



PATENTS ACT 1977

BETWEEN

Malcolm and Varnham and Diana Hodgins

Claimants

and

BAE Systems plc

Defendant

PROCEEDINGS

Claim for employee compensation under section 40(1) of the Patents Act 1977 in respect of European patent no EP0461761B1

HEARING OFFICER

A C Howard

DECISION

Introduction

- 1 The substantive proceedings before the comptroller related to a claim for employee compensation under section 40 of the Patents Act 1977 ("the Act"). Following a hearing on 30 October 2013, I issued a decision on 31 December 2013¹ declining to deal with the matter. In that decision I gave the parties the opportunity to make submissions on the question of costs, and in an Official letter of the same date, the parties were also invited to make submissions on the question of whether the decision should be made open to public inspection or should remain confidential.
- 2 In subsequent correspondence, the claimants requested that I consider in addition the status as regards possible publication and use for other purposes of the statements of case and other material filed in the proceedings, and I have received submissions from both sides on this matter also.
- 3 The defendant (being the party who had successfully argued that I should decline to deal with the substantive matter) has indicated that it will not be seeking any award of costs against the claimants.

¹ BL O/517/13

- 4 The parties have confirmed that they are content for me to decide these final questions on the basis of their written submissions, and that is what I shall proceed to do.

The law

- 5 The relevant provisions are as follows:

Section 118(1) Patents Act 1977

(1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) give the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions.

Rule 51 Patents Rules 2007

(1) For the purposes of section 118(1) the prescribed restrictions are those set out in paragraphs (2) and (3).

(2)

(3) Unless in a particular case the comptroller otherwise directs, no document may be inspected—
(a) where that document was filed at the Patent Office in connection with an application under section 40(1) or (2) or 41(8);
(b) where that document is treated as a confidential document under rule 53;
(c) where—
(i) that document was prepared by the comptroller, an examiner or the Patent Office other than for internal use, and
(ii) it contains information which the comptroller considers should remain confidential;

(4) In this rule references to a document include part of a document.

Rule 53

(1) Where a person files a document at the Patent Office or sends it to an examiner or the comptroller, any person may request that the document be treated as a confidential document.

(2) The comptroller must refuse any request where it relates to—
(a) a Patents Form; or
(b) any document filed in connection with a request under section 74A.

(3) A request to treat a document as confidential must—
(a) be made before the end of the period of 14 days beginning immediately after the date on which the document was—
(i) filed at the Patent Office, or
(ii) received by the comptroller, an examiner or the Patent Office; and
(b) include reasons for the request.

(4) Where a request has been made under paragraph (1), the document must be treated as confidential until the comptroller refuses that request or gives a direction under paragraph (5).

(5) If it appears to the comptroller that there is good reason for the document to remain confidential, he may direct that the document shall be treated as a confidential document; otherwise he must refuse the request made under paragraph (1).

(6) But where the comptroller believes there is no longer a good reason for the direction under paragraph (5) to continue in force, he must revoke it.

(7) In this rule references to a document include part of a document.

- 6 Thus, section 118(1) lays down the general principle that after publication of an application, documents relating to that application or any respective granted patent must be available for public inspection. This is subject only to the exceptions set out in rule 51. These provisions apply to European patents designating the UK by virtue of section 77(1) which assimilates such patents to patents applied for and granted under the Patents Act 1977.
- 7 It is clear from Rule 51(3)(a) that (unless the comptroller otherwise directs), documents filed at the Patent Office in connection with an application under section 40(1) or (2) or 41(8) are not to be open to public inspection, and it is not at issue that the documents filed at the Office by the parties in connection with these proceedings fall within the scope of this provision.
- 8 A decision of the comptroller is not however a “document filed at the Patent Office” and does not therefore fall within the scope of Rule 51(3)(a). It follows that there is no blanket ban on public inspection of decisions. On the contrary, the effect of section 118(1) combined with the clear limitation of the exception in Rule 51(3)(a) creates a clear general requirement that decisions, including decisions under section 40, will be published. This is consistent with the well known and clear public interest in open justice.
- 9 This is not the end of the story however. Rule 51(3)(c) provides that a document or part of a document which has been prepared in the Office other than for internal use may be kept from public inspection if “it contains information which the comptroller considers should remain confidential”. The reference to a “document ... which has been prepared in the Office” clearly encompasses decisions of the comptroller. The rule sets out no procedure to be followed, and nor does it offer any guidance as to the factors to be taken into account, but I have no doubt that in principle, the comptroller is free to consider on its merits a request for confidentiality in respect of all or part of one of his decisions.

Discussion

1. Confidentiality of the decision

- 10 The claimants argue that there is nothing confidential in the decision and nor is there any legal constraint on the parties which would prevent them publishing the decision themselves. They further argue that it is in the public interest for the decision to be published as it raises issues of public importance, and therefore are of the view that the decision should be made publicly available on the IPO website.
- 11 The defendants say that as the decision relates to a section 40 matter, it should remain not open to public inspection. They have not however advanced arguments relating to the objective confidentiality of any part the specific content. Indeed, they have confirmed that if my decision is to publish the decision, they will not be seeking any redactions.
- 12 I have already commented that the general rule is that decisions should be published, although the comptroller has the discretion to keep them confidential if he considers it appropriate to do so. The fact that the legislator chose not to include documents prepared in the Office from the exception set out in Rule 51(3)(a)

indicates to me strongly that the mere fact that these are proceedings under section 40 is not sufficient justification for exercising discretion to keep the decision confidential.

- 13 Having regard to the above and in the absence of specific justification by the defendant for its request, it is quite clear to me that the decision should be published. For the avoidance of any doubt, I confirm that similar considerations apply to the present decision.

II. Confidentiality in relation to material filed in the proceedings

- 14 Rule 51(3)(a) operates to prevent the Office from publishing any documents filed by the parties. This includes the statements, annexes and skeleton arguments. The claimants accept this and have not requested the Office to place any of this material on the open part of the file. What they have requested is that I make a ruling on whether the parties are free to use outside these proceedings documents (notably the statements of case and skeleton arguments) which were not produced under compulsion. The defendant has not made submissions on this point beyond reiterating that that documents filed at the Office should remain not available to public inspection.
- 15 I have considered the claimants' arguments carefully. However I do not see that it is possible for me to give a ruling of the kind that they seek. On their face, none of the provisions discussed above place any obligation of confidentiality on parties to proceedings before the comptroller (as opposed to the Office itself). While, as the claimants acknowledge, a confidentiality obligation may arise because of the circumstances in which documents are produced in proceedings (for example if they are produced under compulsion), the answer to the question of how free a party might be to use any particular document would need to be determined in the appropriate forum if the situation ever arose and cannot be affected by anything I say in this decision.
- 16 The claimants also ask for a ruling that the defendant is out of time for requesting that the statements of case and skeleton arguments should be treated as confidential under Rule 53. However no request has been made under this provision and I can see no purpose in making such a determination on a hypothetical basis, particularly in view of the fact that to do so would fetter discretion with regard to any possible future request and I have confirmed that these documents are not in any event open to public inspection under the provisions of Rule 51(3)(a).

Conclusion and order

- 17 I have concluded that there are no grounds for maintaining confidentiality of the earlier decision or of this decision. I therefore direct that the above mentioned decision of 31 December 2013 and the present decision be made open to public inspection, this action to be stayed until the appeal period has passed or any appeal lodged has been concluded.
- 18 For the reasons set out above, I decline to make any ruling as regards the freedom of the parties to use documents filed in these proceedings for other purposes, or as regards the possibility of requesting confidentiality under Rule 53. For the avoidance

of any doubt I confirm that all documents filed at the Office in connection with these proceedings must remain unavailable for public inspection at the Office in accordance with Rule 51(3)(a).

Costs

- 19 I found for the defendants in my earlier decision and they are therefore entitled to ask for a contribution toward their costs. However, as I have already remarked, they have indicated that they would not be seeking costs on this occasion.
- 20 While in this decision I found for the claimants on the specific question relating to publication of the decision, they lost on their other requests. Taking all this into consideration, I conclude that it would not be appropriate to make an award of costs and accordingly make no order in this regard.

Appeal

- 21 Any appeal must be lodged within 28 days.

A C HOWARD

Divisional Director acting for the Comptroller