

PATENTS ACT 1977

IN THE MATTER OF European patent application EP 0485211 in the name of Pifco Limited

and

IN THE MATTER OF a referral under sections 37 and 13 by Global Domestic Products Limited and Stylianos Panaghe

DECISION

1. European patent EP 0485211 was granted on 18 June 1997 to Pifco Limited following an assignment dated 4 May 1994. The application had originally been made by IST Laboratories Limited on 7 November 1991 (claiming priority from an earlier British application GB 9024419) but the assignment had been made following the liquidation of the latter company.

2. A Form 2/77 plus an original statement was filed on 18 June 1999 followed by an amended statement of 16 July 1999 in respect of the two referring parties. A counterstatement was filed on 15 November 1999. Prior to filing of their counterstatement, however, on 4 October 1999, a letter was received on behalf of the proprietors asking that the Comptroller consider under section 37(8) whether the matter would be more properly dealt with by the court *inter alia* at that stage because the reference was anticipated to have the potential to form part of a more extensive case involving alleged defamatory statements on behalf of the referrer and, if the latter were successful in their reference, then presumably they would wish to bring an action for infringement.

3. This was initially resisted on the part of the referrers, but following extensive correspondence by both parties, they too have subsequently indicated that they would be content for the Comptroller to decline to deal with the action.

4. The proprietors submissions of 8 August 2000 give four basic reasons why the Comptroller should decline to deal. These present me with some difficulty since no single one of the reasons seems to be conclusive. The four reasons given are:

(A) The wider powers available to the patents court to order disclosure. Whilst it is true that, in the general case, the Comptroller will only be minded to order 'specific' rather than 'standard' disclosure and to order disclosure by parties rather than non-parties, nevertheless as I see it the whole range of powers analogous to those under the CPR are open to the Comptroller to make such broader orders as she may wish.

(B) The ability to hear extensive cross-examination of witnesses before the Comptroller. Whilst it is true that it is within the discretion of the Comptroller whether or not to permit cross-examination, the right to such is not something that would be lightly refused by the

Comptroller, particularly in a case with such a clear conflict of evidence as the present.

(C) The interpretation of contractual terms and the construction to be placed on confidentiality undertakings. This does not seem to be in any way out of what would be expected to follow from an entitlement dispute.

(D) The amount of the costs awarded. Whilst it is true that the Comptroller generally awards only scale costs, there would be nothing to prevent the parties agreeing prior to the hearing that they would be subject to full-scale costs on a taxed basis, as in the courts.

5. To sum up, I believe that had this application been opposed, I would have refused to grant it. However, the referrer no longer contests the application, and they raise the additional point that, should I find in favour of a decision to retain jurisdiction, then the applicants have suggested that they will appeal thus adding unnecessary further expense to both parties.

6. Accordingly, as provided for under section 37(8), I decline to deal with the reference.

7. I would comment that at an earlier stage the proprietors indicated that they had issued a claim form in the High Court (HC 1999 04183) against the referrers for alleged libel and threats. This was not served against the referrers (at least before the 11 November 1999) having regard to a proposed settlement foreshadowed at that stage following on from revocation of the patent at issue before the EPO. The settlement negotiations broke down, however, and the request that the Comptroller consider whether she should decline to deal with the case was restarted. If this claim form was ever served against the proprietors, then it would be a further reason for me to exercise the Comptroller's discretion, but I assume that it has not been because it would have been referred to in one or both parties recent submissions.

Appeal

8. This being a procedural decision, the period for appeal is two weeks.

Dated this 22nd day of August 2000

G M BRIDGES
Divisional Director, acting for the Comptroller

THE PATENT OFFICE