, there is no specific provision such as this in opposition proceedings under section 27, and I can find nothing in case law to suggest that such an approach should be adopted as a matter of principle. What the case law identifies as a matter of principle is that when amendments are proposed under section 27 to distinguish an invention from specified prior art, the grounds of opposition are limited to the question of whether the amendments sufficiently distinguish the invention from the specified prior art. The opponent cannot introduce new prior art as this would amount to a roving inquiry into the validity of the patent and a separate mechanism exists under the Act for doing just this. Although unlikely, it seems to me perfectly possible for a patentee to want to amend a patent under section 27 in order to further distinguish it from prior art already considered during examination of the application, and I see no reason why the patentee should not be allowed to do so. The logical conclusion of Mr Ambrosini's reasoning is that this should not be possible. Taking all

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<sup>3</sup> BL O/238/04

<sup>4</sup> BL O/079/00

<sup>5</sup> BL O/062/03

of this into account, I am not persuaded by the argument that Office practice in dealing with requests for Opinions is relevant in proceedings under section 27.

- 13 At the hearing, Mr Ambrosini referred me to the Hearing Officer's comments at paragraphs 27 and 28 of *Baxi Heating Limited* where he says that while he could look to witness statements submitted by the opponent for evidence as to the meaning of technical terms or in establishing when certain events occurred if it is evidence of fact, he could not look to the witness statements for evidence of the state of the art or of what was the common general knowledge as this would amount to introducing into proceedings prior art beyond that brought in by the proprietor. On the face of it, this appears to be wholly consistent with the principle set out above that an opposition under section 27 cannot be allowed to develop into a roving inquiry into the validity of the patent, but seems at odds with the practice currently set out at paragraph 27.09 of the Manual which Mr Moss refers to. In order to resolve this apparent inconsistency, I shall review the relevant case law identified by the parties and any additional authorities cited therein, together with other well-known authorities.
- 14 I start with the Office decision in *Bucher-Bayer's Patent*<sup>6</sup> cited at paragraph 27.12 of the CIPA Guide to the Patents Act (8<sup>th</sup> Edition), in which an opponent was not permitted to contend that the proposed amendment would add only an obvious feature to the claim, or leave it clearly anticipated by some further prior art, but was permitted to contend that the amendment did not cure the defect which the proprietor had indicated it was his intention that the requested amendment should cure. The Hearing Officer had this to say (pages 3-4):

"This application highlights an apparent conflict between two principles on which these case have been decided in the past, one that the Comptroller will not allow an amendment that leaves a patent clearly invalid, and one that the Comptroller will not permit amendment proceedings under section 29 to be expanded into a roving inquiry into the validity of the patent (for which the authority cited at the hearing was *Great Lakes Carbon Corporation's Patent* [1971] RPC 117 at 126). Mr Thorley's main argument was that to point to one clear anticipation of the patent could not be regarded as embarking on a roving inquiry into validity. In addition, he submitted that, as was usual in patent litigation, it was necessary to lead evidence to give the hearing officer the background information that the skilled man would have – in this case as I understand it the information that was common knowledge among agricultural engineers in 1969. Therefore, if the patent was clearly invalid in the light of that common general knowledge, it would be wrong of the hearing officer to ignore the situation.

In my view, Mr Thorley's submission does not properly take account of the policy associated with these proceedings. It is in the public interest that a patent granted in ignorance of some defect in it should be corrected as soon as possible. The patentee is under a positive obligation to have it corrected without undue delay, and if he neglects this obligation he risks being left with an incurably bad patent. The counterpart of this obligation is that the patentee should be encouraged to amend by making the procedure as straightforward as possible. As a general rule, if the patentee notifies the Comptroller of a specified defect and puts forward a proposal for correcting it, the Comptroller will not go out of his way to search for other flaws.

An opponent may legitimately argue that proposed amendments do not in fact remove the defect they are intended to remove (see for example *James Gibbons Ltd's Patent* [1957] RPC 158 at page 163) but such an argument must in my view be based on the evidence

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<sup>6</sup> BL O/167/86

that is already before the Comptroller.”

- 15 The reference here to section 29 is to section 29 of the Patents Act 1949, which is to all material extent equivalent to section 27 of the Patents Act 1977. The Hearing Officer goes on to conclude that (page 5):

“In my view however, this jurisdiction has been given to the Comptroller precisely because of the technical expertise of his hearing officers, which avoids the expense of supplying the technical background to each case. In contrast, the Court’s comparable jurisdiction under section 30 is to be exercised within infringement or revocation proceedings, when a more extensive appraisal of the prior art is appropriate. It is true no doubt that one hearing officer’s background knowledge will be different from another’s, but that is relatively unimportant. The primary purpose of section 29 proceedings is to deal with voluntary proposals by patentees to amend; whether extraneous deficiencies in the patent are spotted at the same time is a secondary consideration.”

- 16 In the Office decision in the case of *James Gibbons Ltd’s Patent*, the Hearing Officer said (at lines 11-19, page 163):

“I hold, therefore, that the Comptroller has the right, and indeed the duty, to examine any proposed amendment in the light of the reasons given by the applicant who seeks the indulgency, and reject it if, in his opinion, it does not achieve the result which it purports to do. In the present case, the Comptroller should assure himself that the amendments do in fact restrict the ambit of the invention to a construction not disclosed in the United States specification referred to by the Patentee. I would not suggest, however, that the Comptroller ought to extend the enquiry into realms of “subject-matter” or to other matters outside the reasons for seeking amendment given by the Patentee”.

- 17 In the Office decision in the case of *Great Lakes Carbon Corporation’s Patent* which was upheld by Whitford J on appeal to the Patents Appeal Tribunal, the Hearing Officer found that (lines 3-8, page 122):

“..grounds 3 and 4 on the opponents’ notice of opposition do not relate to objections which can properly be raised by an opponent in proceedings under section 29 since they relate to or are based upon publications which are not admitted by the patentees to be prior publications of the subject matter or to be such as make that subject matter obvious.”

- 18 In the Office decision in the case of *Minister of Agriculture’s Patent* where the opponent anticipated introducing evidence in the form of statutory declarations to support an allegation that features introduced by the proposed amendment were conventional, this decision being upheld by Aldous J on appeal to the Patents Court, the Hearing Officer said (at lines 11-22, page 65):

“Consequently it would appear to me that if the present opponent wished to contest the validity of the amended claims on the ground of lack of novelty or inventive step solely on the basis of the two journal references cited by the patentee it should be allowed to do so. If the opponent does not wish to be so limited then a revocation action is the only alternative.”

- 19 In the Office decision in the case of *Smith Kline & French’s (Bavin’s) Patent*, reference is made to a judgment of the Patents Court in *Donaldson Co. Inc.’s Patent*<sup>7</sup> in which the patentees applied to amend their specification to distinguish the claimed invention more clearly from one UK and two US patent specifications. The following passages from the *Donaldson* case, which were quoted in the *Smith Kline* decision,

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<sup>7</sup> [1986] RPC 1

bear repeating here (Falconer J at page 12, line 46 to line 39, page 47):

“The respondents, however, have sought to contend on this appeal, as they did before the superintending examiner, that claim 1 as accepted is invalid for obviousness and that the amendments sought do not cure that invalidity because, it is contended, the amended claim remains obvious in the light of five of the cited prior disclosures (enumerated in paragraph (i) of their respondents' notice) said to have been known to the patentees at all material times. A decision on that contention would, of course, require an investigation into the whole issue of whether claim 1 as accepted is, and as proposed to be amended would remain, invalid for obviousness and as to that issue there is a very substantial dispute on the evidence. The superintending examiner, in his decision, states it as his view that whether or not the invention now claimed is obvious or not is not a question which is proper to consider in these proceedings (i.e. amendment under section 29 of the Patents Act 1949 ). As the superintending examiner pointed out, the principles underlying the grounds which can properly be raised by opponents in section 29 proceedings and which can be considered by the Comptroller were authoritatively stated by Whitford J. in Great Lakes Carbon Corporations' Patent [1971] R.P.C. 117 in the passage at page 123. Whitford J. stated the principles thus:

‘The question accordingly is whether an opponent is entitled to bring into such an amendment proceeding objections relating to the validity of the claims as published or as proposed to be amended which are not related to the grounds upon which amendment is sought at all and may, counsel for the opponents thus submitted, cover the whole gamut of objections open under section 32 notwithstanding the fact that in proceedings at the Office the Comptroller General is limited under sections 14 and 33 to a consideration of certain grounds of objection to validity only.

The scheme of the Act appears to me to be against this broad submission. If anyone wishes to challenge validity as such the Act provides the machinery by which this may be done at the various stages of publication, one year from the sealing of the patent and the period subsequent thereto under the various sections 14, 33 and 32. There is nothing to indicate that it was in the contemplation of Parliament that an application to amend before the Comptroller General could be turned into a full-scale attack against the patent as originally granted or as proposed to be amended on any conceivable ground an opponent might like to raise and my attention was not drawn to any authority which would support the proposition that an unrestricted attack upon validity can be introduced into a section 29 amendment proceeding.’

In my judgment the superintending examiner was right to consider, as he did,

‘that these principles apply even when the opponents restrict their case to one based on the prior art cited in these proceedings and by the examiner in the pre-grant proceedings’

and accordingly, was right in his view that whether claim 1 is obvious in its accepted or amended form is not a question proper to be considered in these proceedings.”

- 20 The position so far as case law is concerned thus seems very clear: an opponent can question whether the proposed amendment has the effect of curing the defect as specified by the patentee but cannot advance arguments which challenge the validity of the patent beyond that suggested by the patentee.
- 21 Turning now to the guidance given in the Manual. Paragraphs 27.03-27.20 of the Manual set out the sequence of steps involved in dealing with amendments under section 27, which starts with the initial procedure for submitting the application and the preliminary notification of the amendment in the Journal, followed by examination

of the amendments by an examiner and finally publication of the amended specification. Once Litigation Section has arranged for preliminary advertisement of the application, the case is referred to an examiner to determine whether the reasons given by the patentee for making the amendments are sufficient. Paragraph 27.07 makes clear that the allowance of amendment under section 27 is a matter for the discretion of the comptroller and that the examiner's task is to ensure that the amendments effect a proper cure for any defect they are intended to rectify. It is only after the examiner considers that the amendments appear to be allowable that a notification is published in the Journal declaring that the amendments are open to opposition.

- 22 Paragraph 27.09 instructs the examiner that when amendments are proposed to distinguish the invention from specified prior art they must be such that the invention is both novel and involves an inventive step having regard to the specified prior art when considered in the light of common general knowledge and of the prior art taken into account during examination of the application for the patent. Once the examiner is satisfied that the amendments are *prima facie* allowable, the examination process is complete and the amendments are advertised for opposition. The examiner is required to determine whether the amendments proposed by the patentee are allowable without the benefit of input from third party opponents, i.e. before opposition under section 27(5), so the common general knowledge referred to in paragraph 27.09 of the Manual must come from the examiner's own background knowledge and not from elsewhere. This would be consistent with the Hearing Officer's comments in *Bucher-Bayer's Patent* (see paragraph 15 above).
- 23 Paragraph 27.09 also says that the examiner should consider the proposed amendment in the light of the prior art taken into account of the application for the patent. The examiner will be aware of this prior art without the need for a third party to provide the information in opposition.
- 24 Having reviewed the relevant case law and studied the practice for dealing with amendments under section 27 as set out in the Manual, I come to the conclusion that there is no inconsistency between the two as would initially appear with respect to information the examiner should have available in assessing allowability of amendments. Case law clearly establishes that an opponent cannot advance arguments which challenge the validity of the patent beyond that suggested by the patentee, therefore cannot provide evidence of the common general knowledge not already admitted in the application to amend. This is not a problem because the examiner can still decide not to exercise comptroller's discretion to amend the patent if he is aware from his own background knowledge that the proposed amendment would not sufficiently distinguish the invention (i.e. in terms of novelty and inventive step) from the prior art specified by the patentee. The examiner does not need information from the opponent to establish the common general knowledge or to identify the documents considered in examination of the application before grant.
- 25 In the present case, the opponent is not allowed to allege that the invention (as proposed to be amended) lacks novelty over document D1, nor can it argue that the invention would lack an inventive step from either HP768 or document D1 based on the common general knowledge it says is shown in documents D1-D5, because these were not reasons specified by the patentee for making the application under section 27.

## **Conclusion**

- 26 I have found that the case law is very clear on the grounds available to oppose an application to amend a patent specification after grant and that the practice set out at paragraph 27.09 of the Manual for assessing the allowability of the amendments is consistent with this case law. An opponent can question whether the proposed amendment has the effect of curing the defect as specified by the patentee but cannot advance arguments which challenge the validity of the patent in any way beyond that suggested by the patentee. In his examination of the application to amend, an examiner is allowed to take into account his own background knowledge when deciding whether to exercise the comptroller's discretion to allow the amendments and can also take account the prior art cited during examination of the application for the patent. However, it is not open to an opponent to put forward its own view of the common general knowledge or to advance new arguments on novelty or inventive step not previously advanced by the patentee.
- 27 Paragraphs 19 to 27, 32, 33 and 41 of the opponent's statement of grounds relate to arguments which challenge the validity of the patent beyond that suggested as necessary by the patentee. According to the case law, these are not valid grounds of opposition under section 27(5) and therefore the patentee's application to strike out these parts of the opponent's statement is successful. I will allow the Opponent a period of three weeks from the date of this preliminary decisions to submit an amended statement of grounds.

## **Costs**

- 28 The matter of costs was not discussed in any detail at the hearing. The Patentee has succeeded in its application to strike out parts of the Opponent's statement of grounds and is entitled to its costs arising from this preliminary decision. I shall allow both sides a period of 28 days to make submissions on costs before making an Order in favour of the Patentee.

## **Appeal**

- 29 Any appeal must be lodged within 28 days after the date of this decision.

## **H Jones**

Deputy Director acting for the Comptroller