

0/388/01

PATENTS ACT 1977

Linda
3Y36

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 Contra Vision Limited ("the proprietor") applied to the comptroller to amend the specification of Patent Number GB 2165292 C ("the UK patent"). The application stands opposed by Clear Focus Imaging Inc ("the opponent"). The matter came before me at a hearing and was the subject of my decision of 3 March 2000. In that decision I refused the request to amend the patent on the grounds that some of the proposed amendments were not acceptable, and set out a draft order which would allow the proprietor the opportunity to submit revised proposals for amendment. Although the proprietor accepted the terms of the draft order, the opponent did not, arguing that I should refuse the current application outright. The issue was settled in my decision of 7 November 2000 in which I ordered as follows:

"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."

- 2 In January 2001, the proprietor duly filed revised proposals together with comments and what appeared to be further evidence; and in March 2001, the opponent filed comments and what appeared to be further evidence. In an official letter dated 8 March 2001 the parties were notified that I had reviewed the file and wished to make it clear that whilst my decision was intended to permit the submission of fresh amendments, observations and argument, it did not provide for the submission of further evidence; and that I was inclined to the view that the submission of fresh evidence at that stage of the proceedings would not be justifiable. In subsequent correspondence, this preliminary view was accepted by the proprietor but not by the opponent. The question of whether or not the revised proposals should be advertised as open to opposition also arose in correspondence and remains outstanding: the opponent argues for advertisement and the proprietor against. That both of these matters are for the comptroller's discretion does not appear to be in dispute. Both parties have indicated that they are content for me to settle them on the basis of the papers on file.

Evidence

- 3 The revised proposals, filed by the proprietor under a letter dated 4 January 2001, are accompanied by a commentary on the proposals, six exhibits labelled I to VI, two schedules labelled A and B, and a commentary on the basis for the revised amendments. Exhibits I and II relate to proceedings in the United States Patent and Trademark Office concerning the US equivalent of the UK patent, US Patent No 4673609 ("the US patent"); exhibit III comprises copies of scientific articles; exhibit IV is a copy of a declaration by Dr Geoffrey J Levermore of the University of Manchester Institute of Science and Technology used in the proceedings in the United States referred to above; exhibit V comprises affidavits by Mr Don Sanderson and Mr Ayako Somers, both translators; and Exhibit VI is an extract from a dictionary of English. The evidence of Dr Levermore relates to vision control experiments carried out using the screen of the US patent; and that of Messrs Sanderson and Somers concerns the translation into English of Japanese Utility Model No 1982-14101 ("Morimoto"), a document which forms part of the prior art under consideration in these proceedings.
- 4 The opponent's response, filed under a letter dated 8 March 2001, comprises a commentary (including a schedule labelled X) on the documents filed by the proprietor, and two exhibits labelled A and B. Exhibit A is an affidavit by Mr Larry Reeves and exhibit B is an affidavit by Mr Edward Jay Leavitt Junior. Mr Reeves is a manufacturer of one-way vision products and is co-inventor of US Patent No 4358488 ("Dunklin"), a patent referred to by the proprietor in its original application to amend. Mr Leavitt has been involved with similar products in the United States since 1974.
- 5 The proprietor has indicated in letters dated 12 March 2001 and 2 April 2001 that it accepts that further evidence should not be admitted at this stage of the proceedings. In particular it is content for its own exhibits I to VI not to be admitted in evidence, and argues that the opponent's exhibits A and B should also not be admitted. The opponent on the other hand has argued for its evidence to be admitted.
- 6 I turn therefore to the opponent's exhibits A and B, that is the affidavits by Mr Reeves and Mr Leavitt. In his affidavit Mr Reeves discusses the construction, manufacture and functioning of his company's products, and also comments on the views expressed by the proprietor on Dunklin. Mr Leavitt's affidavit is concerned with certain screen products available in the United States over the years.
- 7 In response to an official letter dated 27 March 2001, which noted that all of this evidence could have apparently been filed in the normal rounds preceding the hearing, the opponent put forward two main submissions. The first is that Mr Reeves' affidavit includes evidence which is not directly related to Dunklin and which is material to the allowability of the revised amendments. The second is that the willingness of the proprietor to forgo its new evidence indicates that the opponent's further evidence is significantly more material than that of the proprietor.
- 8 I do not find myself persuaded by either of these submissions. No reason has been advanced by the opponent as to why Mr Leavitt's evidence, and the evidence of Mr Reeves not directly related to Dunklin, could not have been filed in the normal rounds

preceding the substantive hearing, and this in my view is a key issue here. As to the relative significance of the opponent's and proprietor's evidence, the opponent has advanced no detailed argument in support of its submission that the two sets of evidence are not of comparable weight, nor, more importantly, that its own evidence is of sufficient weight that its exclusion would prejudice the case to any material extent.

- 9 There are strong reasons, derived from the public interest in proceedings being handled justly and proportionately, why fresh material submitted outside the prescribed evidence rounds, and therefore admissible only at the comptroller's discretion, should not be admitted in evidence unless it is justified. Such justification would require compelling supporting reasons, for example as to why the material in question could not or had not been filed before, and as to its weight or significance to the issues under consideration. As I have indicated, I do not believe such reasons have been made out here.
- 10 In the circumstances therefore, I see no reason to go outside the terms of my previous Order as set out above and I decline to exercise the comptroller's discretion in respect of the opponent's exhibits A and B, that is to say I refuse the admission in evidence of those documents at this stage of the proceedings. For the avoidance of doubt, I should make it clear that I also refuse to admit in evidence the proprietor's exhibits I to VI, a course of action which is not contested by the proprietor.

Advertisement

- 11 These amendment proceedings were originally filed, advertised in the *Patents and Designs Journal*, and opposed under section 27. However, the opponent also applied to the comptroller under section 71 for a declaration of non-infringement of the UK patent. In view of the provisions of section 27(2), which preclude amendment under section 27 where there are pending proceedings in which the validity of the patent may be put in issue, the parties agreed that the proceedings under section 27 should be converted to proceedings under section 75.
- 12 In a letter dated 28 February 2001 the opponent stated that the revised proposals for amendment include eleven independent claims not previously submitted, and raised the question of advertising these proposals under rule 40, which applies to proceedings under section 27. The proprietor responded in a letter dated 8 March 2001 stating that there were no claims new to these proceedings in the revised proposals, and that only two independent claims (1 and 45) had been amended. The proprietor also pointed out in that letter that these proceedings are now governed by section 75 and rule 78. It was confirmed in an official letter, also dated 8 March 2001, that both parties had previously agreed that these amendment proceedings should be treated as being based in section 75, under which advertisement was a matter for the comptroller's discretion. It was also indicated in that letter that, in the Office's preliminary view, the revised amendments, although significantly different from those originally advertised, appeared to fall within the scope of the earlier amendments and did not therefore require to be advertised afresh.
- 13 The proprietor indicated its agreement with this preliminary view in a letter dated 12 March 2001. The opponent, however, in a letter dated 15 March 2001 argued that not

only are the latest amendments significantly different from those originally advertised, but they include a number of independent claims which have no equivalents in the previously submitted and rejected amendments.

- 14 Turning then to the proposed amendments themselves, I note that the UK patent contains 63 claims including two independent claims (not counting omnibus claims); the original proposal to amend has a total of 239 claims including 68 independent claims; and the revised proposal has a total of 63 claims including 13 independent claims. Of these 13 independent claims, it seems to me that only claims 1, 42 and 45 have no direct counterpart in the claims that have already been advertised.
- 15 The latest form of claim 1 comprises the subject matter of claim 1 as advertised combined with the subject matter of claims 14 and 26 of the UK patent, together with certain further limitations; the latest claim 42 comprises the combined subject matter of claims 82, 84 and 91 as advertised; and the latest claim 45 comprises claim 123 as advertised but refers to "a film material layer" rather than to "a material layer". Thus each of claims 1, 42 and 45 as most recently proposed appears to fall within the scope of claims that have already been advertised. (For completeness I should add that the revised proposals also include amendments to the description, amendments which appear to correspond to the revised claims.)
- 16 The opponent has made no submissions under this head more detailed or specific than those I have referred to above. It seems to me that they do not impugn the preliminary view expressed in the official letter dated 8 March 2001 that the revised proposals appear to fall within the scope of the earlier advertised amendments, especially given that the proprietor agreed with that view. I conclude therefore that to exercise the comptroller's discretion in favour of advertising the revised proposals would not be justified.

Conclusion and Next Steps

- 17 Having carefully considered all of the submissions on file, and for the reasons that I have given, in exercising the comptroller's discretion I have refused to admit further evidence from the opponent and the proprietor, and I have decided that the revised amendment proposals should not be advertised.
- 18 In consequence this case now appears to be ready for substantive consideration of the revised proposals for amendment. As I have already noted, the opponent has commented on these proposals in its response filed on 9 March 2001. Even on the most cursory of scans, it seems clear from those comments that the opponent remains opposed to the (revised) application to amend. The question for me then is what is the most efficient course for the proceedings to take now.
- 19 In view of the opponent's continued opposition to the application to amend, I propose that **both parties shall have one month from the date of this decision in which to request an oral hearing on the substantive matter or to indicate a willingness for the matter to be decided on the papers. The parties may also make use of this period, if they wish, to submit any further written comments on the allowability of**

the revised proposals for amendment.

Costs

20 As in the earlier decisions on this case, consideration of the question of costs is deferred.

Appeal

21 As this is a decision on a matter of procedure, any appeal against it shall be filed within two weeks from the date of this decision.

Dated this 6th day of September 2001



S N DENNEHEY

Divisional Director, acting for the comptroller

