



PATENTS ACT 1977

Helimedia Limited

Requester

PROCEEDINGS

Request under section 74A of the Patents Act 1977
for an opinion on patent number GB 2377538 B

HEARING OFFICER

Phil Thorpe

DECISION

Introduction

1. This decision relates to whether a request for an opinion should be refused.
2. The request seeks an opinion on the validity of a granted GB patent. What is unusual about this request is that it is relying on prior art and arguments already considered by the European Patent Office (EPO) when it examined, and ultimately refused, the EP equivalent of the GB patent.
3. The request was filed on 10 December 2009 in the name of Helimedia Limited ("the requester"). The request sought an opinion on whether patent GB 2377538 B ("the GB patent") in the name of Citysync Limited ("the proprietor") is valid.
4. The request was advertised on 14 December 2009. Observations were filed by the proprietor on the 7 January 2010. Observations in reply were subsequently filed by the requester on 22 January 2010.
5. In a letter dated 18 February 2010, the Office informed the requester that it proposed to refuse the request but before doing so would allow the requester an opportunity to be heard. The matter came before me at a telephone hearing on 15 April 2010 where the requester was represented by Mr Jason Lessard of Hepworth Brown. In accordance with Section 74A(6)(a) only the requester was considered to be a party to the proceedings before the comptroller. The hearing

was however open to the public and, in response to a specific request, provision was made for a representative of the proprietor to listen in on the hearing.

The Patent

6. The GB patent was the basis for a priority claim on an international application filed under the PCT. The PCT application entered the European regional phase as EP 02708497.9 and was subsequently refused following oral proceedings before the EPO on 23 November 2006. The requester notes, and this has not been challenged by the proprietor, that the claims on which the refusal before the EPO was based are identical to the granted claims of the GB patent but for the fact they are in two-part form and include reference numerals and omit the omnibus claim of claim 15 of the GB patent.
7. The PCT application also entered the US national phase and the US Patent and Trademark Office issued a final rejection on 30 November 2005. The claims in the US patent also corresponded with the claims of the GB patent.

The Request

8. The request for the opinion details the documents that were considered in the examination of the GB patent as well as those considered during the prosecution of the equivalent EP and US applications. The request notes that a number of these documents were not been considered by this Office and that therefore it would be “entirely appropriate for the Comptroller to review the validity of the Patent on the basis of these new documents”.
9. The observations filed by the patentee argue why these documents do not render the patent invalid.

The initial view of the office

10. Following the submission of observations in reply, which dealt only with the substantive matter of the validity of the patent, the Office wrote to the requester saying that it was minded to refuse the request for the opinion. This reason given was that the question upon which the opinion is sought appears to have been sufficiently considered by the EPO.
11. In response the requester has put forward arguments in a letter dated 11 March 2010 and at the hearing as to why the request should not be refused.

The law

12. The relevant provisions of the Patents Act 1977 and Patent Rules 2007 so far as this decision is concerned are:

Section 74A(3)

The comptroller shall issue an opinion if requested to do so under subsection (1) above, but shall not do so-

- (a) in such circumstances as may be prescribed, or
- (b) if for any reason he considers it inappropriate in all the circumstances to do so.

Rule 94

- (1) The comptroller shall not issue an opinion if-
 - (a) the request appears to him to be frivolous or vexatious; or
 - (b) the question upon which the opinion is sought appears to him to have been sufficiently considered in any relevant proceedings.

13. I deal first with the prescribed circumstances referred to in Section 74A(3)(a) which are set out in Rule 94

Is the request frivolous or vexatious?

- 14. The requester has provided a copy of a letter which appears to show that the patentee is seeking to enforce the GB patent against the requester notwithstanding that the EP application was rejected. The request is therefore not in my view frivolous.
- 15. The patent proprietor suggests that the manner in which the question has been presented in the request is “vexatious”. There is an issue with how the request has been made and I deal with that specific point later in this decision. But overall I do not believe on the basis of the material before me that the request is vexatious.

Has the question been sufficiently considered in any relevant proceedings?

- 16. The question that is being considered is in accordance with Section 74A(1)(b) whether, or to what extent, **the invention in question** is not patentable because the condition in section 1(1)(a) or (b) above is not satisfied (emphasis added).
- 17. In this case the “invention in question” is that set out in claim 1 of the GB patent. But that is the same invention as claim 1 of the equivalent EP application since the claims are in effect identical. Indeed if the EP application had been granted then under section 73(2) the comptroller would have revoked the GB patent because it would have been in respect of the same invention as the equivalent EP patent.
- 18. The phrase “relevant proceedings” as referred to in Rule 94 is defined in Rule 92 as “proceedings (whether pending or concluded) before the comptroller, the court or the European Patent Office.” A number of previous decisions¹ have considered what constitutes proceedings before the comptroller or before the EPO. These decisions have concluded that the normal pre-grant examination

¹ BL O/289/07, BL O/298/07, BL O/370/07, BL O/242/09,

process, as conducted either before this Office or the EPO does not constitute relevant proceedings for the purposes of rule 94(1).

19. In this case the EP application was also the subject of oral proceedings. Such proceedings are similar to ex-parte hearings in this Office which are held at the applicant's request where the Comptroller is inclined to exercise his discretion against the applicant. Although oral proceedings, as with ex-parte hearings result in the issuance of a formal decision, they are still in effect part of the pre-grant examination process. I believe therefore that they would not fall within the definition of "relevant proceedings".
20. I should add that the proprietor has in letters to the requester questioned the competence of the examining division of the EPO and also noted that it did not pursue the EP application for "commercial rather than legal reasons". It is also noted that the proprietor was not represented at the oral proceedings. This certainly suggests that the proprietor does not believe that the question has been "sufficiently" considered by the EPO. I do not need to say anything further on that in respect of Rule 94(1) since I have already concluded that these were not relevant proceedings.

Is it inappropriate in the circumstances to issue an opinion?

21. I turn now to Section 74A(3)(b) which provides that the comptroller shall not issue an opinion if for any reason he considers it inappropriate in the circumstances to do so.
22. This provision has been relied on previously to refuse requests that did no more than repeat arguments already sufficiently considered pre-grant. In the earlier cases² the requester was seeking in effect a re-examination of a granted patent using the same prior art that the examiner, either in this office or the EPO, had considered when examining that patent.
23. The rationale for refusing such requests was that the opinion service was never intended to be a tool by which patent proprietors could be asked to justify the validity of their patents on the basis of questions already considered by the office that granted the patent. These previous cases have highlighted the need for the request to raise something new.
24. This case is however different to those cases referred to above. Indeed this is the first time where the office has been asked for an opinion on the validity of a granted patent on the basis of material that led to an equivalent GB or EP application being refused. The proprietor of the GB patent clearly believes that the GB patent is valid otherwise it would not be trying to assert it against the requester. This belief is based on a view that the question of whether the invention in question is patentable was not sufficiently considered by the EPO. An opinion would allow that question to be considered further.

² ibid

25. In determining whether it is appropriate to issue an opinion I need to be mindful of the rationale for the opinion service which is to help parties settle disputes without having to litigate. Even though opinions are non-binding, there is now considerable evidence that they do help resolve disputes.
26. In this case the requester does not wish to incur the cost of a revocation action. It also argues that it would be in the public interest for the comptroller to issue an opinion since if it finds the patent invalid then this will provide certainty for third parties against whom the patent might be asserted. By their nature, opinions cannot provide that sort of certainty. But an opinion that confirms the validity of the patent may encourage the parties to enter into settlement discussions whilst an opinion that the patent is invalid may encourage the proprietor to withdraw its assertion that the patent is infringed.
27. On balance therefore, and mindful of the overriding purpose of the opinion service to help resolve disputes, I believe that in this instance it would be appropriate to issue an opinion.

Scope of the opinion

28. The initial request under the heading “**General**” notes that “If the comptroller considers that any of the claims of the Patent are valid despite the above arguments, the Requester asks that all documents presented herewith are considered individually and in any relevant combination in order to determine the validity of the document”. The request lists nine documents. Not surprisingly the proprietor has questioned the appropriateness of such a vague request.
29. The opinion procedure allows a proprietor a relatively short period in which to submit a single response to a request questioning the validity of its patent. It is therefore imperative that the question on which it needs to respond is adequately set out in the request. The part of this request that I have referred to does not do this and therefore it would be unfair to expect the proprietor to respond to such vague assertions. The opinion should therefore disregard this part of the request. In addition the request raises the issue of whether the claims incorporate any patentable subject matter. This is not something that an opinion can consider and therefore this part of the request should also be disregarded.

Conclusion

30. I have concluded that in the circumstances it would be appropriate to issue an opinion and that that opinion should be based on the specific arguments relating to novelty and inventive step set out in the request.

P THORPE

Deputy Director acting for the Comptroller